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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

MIKE SARIEDDINE,
Plaintiff,
v.
D&A DISTRIBUTION, LLC (dba
STRICTLY E-CIG), et al.,
Defendants.

SHENZHEN TECHNOLOGY CO.,
LTD. (fka SHENZHEN SMOK
TECHNOLOGY CO., LTD.),

Counterclaimant,

v.

MIKE SARIEDDINE,
Counterdefendant.

Case No. 2:17-cv-02390-DSF-SK

**Discovery Document: Referred to
Magistrate Judge Steve Kim**

**JOINT STIPULATION
REGARDING PLAINTIFF'S
MOTION TO COMPEL
PRODUCTION OF
DOCUMENTS AND
RESPONSES TO PLAINTIFF'S
FIRST SET OF DOCUMENT
REQUESTS AND
INTERROGATORIES**

[Declarations filed concurrently
herewith]

Hearing Date: April 11, 2018
Time: 10:00 am
Courtroom: 23
Magistrate: Honorable Steve Kim
Discovery Cut-off: March 11,
2019

JOINT STIPULATION REGARDING
PLAINTIFF'S MOTION TO COMPEL
Case No. 2:17-cv-02390-DSF-SK

Pretrial conference: July 15, 2019
Trial: August 13, 2019

JOINT STIPULATION

This Joint Stipulation is submitted pursuant to Local Rule 37-2.1 in connection with Plaintiff Mike Sarieddine’s (“Plaintiff”) motion to compel Defendant and Counterclaimant Shenzhen IVPS Technology Co., Ltd. f/k/a Shenzhen Smok Technology Co., Ltd. (“Smok” or “Defendant”) to produce documents and information in response to Plaintiff’s First Set of Documents Requests and Interrogatories. In accordance with Local Rule 37-1, the parties met and conferred to resolve this dispute but were unable to do so. (Declaration of Valerie McConnell (“McConnell Decl.”), ¶¶ 19-35.)

1 **I. PLAINTIFF'S INTRODUCTORY STATEMENT**

2 Smok has not produced the vast majority of documents and information
3 sought by Plaintiff's document requests and interrogatories, even though Smok
4 received these discovery requests six months ago. Virtually all of the few
5 documents that Smok has produced were already in Plaintiff's possession or
6 available from a public source. Smok has not produced any internal emails and very
7 few company documents. The only financial information that Smok has produced
8 regarding its infringement of Plaintiff's trademarks is limited to a single Excel
9 spreadsheet created solely for this lawsuit, which is missing key data. Smok's
10 responses to Plaintiff's interrogatories are similarly deficient.

11 In an effort to resolve this dispute, Plaintiff has sent *three* letters pursuant to
12 Local Rule 37-1, asking Smok to produce the outstanding documents and
13 information. McConnell Decl., ¶¶ 5; 13; 19. In response, Smok has asserted
14 numerous unfounded objections that improperly limit the scope of Smok's
15 obligation to search for and produce responsive documents and information. These
16 improper objections include Smok's refusal to provide information regarding its
17 AL85 or "Alien Baby" vaporizer—one of the key products at issue in this lawsuit—
18 as well as its refusal to produce any data regarding the sales of its infringing
19 products outside the United States. Smok has also objected to providing basic
20 information regarding its revenue, costs, and profits from selling its infringing
21 products, which Plaintiff needs to calculate damages in this lawsuit.

22 In addition to its blanket refusal to produce relevant documents regarding its
23 products and finances, Smok has unreasonably delayed in producing the few
24 categories of documents that it has agreed to produce. Smok has given an internal
25 deadline of June 29, 2018 to finish producing documents—which would give Smok
26 almost a year to respond to Plaintiff's *first* set of discovery. Most recently, during
27 the parties' meet and confer session on March 5, 2018, Smok revealed, for the first
28 time, that certain documents that it had previously agreed to produce do not exist.

1 *Id.*, ¶ 22. Plaintiff has reason to believe that these documents *do* exist and that their
2 absence from Smok’s production is either due to Smok’s failure to search for these
3 documents or its decision to improperly withhold these documents from production.

4 Plaintiff therefore seeks an order compelling Smok to produce all the
5 outstanding documents and information sought by Plaintiff’s discovery requests.
6 Furthermore, because Smok has already had six months to respond to Plaintiff’s
7 discovery, Plaintiff asks that the Court order Smok to produce the missing
8 documents and information within two weeks of the hearing on this motion.

9 This is an action for federal trademark infringement, breach of contract, and
10 related state law claims brought by Plaintiff against Smok and ten of its U.S.
11 distributors (the “Distributor Defendants”). Plaintiff has sold high-quality e-
12 cigarette products under the “Alien Vape” brand name since 2008 and is the owner
13 of two federally registered trademarks for “Alien Vape” (the “ALIEN VAPE®
14 marks”). Smok, a manufacturer of e-cigarette products, infringed Plaintiff’s
15 ALIEN VAPE® marks by selling an e-cigarette vaporizer under the confusingly
16 similar name, “Alien Kit.” After Plaintiff notified Smok that its “Alien Kit”
17 vaporizer infringed his ALIEN VAPE® marks, the parties entered into a settlement
18 agreement, which restricted Smok’s ability to use the “Alien” name. However,
19 Smok subsequently breached the settlement agreement by, *inter alia*, releasing a
20 new “AL85” vaporizer, which it explicitly advertised as the “Alien Baby.”

21 On September 15, 2017, Plaintiff served its first set of interrogatories and
22 document requests on Smok. McConnell Decl., ¶ 3. These discovery requests seek
23 information that is essential to Plaintiff’s trademark infringement, breach of
24 contract, and related state law claims, including: (1) Smok’s sales and marketing of
25 products under the infringing “Alien Kit Marks;” (2) Smok’s revenue, costs, and
26 profits from selling its infringing products, which Plaintiff needs to estimate
27 damages pursuant to 15 U.S.C. § 1117(a) of the Lanham Act; (3) documents
28 regarding Smok’s decision to adopt and use the “Alien Kit Marks;” and (4)

1 documents regarding Smok's performance (and lack thereof) under the settlement
2 agreement, including Smok's efforts to challenge Plaintiff's trademarks in violation
3 of the settlement agreement.

4 Plaintiff has, in good faith, given Smok several lengthy extensions for
5 responding to its discovery. Plaintiff first extended Smok's deadline for responding
6 to its discovery requests to November 22, 2017. McConnell Decl., ¶ 4. After Smok
7 failed to meet that deadline, Plaintiff extended Smok's deadline until February 2,
8 2018. *Id.*, ¶ 15. Smok has already had six months to respond to Plaintiff's
9 discovery requests. Smok is also flatly refusing to answer the **majority** of Plaintiff's
10 discovery requests due to myriad improper objections, including refusing to provide
11 information concerning the worldwide sales of its infringing products and any
12 information regarding its AL85 / "Alien Baby" vaporizer.

13 Plaintiff cannot accept Smok's request for an extension through June, nor can
14 Plaintiff accept Smok's meritless objections to providing information regarding its
15 worldwide sales or its AL85 / "Alien Baby" vaporizer. Moreover, Plaintiff cannot
16 continue to wait for Smok to produce documents. Plaintiff cannot move forward
17 with depositions or other discovery until it has basic information regarding the sales
18 of Smok's infringing products, which Smok has yet to produce. Plaintiff does not
19 have even **one** internal email that it could use in a deposition, nor does it have any
20 accounting or sales documents reflecting Smok's revenue or profits.

21 By contrast, Smok has had the benefit of Plaintiff's discovery for months.
22 Plaintiff produced responsive documents, as well as verified interrogatory
23 responses, to Smok on November 22, 2017. McConnell Decl., ¶ 5. Smok has had
24 ample time to review these materials and is now proceeding to subpoena third-party
25 witnesses. This information asymmetry is unfairly prejudicial to Plaintiff. Plaintiff
26 therefore seeks an Order compelling Smok to withdraw its improper objections and
27 produce the documents and information sought by its interrogatories and document
28 requests within two weeks of the hearing on this motion.

II. SMOK'S INTRODUCTORY STATEMENT

In the interest of brevity, Smok directs the Court's attention to Smok's Omnibus Position Regarding Document Requests (Section III.B. below) and Smok's Omnibus Position Regarding Interrogatories (Section III.E. below).

III. ARGUMENTS

A. Plaintiff's Omnibus Position Regarding Document Requests

Smok has produced only a fraction of the documents sought by Plaintiff's Requests for Production ("RFPs"). Smok's document productions have been almost entirely comprised of documents created by Smok's attorneys to assist it in proving its own defenses in this action and are almost exclusively screenshots of publicly available websites, communications with Plaintiff, PACER documents from lawsuits that Plaintiff has filed, and photographs of Plaintiff's products. In other words, Smok's production largely consists of self-serving documents that were already within Plaintiff's possession, custody, or control. The documents that are missing from Smok's productions are far more significant than the documents that have been included. The major deficiencies in Smok's productions can be summarized as follows:

First, Smok has failed to produce internal company communications. Smok is a large Chinese public company. Smok is one of the largest, if not the largest, e-cigarette company in the world. Smok has not produced even a single email exchanged between Smok employees; the only emails in Smok’s productions are emails to or from Plaintiff and a tiny subset of third parties. During the parties’ meet and confer session on March 5, 2018, Smok did not have any explanation for the paucity of internal communications in its production. McConnell Decl., ¶ 25. Counsel for Smok has admitted that Smok has produced only 14 pages of company documents. *Id.*, ¶ 35. It is not credible that Smok employees never exchanged any emails, or have any other internal documents, about Plaintiff, Plaintiff’s trademarks, the settlement agreement they supposedly negotiated and signed without any legal

1 advice, naming their own products, or any other topic relating to the claims or
2 defenses in this lawsuit. Plaintiff requests that Smok search for and produce all
3 responsive documents, which necessarily includes internal documents and
4 communications.

5 *Second*, Smok has refused to produce any documents regarding its sales and
6 marketing of the infringing products outside of the United States. Smok’s attempt
7 to unilaterally restrict discovery to sales and marketing within the U.S. must be
8 rejected. Plaintiff’s breach of contract claim is not limited to Smok’s use of the
9 “Alien” trademarks within the United States. The settlement agreement between
10 Plaintiff and Smok—which is the foundation of Plaintiff’s breach of contract and
11 related state law claims—applied “worldwide.” *See* Plaintiff’s First Amended
12 Complaint, Ex. 1 (Dkt. 165-1) at Section 3.2 (prohibiting Smok from using the
13 ALIEN mark on any products similar to Sarieddine’s Alien Vape products and from
14 applying “anywhere in the world” for any trademark that includes the term
15 “ALIEN”) and Section 9 (“The scope of this Agreement shall be worldwide.”).

16 Nor are Plaintiff’s Lanham Act claims limited to acts of trademark
17 infringement that occurred within the United States. The Lanham Act can be used
18 to reach extraterritorial conduct. *See, e.g., Wells Fargo & Co. v. Wells Fargo*
19 *Express Co.*, 556 F.2d 406, 428 (9th Cir. 1977) (“[T]he extraterritorial coverage of
20 the Lanham Act should be gauged not so much by the locus of the activity sought to
21 be reached . . . as by the nature of its effect on that commerce which Congress may
22 regulate.”); *Aurora World, Inc. v. TY Inc.*, 719 F. Supp. 2d 1115, 1142 (C.D. Cal.
23 2009) (“To establish that it is appropriate to apply the Lanham Act
24 extraterritorially, [plaintiff] must first show that there is ‘some effect on American
25 foreign commerce.’”) (citing *Reebok Int’l Ltd. v. Marnatech Enters., Inc.*, 970 F.2d
26 552, 544-57 (9th Cir. 1992)). This Court has not issued any orders limiting
27 Plaintiff’s Lanham Act claims to Smok’s U.S. sales, and such an order would not
28 be appropriate at this stage in the proceedings. Plaintiff is entitled to establish that

1 the Lanham Act should be applied extraterritorially by offering evidence
2 demonstrating that Smok's infringing sales abroad affected American foreign
3 commerce. But to make this threshold showing, Plaintiff needs to conduct
4 discovery regarding Smok's infringing sales abroad. Smok's refusal to provide any
5 information regarding its sales abroad, in the absence of any court order limiting the
6 scope of Plaintiff's Lanham Act or breach of contract claims, is improper.

7 *Third*, Smok has refused to search for and produce documents regarding all
8 of the infringing products in this lawsuit. Plaintiff's RFPs seek documents
9 regarding products that Smok sold under the "Alien Kit Marks," which is defined as
10 the "marks used by SMOK that are at issue in this Action and are used to identify
11 certain of its vaporizer products, the: Alien Kit, Alien Baby, AL85, Alien 2,
12 AL220, and AL230." Smok has objected to searching for documents regarding
13 these products and has instead limited its search to products specifically named
14 "Alien" or "AL85." Because Plaintiff's trademark infringement and breach of
15 contract claims broadly cover all products that Smok sold under names that are
16 "confusingly similar" to "Alien," Smok's unilateral decision to limit discovery to
17 products named "Alien" or "AL85" is improper. Moreover, the few documents that
18 Smok has produced demonstrate that Smok *did* sell products under the excluded
19 names. *See* McConnell Decl., ¶ 28, Ex. 15 (Smok advertisement for the "AL85 Kit
20 – AKA Alien Baby.") Smok's own website demonstrates that Smok continues to
21 sell products under the Alien Kit Marks. McConnell Decl. ¶ 29, Ex. 16. In
22 addition, Smok's Twitter account continues, as of March 13, 2018, to display a post
23 promoting its AL85 vaporizer using the #alienbaby hashtag. *Id.*, ¶ 36, Ex. 20.
24 Smok's Instagram account likewise displays, as of March 13, 2018, promotions for
25 the AL85 vaporizer using the #alienbaby hashtag, and Smok has published these
26 #alienbaby posts to its 350,000 followers, even after this lawsuit was filed. *Id.*, ¶
27 36, Ex. 21.

28 Plaintiff therefore requests that Smok search for and produce all documents

1 regarding products sold under *any* name that is confusingly similar to “Alien,”
2 including, but not limited to the following: “Alien Kit” aka AL220, Alien Mod,
3 “Alien Baby” aka AL85, and “Alien 2” aka AL230.

4 *Fourth*, Smok has refused to produce documents regarding its revenue,
5 profits, and costs from infringing Plaintiff’s trademarks, which Plaintiff needs to
6 estimate damages under the Lanham Act, 15 U.S.C. § 1117(a). The only document
7 containing any information regarding Smok’s revenue and profits from infringing
8 Plaintiff’s trademarks is a single Excel spreadsheet, SMOK002406. This
9 spreadsheet appears to have been created specifically for this lawsuit and comes
10 with no supporting documents or details to authenticate the self-serving numbers.
11 Among other problems, this spreadsheet is limited to sales in the United States,
12 which is improper because Plaintiff’s Lanham Act and breach of contract claims are
13 not so limited.

14 Perhaps even more troublingly, the Excel spreadsheet at SMOK002406 does
15 not contain any data for Smok’s AL85 / “Alien Baby” vaporizer. Smok has taken
16 the untenable position that it is not required to produce *any* financial data regarding
17 its AL85 product because Smok “does not interpret” Plaintiff’s Complaint as
18 claiming that its AL85 vaporizer infringes Plaintiff’s Alien Vape marks.
19 McConnell Decl., ¶ 35, Ex. 19. But even a cursory reading of Plaintiff’s First
20 Amended Complaint demonstrates that Smok’s interpretation is groundless; there
21 are numerous allegations that Smok’s AL85 brand infringes Plaintiff’s Alien Vape
22 marks. *See*, First Amended Complaint, Dkt. 165, at ¶¶ 62-67 (alleging that Smok’s
23 promotion of its vaporizer under the names AL85 and “Alien Baby” infringed
24 Plaintiff’s trademarks); ¶¶ 78-79 (alleging that Vapetrik, one of Smok’s
25 distributors, infringed Plaintiff’s trademarks by selling and promoting the AL85
26 vaporizer) and ¶ 84 (asking for an injunction prohibiting Smok from selling or
27 advertising its AL85 vaporizer).

28 Smok’s position that its AL85 vaporizer does not infringe Plaintiff’s Alien

1 Vape Marks wholly ignores its marketing campaign for this product and the history
2 behind the “AL85” name. As Plaintiff explained at length in its Motion for a
3 Preliminary Injunction, the “AL” in “AL85” refers to “Alien.” *See* Dkt. 71-1 at pp.
4 4-6. And even after changing the official name of the vaporizer from “Alien Baby”
5 to AL85, Smok has continued to use the “Alien Baby” name to promote the AL85
6 product. Indeed, Smok’s Twitter and Instagram accounts continue to display posts
7 promoting the AL85 vaporizer using the #alienbaby hashtag. McConnell Decl., ¶
8 36, Exs. 20-2

9 Contrary to Smok’s position, Plaintiff *can* maintain a trademark infringement
10 claim based on the fact that Smok and its distributors nicknamed the AL85 product
11 the “Alien Baby” and marketed its product under this name. Liability for trademark
12 infringement is not limited to “official” product names but can include nicknames.
13 *See, e.g., Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.*, 408 F. Supp.
14 1219, 1229 (D. Colo. 1976) (affirming defendant tire manufacturer’s liability for
15 trademark infringement based on defendant’s use of the infringing nickname
16 “BIGFOOT” for its tires). Furthermore, if Smok’s position, that it has never sold a
17 product named “Alien Baby” were true, then surely it would not be unduly
18 burdensome or very difficult for it to search for and produce every internal
19 document that uses the term “Alien Baby”.

20 In any event, Smok cannot satisfy its discovery obligations by producing the
21 Excel spreadsheet at SMOK002406, which is an incomplete and self-serving
22 “summary” of its revenue and profits from infringing Plaintiff’s trademarks. At the
23 parties’ meet and confer session on March 5, 2018, Smok stated that it was willing
24 to produce “some” underlying cost documents that it used to create this spreadsheet,
25 but it did not commit to producing its underlying revenue or profit documents.
26 McConnell Decl., ¶ 33. However, Plaintiff is entitled to review *all* underlying
27 documents that Smok used to create this spreadsheet so that Plaintiff can investigate
28 the veracity of these numbers. *See, e.g., Wahoo Int’l, Inc. v. Phix Doctor, Inc.*, No.

1 13cv1395-GPC (BLM), 2014 U.S. Dist. LEXIS 98044, at *20-21 (S.D. Cal. July
2 18, 2014) (plaintiff was entitled to underlying financial documents where defendant
3 only produced an Excel spreadsheet reflecting total sales). Plaintiff therefore asks
4 that Smok produce all underlying financial documents that it used to create this
5 spreadsheet. Plaintiff further asks that Smok withdraw its improper objections to
6 producing data regarding its worldwide sales and its AL85 / “Alien Baby” product
7 because Plaintiff’s claims encompass Smok’s worldwide sales of all infringing
8 “Alien” products.

9 *Fifth*, Smok has failed to produce relevant communications with third parties
10 regarding this lawsuit, even though these communications are sought by numerous
11 RFPs. *See* RFP Nos. 21, 26, 28, 44-47, and 61. Smok’s communications with third
12 parties regarding Plaintiff and its trademarks are relevant to Plaintiff’s claims for
13 breach of contract and breach of the implied covenant of good faith and fair
14 dealing, which allege that Smok worked with third parties to challenge Plaintiff’s
15 Alien Vape marks. The communications missing from Smok’s production include
16 Smok’s communications with Big Bang Vape Co., another e-cigarette company
17 accused of infringing Plaintiff’s trademarks, and its communications with Vapor
18 World, a former Smok distributor. Plaintiff knows that Smok communicated with
19 these third parties regarding this lawsuit based on evidence produced thus far. For
20 example, Smok’s CEO told Plaintiff in writing that Smok has been communicating
21 with “Alien Kiss”—the brand name of Big Bang—about invalidating Plaintiff’s
22 trademarks. McConnell Decl., ¶ 23, Ex. 13. Therefore, Plaintiff reasonably
23 expects that Smok’s communications with Big Bang exist and should be produced.
24 Likewise, Plaintiff knows that Smok communicated with Vapor World about this
25 lawsuit. *Id.*, ¶ 24, Ex. 14.

26 During the parties’ meet and confer session on March 5, 2018, Smok
27 revealed for the first time that it has “no written record” of these missing third-party
28 communications. *Id.*, ¶ 22. However, documents produced in this lawsuit

1 demonstrate Smok employees essentially exclusively use email, WeChat, and
2 Skype to communicate with individuals outside the company. *Id.*, ¶ 23, Ex.13. This
3 is consistent with Plaintiff's own experience, as the vast majority of Plaintiff's
4 communications with Smok occurred through these means. *Id.*, ¶ 23. This is also
5 consistent with the fact that Smok is a Chinese company and its communications
6 with third parties encounter a language barrier and a significant time zone
7 difference. Furthermore, Vapor World has told Plaintiff's counsel telephonically
8 that it had responsive written Skype and WeChat conversations with Smok
9 employees. (See McConnell Decl.). Plaintiff therefore believes Smok has
10 additional responsive communications with third parties, including, but not limited
11 to, communications with Big Bang and Vapor World, that it has chosen not to
12 produce.

13 The sixth major problem is that Smok had agreed to produce documents in
14 response to numerous RFPs—Nos. 3, 5, 6, 7, 8, 9, 12 13, 14, 15, 17, 21, 23, 27, 28,
15 30, 34, 37, 38, 53—but has not yet done so. During the parties' meet and confer
16 session, Smok stated that it will “try” to produce these documents by the end of
17 March but left open the possibility that it will not finish producing these documents
18 until June 29, 2018. McConnell Decl., ¶ 21. Smok's requested deadline is wholly
19 unreasonable and gives Smok almost a year to respond to Plaintiff's *first* set of
20 discovery. At Smok's current pace, Plaintiff will not have time to take depositions
21 or complete other essential discovery tasks, including translating Smok's
22 documents, written in Mandarin, by the Court's discovery deadline. Judge Fischer
23 has been adamant that she will not extend the discovery deadline for any reason, so
24 this delay will end up being extraordinarily prejudicial to Plaintiff.

25 The seventh and final major problem is that Smok has refused to produce
26 numerous documents based on relevancy objections based on the faulty argument
27 that the Settlement Agreement was terminated in early 2017, so documents related
28 to breaches of the Settlement Agreement after that will not be searched for or

1 produced. The Settlement Agreement was *never* terminated. Plaintiff terminated
2 one discrete clause of the Settlement Agreement: the distribution clause. Smok
3 purported to terminate the entire Agreement on May 31, 2017 via a letter to
4 Plaintiff's counsel, but that purported termination was ineffectual. The Settlement
5 Agreement contains no provision at all for Smok to terminate the contract. Indeed,
6 it would be incredibly unusual for a Settlement Agreement to be drafted to allow
7 the infringer (here, Smok) to simply terminate it after signing it. Furthermore,
8 despite Smok's assertions, the Settlement Agreement does have clauses regarding
9 duration and survivability. Section 3.3 requires that: "SMOK shall forever refrain
10 from using ALIEN or any mark containing the term ALIEN or any similar term in
11 connection with any products or services." Section 3.3 (emphasis added). Section
12 6.2 further holds that "This Agreement will remain in effect following expiration of
13 the Distribution Term." The circumstances of the Settlement Agreement indicate
14 that the prohibition of Smok using the Alien marks lasts at least as long as
15 Plaintiff's Alien trademarks remain registered and protectable. Thus, the
16 abandonment or cancellation of Sarieddine's trademark rights is the only condition
17 that could theoretically terminate Smok's agreement to restrain its use of Alien.
18 Accordingly, Smok should not be allowed to refuse to search for, or to withhold
19 documents, based on the erroneous idea that the Settlement Agreement is
20 terminated.

21 The significant gaps in Smok's production suggest that Smok has either
22 failed to perform a diligent search for responsive documents, that Smok has
23 improperly withheld numerous responsive documents, or that Smok has destroyed
24 documents. To the extent that Smok has limited its search for responsive
25 documents to documents written in English, such a search is unacceptable. Given
26 that Smok is based in China, Plaintiff reasonably expects that many responsive
27 documents are written in Mandarin, and these responsive documents must be
28 produced. To the extent that Smok has withheld documents on attorney-client, joint

1 defense, or common interest privilege grounds, Smok must produce a detailed
2 privilege log. And to the extent that Smok has withheld responsive documents on
3 any other grounds, including its objections to producing relevant documents
4 regarding its “Alien Baby” vaporizer, Smok should withdraw these improper
5 objections and produce responsive documents forthwith.

6 Plaintiff therefore requests a Court Order requiring Smok to produce all
7 outstanding responsive documents within two weeks of the hearing on this motion.
8 Plaintiff’s Document Requests, and the relevant portions of Smok’s responses
9 thereto, are identified below.

10 **B. Smok’s Omnibus Position Regarding Document Requests**

11 1. Smok’s responses and ongoing document production comply with
12 Smok’s obligations under the Federal Rules of Civil Procedure. Smok has
13 performed reasonable searches for responsive documents (including internal
14 documents and documents in Mandarin). Smok’s objections to producing
15 documents related to trademark use outside the United States are well-founded, as
16 is Smok’s objection to Sarieddine’s overbroad definition of “Alien Kit Marks.”
17 Smok has produced sufficient documentation to disclose its revenues, costs, and
18 profits for Smok’s Alien goods in the United States.

19 2. Smok has searched for and produced internal documents responsive to
20 Sarieddine’s document requests. Smok’s ongoing search has included internal
21 communications, as well as documents in Mandarin. Smok’s production of internal
22 documents continues, and Smok expects to supplement its production by March 30,
23 2018. In its positions below regarding specific document requests, Smok will
24 specify where its ongoing search has or has not revealed additional internal
25 documents. But Plaintiff’s belief that additional documents must exist does not
26 mean that any such documents are in Smok’s possession, custody or control.

27 3. Smok is not obligated to produce documents or information related to
28 trademark use outside the United States (including financial documents and

1 information related to such use). As a general matter, the Lanham Act applies only
2 to conduct within the United States. Extraterritorial application is the exception,
3 rather than the rule. And Sarieddine has not proven any exception here. All he has
4 proven is that he is a trademark troll, using an ALIEN VAPE registration obtained
5 under (at best) questionable circumstances to impose massive discovery costs on
6 anybody using the word “Alien” in the e-cigarette industry, despite Sarieddine’s
7 ALIEN VAPE marks having coexisted for years with dozens of other “Alien”
8 marks and generic uses of “alien” on alternative smoking goods and services,
9 including the following:

- 10 • ALIEN VISIONS e-liquid
- 11 • ALIEN VAPOR e-liquid and online retail store services featuring e-
12 cigarette products
- 13 • ALIEN PISS e-liquid
- 14 • ALIEN KISS e-liquid
- 15 • ALIEN e-liquid
- 16 • ALIEN BLOOD e-liquid
- 17 • ALIEN NECTAR e-liquid
- 18 • ALIEN OOZE e-liquid
- 19 • NATIVE ALIEN VAPOR e-liquid
- 20 • ALIEN-CLOUDVAPES distribution and wholesale services featuring
21 e-cigarette goods
- 22 • ALIEN THROAT PUNCH e-liquid
- 23 • PURPLE ALIEN e-liquid
- 24 • ALIEN MILK e-liquid
- 25 • ALIEN INVADER VAPOR e-liquid
- 26 • ALIEN INVADER e-cigarette devices
- 27 • ETALIENS e-cigarette devices
- 28 • ALIEN ANT e-cigarette devices

- 1 • ALIENWARE e-cigarette accessories
- 2 • ALIEN vapor hookas
- 3 • ALIEN hookah funnel bowls
- 4 • ALIENSHPAES hookah pipes
- 5 • ALIEN PHUNNEL hookah bowls
- 6 • ALIEN MINI PHUNNEL hookah bowls
- 7 • ALIEN FLASHBACK hookah bowls
- 8 • ALIEN hookah papies
- 9 • FOGSLORD-brand alien wire for e-cigarette goods
- 10 • XFKM-brand alien wire for e-cigarette goods
- 11 • DEMON KILLER-brand alien wire for e-cigarette goods
- 12 • LIGHNING VAPES-brand alien wire rods for e-cigarette goods
- 13 • FOCUSECIG-brand alien wire rods for e-cigarette goods
- 14 • KUKEN TECH-brand alien wire for e-cigarette goods
- 15 • ADVERKEN-brand alien wire for e-cigarette goods
- 16 • ROFVAPE-brand alien wire shots for e-cigarette goods
- 17 • NINJA WIRE-brand alien wire for e-cigarette goods
- 18 • COILOLOGY-brand alien coils for e-cigarette goods
- 19 • CENTRAL IOWA VAPORS-brand alien wire for e-cigarette goods
- 20 • PURE COILS-brand alien coils for e-cigarette goods
- 21 • OHMLANDCOILS-brand alien coils for e-cigarette goods
- 22 • AKATTAK-brand alien wire for e-cigarette goods
- 23 • VPDAM-brand alien coils for e-cigarette goods
- 24 • PUFF N STUFF-brand alien wire for e-cigarette goods
- 25 • MEDUSA COILS-brand alien coils for e-cigarette goods

26 In order for the Lanham Act to apply extraterritorially, “first there must be
27 some effect on American foreign commerce; second, the effect must be sufficiently
28 great to present a cognizable injury to plaintiffs under the federal statute; and third,

1 the interests of and links to American foreign commerce must be sufficiently strong
2 in relation to those of other nations to justify an assertion of extraterritorial
3 authority.” *Aurora World*, 719 F.Supp.2d at 1142. It is undisputed that Smok has
4 made significant sales within the United States. So it is unreasonable to expect that
5 Smok’s foreign sales would have such a great effect on American foreign
6 commerce as to present a cognizable injury to Sarieddine under the Lanham Act.
7 Nor is it reasonable to expect that American foreign commerce has sufficiently
8 strong interests in and links to Smok’s foreign sales to justify an assertion of
9 extraterritorial authority. Moreover, Sarieddine has shown absolutely no cognizable
10 injury as a result of Smok’s alleged infringement (let alone alleged infringement
11 outside the United States). Sarieddine was required by Federal Rule of Civil
12 Procedure 26(a)(1)(A)(iii) to provide “a computation of each category of damages
13 claimed.” Yet Sarieddine’s initial disclosures—last supplemented on March 14,
14 2018—do not mention any injury traceable to Smok’s foreign sales. In fact,
15 Sarieddine’s disclosures do not indicate any lost profits at all. If anything, discovery
16 to date indicates that Sarieddine’s business grew as a result of the purported
17 confusion between Sarieddine’s business and Smok’s.

18 4. Nor does Sarieddine’s contract claim give him the right to documents
19 related to Smok’s trademark use outside the United States. It is undisputed that
20 Smok has used the mark SMOK ALIEN in the United States, which is sufficient for
21 Sarieddine’s claims that Smok breached the purported contract. Thus, requiring
22 Smok to search for and produce documents related to its trademark use in every
23 other country in the world would not be proportional to the needs of the case. Smok
24 does business worldwide, and should not be forced to search for and produce this
25 duplicative documentation of its use of SMOK ALIEN. And even if Sarieddine
26 were entitled to extraterritorial documents on the basis of his breach of contract
27 claim, he would not be entitled to discover Smok’s extraterritorial financials, as the
28 breach of contract claim does not allow for profit disgorgement.

1 5. Smok properly objected to Sarieddine's overbroad definition of the
2 term "Alien Kit Marks." Smok limited the definition of "Alien Kit Marks" to mean
3 only "Alien" and "AL85" because those are the product names Smok has uses for
4 the products at issue in this action. While there have been passing references to the
5 phrase "alien baby" in a few advertisements and promotions for Smok's AL85
6 goods, generally before launching the product in January 2017, Smok never
7 adopted the phrase "alien baby" in the ordinary course of business as the name of
8 any product. As to AL230 or "Alien 2," Smok has never used "AL230" or "Alien
9 2" in connection with any product sold or offered for sale. *See* Declaration of Freda
10 Wong, ¶ 2-3.

11 6. In a similar vein, Smok properly refused to provide financial
12 documents or information regarding its AL85 goods. As discussed above, Smok's
13 AL85 product was not named the "alien baby," and use of that phrase in connection
14 with the AL85 has been scant. Sarieddine's case law supporting trademark
15 infringement for nicknames is inapposite. In *Big O Tire Dealers*, the defendant
16 engaged in "a massive advertising program using television commercials, magazine
17 and newspaper advertising and point of sale material, all using the word
18 BIGFOOT" as a nickname for the defendant's tires. 408 F.Supp. at 1223. The
19 defendant spent \$5,000,000 (in 1974 dollars) promoting this nickname. This is a far
20 cry from the sporadic use of "alien baby" in the case at hand, including a file path
21 to a product photograph (*see* First Amended Complaint, Dkt. No. 165, ¶ 58) and
22 predominantly pre-sale emails and Instagram posts prominently featuring the actual
23 product name (*see id.* at ¶¶ 59-60).

24 7. Further, Sarieddine's newfound position that AL85 itself is
25 confusingly similar to ALIEN VAPE strains credulity. Nowhere in the cited portion
26 of Sarieddine's Motion for Preliminary Injunction does he actually contend that the
27 "AL" in "AL85" refers to "Alien." Moreover, when he complained to Smok about
28 the phrase "alien baby" in early 2017, Sarieddine did not object to Smok's use of

1 AL85. *See* Declaration of David T. Van Der Laan, ¶ 2, Ex. A. Sarieddine’s request
2 was as follows: “don’t call the al85 alien baby.” *Id.* This makes sense, as there is no
3 good-faith argument that AL85 is confusingly similar to Alien Vape. So Smok
4 should not be compelled to produce AL85 financials on this basis, either.

5 8. Smok’s ongoing financial document disclosure satisfies Smok’s
6 discovery obligations. Smok has produced a spreadsheet (bates-labeled
7 SMOK002406) showing its revenues, costs, and profits for Alien goods sold in the
8 United States. Contrary to Sarieddine’s presumption that Smok relied on other
9 documents to create the spreadsheet, Smok created it by querying a report its
10 internal electronic accounting system for Alien goods in the United States.
11 Regarding Sarieddine’s request for underlying financial and accounting documents,
12 it is not clear to Smok what Sarieddine means by “underlying,” and whether
13 “underlying” documents are a subset of the overbroad universe of all documents
14 reflecting any of Smok’s financial transactions for the marks at issue. Sarieddine is
15 not entitled to discover Smok’s financials worldwide, nor is he entitled to discover
16 Smok’s financials with respect to all of Smok’s products. Sarieddine’s case law in
17 support of his request for “*all* underlying documents that Smok used to create this
18 spreadsheet” is inapposite. In *Wahoo Int’l*, the defendant’s spreadsheets included
19 only “total sales and some categories of expenses.” 2014 WL 2573400, *1. Here, on
20 the other hand, Smok’s spreadsheet lists each US sale individually, and identifies
21 the customer, revenue, cost, and profit for each such sale. In addition to this
22 spreadsheet, Smok has produced additional documentation of its advertising and
23 promotion costs, and will produce additional documents related to other costs.

24 9. Regarding Sarieddine’s various requests for third-party
25 communications, Smok has produced responsive documents. Smok is aware of
26 some additional communications between Smok and third parties that are
27 responsive to one or more of Sarieddine’s discovery requests, but does not have
28 documents reflecting these communications. Smok’s process of gathering and

1 producing documents is ongoing. Smok acknowledges that it may have
2 communicated with Big Bang or with Vapor World, and will produce any
3 documents in its possession, custody, or control related to any such
4 communications. Smok is not withholding any non-privileged documents related to
5 its communications with others related to this case.

6 10. With respect to the timing of Smok's production, Smok has worked
7 diligently to gather and produce responsive documents. Smok is making every
8 effort to supplement its production on March 30, 2018 but additional responsive
9 documents may be located as the case progresses. And if Smok locates additional
10 potentially responsive documents in Mandarin, then Smok's counsel will need time
11 to have those documents translated and then review them prior to production. The
12 lengthy discovery timeline in this case was based in large part on Sarieddine's
13 position at the scheduling conference in this case that gathering documents from
14 China would be time-consuming. Sarieddine cannot feign surprise that his
15 prediction came true. Smok's diligent effort has resulted in its production of 56
16 documents on December 1, 2017, 291 documents on December 22, 2017, 504
17 documents on February 2, 2018, and 323 documents on February 16, 2018.

18 11. It is troubling that Sarieddine claims to have a "major problem" with
19 an objection that Smok never raised. Specifically, Smok did not object to the
20 relevancy any request on the basis that the so-called "Settlement Agreement" was
21 terminated.

22 12. Finally, Smok will produce a privilege log for any responsive,
23 privileged documents dated prior to Sarieddine's filing of this lawsuit.

24
25 **C. Document Requests That Are in Dispute**

26 **REQUEST FOR PRODUCTION NO. 1:**

27 All Documents that support or refute any position that SMOK intends to or
28 may take against Sarieddine in this Action.

1

2 **RESPONSE TO REQUEST FOR PRODUCTION NO. 1:**

3 Smok objects to this Request on the grounds that it is overbroad, unduly
4 burdensome, and not proportional to the needs of the case because it seeks
5 documents related to positions that Smok does not intend to take and it seeks to
6 force Smok's counsel to make legal determinations. Smok will not search for or
7 produce documents that support or refute positions that Smok does not intend to
8 take. Smok further objects to this Request on the grounds that it seeks documents
9 protected by the attorney-client privilege, the attorney work product doctrine, or the
10 common interest privilege Smok will produce non-privileged documents—if any—
11 that support any position that Smok intends to take in this Action.

12 **PLAINTIFF'S POSITION:**

13 Smok has not produced all documents within its possession, custody, or
14 control that are responsive to this Request. Smok produced a limited volume of
15 responsive documents, primarily consisting of advertisements for Plaintiff's
16 products, documents from the website of the U.S. Patent and Trademark Office
17 ("USPTO") regarding Plaintiff's trademarks, and documents downloaded from
18 PACER. It is not credible that the documents pertaining to the positions that Smok
19 intends to take in this lawsuit are limited to advertisements and publicly available
20 documents. Smok has not produced any internal emails and few company
21 documents. Nor has Smok produced documents regarding its affirmative defenses
22 (*see, e.g.*, RFP Nos. 52-54 and 81, discussed *infra*). Plaintiff therefore requests that
23 Smok produce all documents that are responsive to this Request within two weeks
24 of the hearing on this motion.

25 **SMOK'S POSITION:**

26 Sarieddine's characterization of Smok's production in response to this
27 request ignores the many documents Smok produced that show widespread third-
28 party use of the word "alien" in connection with alternative smoking goods and

1 services, both generically (for a type of wire or coil used in vaporizers) and as part
2 of a trademark or service mark.

3 Smok is in the process of gathering additional responsive documents and is
4 endeavoring to make a further production responsive to this request by March 30,
5 2018.

6 Finally, in the interest of brevity, Smok incorporates by reference paragraph
7 2 (regarding internal documents) of Smok's Omnibus Position Regarding
8 Document Requests.

9

10 **REQUEST FOR PRODUCTION NO. 3:**

11 Documents sufficient to identify all employees, officers, or principals of
12 SMOK that were responsible for naming any goods bearing any of SMOK's Alien
13 Kit Marks.

14 **RESPONSE TO REQUEST FOR PRODUCTION NO. 3:**

15 Smok objects to this Request on the grounds that responsible is vague and
16 ambiguous. Smok interprets "responsible" to mean "having an obligation to do
17 something, as part of one's job or role." Smok will produce non-privileged
18 documents—if any—sufficient to identify all employees, officer, or principals of
19 Smok that had an obligation to name any goods bearing any of Smok's Alien Kit
20 Marks as part of their job or role.

21 **PLAINTIFF'S POSITION:**

22 Despite agreeing to produce documents in response to this Request, Smok
23 has yet to produce any responsive documents. This is a narrow request, which
24 simply asks for documents identifying the employees who were responsible for
25 naming the infringing goods at issue in this lawsuit. Plaintiff needs this basic
26 information to identify the correct Smok employees for depositions.

27 Plaintiff also asks that Smok withdraw its improper objection to producing
28 documents regarding its "Alien Kit Marks." Plaintiff's RFPs define "Alien Kit

1 Marks” as including Smok’s Alien Kit, Alien Baby, AL85, Alien 2, AL220, and
2 AL230 products. In its General Objections, Smok objected to the definition of
3 “Alien Kit Marks” and stated that it will only search for documents regarding
4 products specifically named “Alien” or “AL85.” This limitation is wholly
5 improper. Plaintiff’s trademark infringement and breach of contract claims concern
6 *all* products sold under the “Alien” name or “confusingly similar” names. *See* First
7 Amended Complaint (Dkt. 165) at ¶¶ 10, 44, 72. The names that Smok used to sell
8 its infringing products were not limited to “Alien” or “AL85.” The few documents
9 that Smok has produced demonstrate that it used the infringing name “Alien Baby”
10 to sell e-cigarette products. McConnell Decl., ¶ 28, Ex. 15. In addition, Smok’s
11 Twitter and Instagram accounts continue to display posts promoting its AL85
12 vaporizer using the #alienbaby hashtag, that Smok was posting to its own social
13 media long even after this litigation had begun. *Id.*, ¶ 36, Exs. 20-21.

14 Plaintiff therefore asks that Smok withdraw the foregoing objection and
15 produce all documents that are responsive to RFP No. 3 within two weeks of the
16 hearing on this motion.

17 **SMOK’S POSITION:**

18 Smok has searched for but not located non-privileged documents responsive
19 to this request.

20 In the interest of brevity, Smok incorporates by reference paragraph 5
21 (regarding the definition of “Alien Kit Marks”) of Smok’s Omnibus Position
22 Regarding Document Requests.

23
24 **REQUEST FOR PRODUCTION NO. 4:**

25 All Documents concerning SMOK’s trademark applications anywhere in the
26 world that contain the term “Alien” for electronic cigarette products, including
27 vaporizers or e-liquids.

28 **RESPONSE TO REQUEST FOR PRODUCTION NO. 4:**

1 Smok objects to this Request on the grounds that it seeks documents
2 protected by the attorney-client privilege, the attorney work product doctrine, or the
3 common interest privilege Smok will produce non-privileged documents—if any—
4 concerning Smok’s trademark application or applications that contain the term
5 “Alien” for electronic cigarette products.

6 **PLAINTIFF’S POSITION:**

7 Despite agreeing to produce documents in response to this Request, Smok
8 has produced only a single trademark application, which is publicly available on the
9 USPTO’s website. During the parties’ meet and confer session on March 5, 2018,
10 Smok acknowledged that its response was deficient and agreed to produce
11 documents regarding its trademark applications for the term “Alien” that it filed in
12 China. McConnell Decl., ¶ 21. However, Plaintiff notes that this Request calls not
13 only for the applications themselves, but also any internal documents regarding
14 trademark applications. Plaintiff requests that Smok search for and produce
15 internal documents regarding the trademark application that Smok has disclosed, as
16 well as any other trademark applications for the mark “Alien” on e-cigarette
17 products anywhere in the world, especially given that the Settlement Agreement
18 explicitly prevents Smok from applying for any “Alien” trademarks worldwide.

19 **SMOK’S POSITION:**

20 Sarieddine mischaracterizes Smok’s production, which also includes Chinese
21 trademark applications responsive to this request. Smok has agreed to search for
22 additional documents responsive to this request, and will endeavor to produce any
23 such documents by March 30, 2018.

24
25 **REQUEST FOR PRODUCTION NO. 5:**

26 All Documents relating to searches or investigations concerning the
27 availability of SMOK’s Alien Kit Mark as a trademark or service mark conducted
28

1 by or on behalf of SMOK.

2 **RESPONSE TO REQUEST FOR PRODUCTION NO. 5:**

3 Smok objects to this Request on the grounds that it is overbroad, unduly
4 burdensome, and not proportional to the needs of the case because it seeks
5 documents unrelated to trademark use in the United States. Smok will not search
6 for or produce documents relating to searches or investigations concerning the
7 availability of Smok's Alien Kit Mark as a trademark or service mark outside the
8 United States. Smok further objects to this request on the grounds that it seeks
9 documents protected by the attorney-client privilege or the attorney work product
10 doctrine. Smok will produce non-privileged documents—if any—relating to
11 searches or investigations concerning the availability of Smok's Alien Kit Mark as
12 a trademark or service mark in the United States.

13 **PLAINTIFF'S POSITION:**

14 RFP No. 5 seeks documents relating to Smok's selection and use of names
15 for its Alien-branded products, which infringe Plaintiff's trademarks. The process
16 that Smok used to select these names—including any trademark searches or other
17 investigations—is relevant to Plaintiff's claim that Smok willfully infringed
18 Plaintiff's Alien Vape trademarks. Plaintiff has alleged that Smok adopted the
19 "Alien Kit" name for its vaporizer with full knowledge of Plaintiff's Alien Vape
20 products and superior trademark rights. *See* First Amended Complaint (Dkt. 165)
21 at ¶¶ 10, 72, 104. The documents sought by this Request are also relevant to
22 Plaintiff's breach of contract claim, which alleges that Smok used the Alien Kit
23 Marks in violation of the settlement agreement. To date, Smok has produced no
24 responsive documents to this request.

25 Smok has unjustifiably limited its response to RFP No. 5 in two critical
26 ways. First, Smok stated that it will only produce documents pertaining to its use
27 of "Alien" trademarks in the United States. This limitation is unacceptable because
28 Plaintiff's breach of contract claim is not limited to Smok's use of the "Alien"

1 trademarks within the United States. The settlement agreement between Plaintiff
2 and Smok applied “worldwide.” *See* Plaintiff’s First Amended Complaint, Ex. 1
3 (Dkt. 165-1) at Section 3.2 (prohibiting Smok from using the ALIEN mark on any
4 products similar to Sarieddine’s Alien Vape products and from applying “anywhere
5 in the world” for any trademark that includes the term “ALIEN”) and Section 9
6 (“The scope of this Agreement shall be worldwide.”).

7 Nor are Plaintiff’s Lanham Act claims limited to acts of trademark
8 infringement that occurred in the United States. As previously discussed, the
9 Lanham Act can be used to reach extraterritorial conduct. Plaintiff is entitled to
10 establish that the Lanham Act should be applied extraterritorially by offering
11 evidence demonstrating that Smok’s infringing sales abroad affected American
12 foreign commerce. *See, e.g., Aurora World, Inc. v. TY Inc.*, 719 F. Supp. 2d at
13 1142. But to make this threshold showing, Plaintiff needs to conduct discovery
14 regarding Smok’s infringing sales outside of the U.S.

15 Second, Smok has refused to produce documents regarding all products sold
16 under the “Alien Kit Marks,” which include Smok’s Alien Kit, Alien Baby, AL85,
17 Alien 2, AL220, and AL230 products, and has instead stated that it will only search
18 for documents regarding products specifically named “Alien” or “AL85.” This
19 limitation, which Smok asserted in its General Objections, is wholly improper.
20 Plaintiff’s trademark infringement and breach of contract claims concern *all*
21 products sold under the “Alien” name or “confusingly similar” names. *See* First
22 Amended Complaint (Dkt. 165) at ¶¶ 10, 44, 72. As previously discussed, the
23 names that Smok used to sell its infringing products were not limited to “Alien” or
24 “AL85.” McConnell Decl., ¶¶ 28-30; 36.

25 Plaintiff therefore asks that Smok withdraw the foregoing objections and
26 produce all documents that are responsive to RFP No. 5 within two weeks of the
27 hearing on this motion.

28 **SMOK’S POSITION:**

1 Smok has searched for but not located non-privileged documents responsive
2 to this request.

3 In the interest of brevity, Smok incorporates by reference the following
4 paragraphs from Smok's Omnibus Position on Document Requests: 3-4 (regarding
5 trademark use outside the United States) and 5 (regarding the definition of "Alien
6 Kit Marks").

7

8 **REQUEST FOR PRODUCTION NO. 6:**

9 All Documents concerning any formal or informal research (including, but
10 not limited to, searches, investigations, surveys, reports, or market studies)
11 conducted by or on behalf of SMOK, or of which SMOK has knowledge,
12 pertaining to any of SMOK's Alien Kit Marks.

13 **RESPONSE TO REQUEST FOR PRODUCTION NO. 6:**

14 Smok objects to this Request on the grounds that it is overbroad, unduly
15 burdensome, and not proportional to the needs of the case because it seeks
16 documents unrelated to trademark use in the United States. Smok will not search
17 for or produce documents concerning formal or informal research pertaining to any
18 of Smok's Alien Kit Marks outside the United States. Smok further objects to this
19 Request on the grounds that it seeks documents protected by the attorney-client
20 privilege, the attorney work product doctrine, or the common interest privilege.
21 Smok will produce non-privileged documents—if any—concerning formal or
22 informal research pertaining to any of Smok's Alien Kit Marks in the United States.

23 **PLAINTIFF'S POSITION:**

24 RFP No. 6 seeks documents relating to Smok's selection and use of names
25 for its Alien-branded products, which infringe Plaintiff's trademarks. Any research
26 that Smok conducted in determining whether to use these infringing names—
27 including any surveys or market studies—is relevant to Plaintiff's claim that Smok
28 willfully infringed Plaintiff's Alien Vape trademarks. *See* First Amended

1 Complaint (Dkt. 165) at ¶¶ 10, 72, 104. The documents sought by this Request are
2 also relevant to Plaintiff's breach of contract claim, which alleges that Smok used
3 the Alien Kit Marks in violation of the settlement agreement.

4 Smok has imposed the same improper limitations on its response to RFP No.
5 6 as it did on its response to RFP No. 5, *supra*. First, Smok stated that it will only
6 produce documents pertaining to its use of "Alien" trademarks in the United States.
7 Second, Smok refused to produce documents regarding all "Alien Kit Marks" and
8 instead stated that it will only search for documents regarding products named
9 "Alien" or "AL85." As discussed above, these limitations are unacceptable because
10 Plaintiff's claims encompass all products sold under the Alien Kit Marks.
11 Moreover, Plaintiff's claims are not limited to products that Smok sold in the
12 United States. Plaintiff therefore asks that Smok withdraw its objections and
13 produce all documents that are responsive to RFP No. 6 within two weeks of the
14 hearing on this motion.

15 **SMOK'S POSITION:**

16 In the interest of brevity, Smok incorporates by reference the following
17 paragraphs from Smok's Omnibus Position on Document Requests: 3-4 (regarding
18 trademark use outside the United States) and 5 (regarding the definition of "Alien
19 Kit Marks").

20

21 **REQUEST FOR PRODUCTION NO. 7:**

22 All Documents related to how SMOK allegedly created, selected, adopted,
23 cleared, acquired, or otherwise made the decision to use each of SMOK's Alien Kit
24 Marks.

25

RESPONSE TO REQUEST FOR PRODUCTION NO. 7:

26 Smok objects to this Request on the grounds that it is overbroad, unduly
27 burdensome, and not proportional to the needs of the case because it seeks
28 documents unrelated to trademark use in the United States. Smok will not search

1 for or produce documents related to how Smok created, selected, adopted, cleared,
2 acquired, or otherwise made the decision to use each of Smok's Alien Kit Marks
3 outside the United States. Smok further objects to this Request on the grounds that
4 it seeks documents protected by the attorney-client privilege or the attorney work
5 product doctrine. Smok will produce non-privileged documents—if any—related to
6 how Smok created, selected, adopted, cleared, acquired, or otherwise made the
7 decision to use each of Smok's Alien Kit Marks in the United States.

8 **PLAINTIFF'S POSITION:**

9 RFP No. 7 seeks documents relating to Smok's selection and use of names
10 for its Alien-branded products, which infringe Plaintiff's trademarks. Documents
11 that discuss how Smok decided to use these infringing names are relevant to
12 Plaintiff's claim that Smok willfully infringed Plaintiff's Alien Vape trademarks.
13 *See* First Amended Complaint (Dkt. 165) at ¶¶ 10, 72, 104. The documents sought
14 by this Request are also relevant to Plaintiff's breach of contract claim, which
15 alleges that Smok used the Alien Kit Marks in violation of the settlement
16 agreement.

17 Smok has imposed the same improper limitations on its response to RFP No.
18 7 as it did on its response to RFP Nos. 5 and 6, *supra*. First, Smok has stated that it
19 will only produce documents pertaining to its use of "Alien" trademarks in the
20 United States. Second, Smok has refused to produce documents regarding all
21 "Alien Kit Marks" and has instead stated that it will only search for documents
22 regarding products named "Alien" or "AL85." As discussed above, these
23 limitations are unacceptable because Plaintiff's claims encompass all products sold
24 under the Alien Kit Marks. Moreover, Plaintiff's claims are not limited to products
25 that Smok sold within the United States. Plaintiff therefore asks that Smok
26 withdraw the foregoing objections and produce all documents that are responsive to
27 RFP No. 7 within two weeks of the hearing on this motion.

28 **SMOK'S POSITION:**

1 In the interest of brevity, Smok incorporates by reference the following
2 paragraphs from Smok's Omnibus Position on Document Requests: 3-4 (regarding
3 trademark use outside the United States) and 5 (regarding the definition of "Alien
4 Kit Marks").

5

6 **REQUEST FOR PRODUCTION NO. 8:**

7 Documents showing each proposed name considered by SMOK and the
8 reasons for rejection of such proposed name in favor of the names ALIEN KIT,
9 ALIEN BABY, or ALIEN 2.

10 **RESPONSE TO REQUEST FOR PRODUCTION NO. 8:**

11 Smok objects to this Request on the grounds that it is overbroad, unduly
12 burdensome, and not proportional to the needs of the case because (1) it seeks
13 documents unrelated to trademark use in the United States and (2) Smok never
14 adopted "Alien Baby" or "Alien 2" as a product name. Smok will not search for or
15 produce documents showing each proposed name considered by Smok and the
16 reasons for rejection of such proposed name in favor of the names ALIEN KIT,
17 ALIEN BABY, or ALIEN 2, where the proposed name was considered only for use
18 outside the United States.

19 Smok further objects to this request on the grounds that the phrase
20 "documents showing" and "proposed" and "considered" are vague, in that Smok
21 cannot discern whether Sarieddine requests each document that shows a proposed
22 name, or rather documents sufficient to show each proposed name. Smok will not
23 search for or produce duplicative documents that reflect identical proposed names
24 considered by Smok.

25 Smok further objects to this Request on the grounds that it seeks documents
26 protected by the attorney-client privilege or the attorney work product doctrine.
27 Smok will produce non-privileged documents—if any—sufficient to show each
28 proposed name considered by Smok for use in the United States. Smok also will

1 produce non-privileged documents—if any—sufficient to show the reason Smok
2 rejected each of the aforementioned proposed names.

3 **PLAINTIFF'S POSITION:**

4 RFP No. 8 seeks documents relating to Smok's selection of names for its
5 Alien-branded products, which infringe Plaintiff's trademarks. Documents
6 responsive to RFP No. 8 will tend to show why Smok decided to use the Alien Kit
7 Marks on its products. These documents are relevant to Plaintiff's claim that Smok
8 willfully infringed Plaintiff's Alien Vape trademarks. *See* First Amended
9 Complaint (Dkt. 165) at ¶¶ 10, 72, 104. The documents sought by this Request are
10 also relevant to Plaintiff's breach of contract claim, which alleges that Smok used
11 the Alien Kit Marks in violation of the settlement agreement.

12 Smok has imposed the same improper limitations on its response to RFP No.
13 8 as it did on its response to RFP Nos. 5-7, *supra*. First, Smok has stated that it will
14 only produce documents pertaining to its use of “Alien” trademarks in the United
15 States. Second, Smok has refused to produce documents regarding all “Alien Kit
16 Marks” and has instead stated that it will only search for documents regarding
17 products named “Alien” or “AL85.” As discussed above, these limitations are
18 unacceptable because Plaintiff's claims encompass all products sold under the
19 Alien Kit Marks. Moreover, Plaintiff's claims are not limited to products that
20 Smok sold within United States. Plaintiff therefore asks that Smok withdraw the
21 foregoing objections and produce all documents that are responsive to RFP No. 8
22 within two weeks of the hearing on this motion.

23 **SMOK'S POSITION:**

24 In the interest of brevity, Smok incorporates by reference the following
25 paragraphs from Smok's Omnibus Position on Document Requests: 3-4 (regarding
26 trademark use outside the United States) and 5 (regarding the definition of “Alien
27 Kit Marks”).

28

1 **REQUEST FOR PRODUCTION NO. 9:**

2 All Documents and Communications in which any of Sarieddine's Marks
3 were discussed, including, without limitation, any meeting minutes, notes, emails,
4 text messages, WeChat logs, or Skype logs, or logs from any other instant
5 messenger software.

6 **RESPONSE TO REQUEST FOR PRODUCTION NO. 9:**

7 Smok objects to this Request on the grounds that it seeks documents and
8 communications protected by the attorney-client privilege, the attorney work
9 product doctrine, or the common interest privilege. Smok will produce non-
10 privileged documents and communications—if any—responsive to this Request.

11 **PLAINTIFF'S POSITION:**

12 Despite agreeing to produce documents in response to this Request, Smok
13 has produced almost no responsive documents. Smok has not produced a single
14 internal email regarding Plaintiff's Alien Vape marks and produced very few
15 communications with third parties on this subject. Plaintiff reasonably believes that
16 Smok has additional documents within its possession, custody, or control that are
17 responsive to this Request. Smok's CEO told Plaintiff that he had communicated
18 with “Alien Kiss” (the brand name of Big Bang) about working with them “to fight
19 against” Plaintiff’s “liquid trademark.” McConnell Decl., ¶ 23, Ex. 13. Given this
20 admission from Smok’s CEO, there are presumably communications between
21 Smok and Big Bang regarding Plaintiff’s trademarks, as well as communications
22 with others.

23 Furthermore, given the Court’s recent order denying Big Bang’s request to
24 consolidate its case with the case against Smok, Smok should not withhold
25 responsive communications with Big Bang on privilege grounds. *See* Case No.
26 Case 2:17-cv-00989-DSF-SK, Dkt. 71. As the Court noted, the differences
27 between Plaintiff’s cases against Smok and Big Bang include “different defendants,
28 different products in different geographic markets, and different time periods.” *Id.*

1 Because of these significant differences, Smok and Big Bang are not pursuing a
2 joint legal strategy, and most, if not all, communications with Big Bang would not
3 fall within the purview of the common interest privilege. *See, e.g., Nidec Corp. v.*
4 *Victor Co.*, 249 F.R.D. 575, 579 (N.D. Cal. 2007) (noting that the common interest
5 privilege applies only to communications made in the course of "formulating
6 a *common legal strategy*" or otherwise furthering the parties' joint interest in a
7 lawsuit).

8 Finally, Plaintiff's marks were the subject of a trademark dispute and signed
9 Settlement Agreement regarding Smok's bestselling product, the Alien Kit. Smok
10 navigated the trademark dispute and Settlement Agreement, apparently, without a
11 lawyer. Smok then named a second product the "Alien Baby" and then abandoned
12 the name in favor of "AL85". That it, a large public company, would have no
13 internal documents regarding *any* of these developments is simply beyond belief.

14 To the extent that Smok has withheld any responsive communications on
15 privilege grounds, Smok must provide a privilege log. In accordance with the
16 instructions provided in Plaintiff's discovery requests, this privilege log should
17 include the following information: (a) the date of the communication; (b) the
18 subject matter of the communication; (c) the names, addresses, job titles, and
19 employers of all persons with knowledge or a copy of the information, and (d) the
20 nature of the privilege asserted.

21 Plaintiff requests that Smok produce all documents that are responsive to this
22 Request, as well as a privilege log indicating which documents (if any) have been
23 withheld from production, within two weeks of the hearing on this motion.

24 **SMOK'S POSITION:**

25 Smok has produced non-privileged documents responsive to this request. Its
26 search has not located any additional non-privileged responsive documents.

27 Sarieddine's position regarding the common-interest privilege between Smok
28 and Big Bang is incorrect. While the two cases were not consolidated, there is

1 undisputed overlap between the cases with respect to a number of issues, including
2 the scope of protection for Sarieddine's ALIEN VAPE marks. Sarieddine's
3 implication that most communications Smok and Big Bang (including their
4 respective attorneys) would cover areas where the cases do not overlap is dubious.
5 Smok is entitled to withhold communications between its counsel and Big Bang's
6 by virtue of the common-interest privilege.

7 Finally, in the interest of brevity, Smok incorporates by reference the
8 following paragraphs from Smok's Omnibus Section Regarding Document
9 Requests: 1 (regarding internal documents); 9 (regarding third-party
10 communications); and 12 (regarding a privilege log)

11

12 **REQUEST FOR PRODUCTION NO. 10:**

13 Representative specimens showing all current uses of each of SMOK's Alien
14 Kit Marks affixed to and/or on packaging for any electronic cigarette products.

15 **RESPONSE TO REQUEST FOR PRODUCTION NO. 10:**

16 Smok objects to this Request on the grounds that it is overbroad, unduly
17 burdensome, and not proportional to the needs of the case because it seeks
18 documents unrelated to trademark use in the United States. Smok will not search
19 for or produce specimens showing current uses of Smok's Alien Kit Marks affixed
20 to or on packaging for any electronic cigarette products outside the United States.
21 Smok will produce non-privileged representative photographic specimens—if
22 any—showing current uses of each of Smok's Alien Kit Marks affixed to and/or on
23 packaging for any electronic cigarette products in the United States.

24 **PLAINTIFF'S POSITION:**

25 RFP No. 10 seeks physical samples of e-cigarette products currently
26 displaying Smok's Alien Kit Marks. Smok has not produced any physical samples
27 of its products, even though Plaintiff sent Smok with physical samples of its own
28 Alien Vape-branded products months ago.

1 During the parties' meet and confer session on March 5, 2018, Smok agreed
2 to provide physical samples of products named "Alien" only. McConnell Decl., ¶
3 21. However, this limitation is improper, as Plaintiff's claims are not limited to
4 products specifically named "Alien." As previously explained, Plaintiff's claims
5 cover all products sold under names that are confusingly similar to Alien, including
6 Smok's Alien Mod and AL85 aka Alien Baby products. *See* First Amended
7 Complaint (Dkt. 165) at ¶¶ 10, 44, 72. Plaintiff therefore asks that Smok provide
8 physical samples of all versions of all products currently sold under the "Alien Kit
9 Marks," which includes its AL85 vaporizer, within two weeks of the hearing on this
10 motion. Smok must produce its products in their original packaging.

11 **SMOK'S POSITION:**

12 In the interest of brevity, Smok incorporates paragraph 5 (regarding the
13 definition of "Alien Kit Marks") of Smok's Omnibus Section Regarding Document
14 Requests.

15
16 **REQUEST FOR PRODUCTION NO. 11:**

17 Documents sufficient to identify SMOK's first use of each of SMOK's Alien
18 Kit Marks on any e-cigarette products.

19 **RESPONSE TO REQUEST FOR PRODUCTION NO. 11:**

20 Smok objects to this Request on the grounds that it is overbroad, unduly
21 burdensome, and not proportional to the need of the case because it seeks
22 documents unrelated to trademark use in the United States. Smok will not search
23 for or produce documents to identify Smok's first use of each of Smok's Alien Kit
24 Marks on e-cigarette products outside the United States. Smok will produce non-
25 privileged documents—if any—sufficient to identify Smok's first use in the United
26 States of each of Smok's Alien Kit Marks on any e-cigarette products.

27 **PLAINTIFF'S POSITION:**

28 This Request seeks evidence of Smok's first use of its Alien Kit Marks,

1 which is relevant to Smok’s counterclaim for a declaratory judgment that it has not
2 infringed Plaintiff’s trademarks. *See* Dkt. 184. Documents regarding the first use
3 of Smok’s “Alien Kit” marks are also relevant to Plaintiff’s Lanham Act and breach
4 of contract claims against Smok, which allege that Plaintiff’s Alien Vape marks
5 have priority over Smok’s Alien Kit Marks.

6 Given the relevance of these documents, Smok’s blanket refusal to search for
7 or produce any documents regarding Smok’s first use of its Alien Kit Marks on e-
8 cigarette products outside the United States is improper. As previously explained,
9 Plaintiff’s claims are not limited to products sold within the United States. The
10 settlement agreement between Plaintiff and Smok applied “worldwide.” *See*
11 Plaintiff’s First Amended Complaint, Ex. 1 (Dkt. 165-1). Moreover, Plaintiff’s
12 Lanham Act claims are not limited to trademark infringement that occurred within
13 the United States, and this Court has not issued any orders limiting Plaintiff’s
14 Lanham Act claims to Smok’s U.S. sales. Plaintiff therefore requests that Smok
15 withdraw this objection and produce documents regarding the first use of its Alien
16 Kit Marks anywhere in the world, including but not limited to the United States.

17 Plaintiff also requests that Smok produce documents regarding all products
18 sold under the “Alien Kit Marks,” which include Smok’s Alien Kit, Alien Baby,
19 AL85, Alien 2, AL220, and AL230 products. Smok’s position that it will only
20 search for documents regarding products named “Alien” or “AL85” is unjustified
21 because Plaintiff’s claims are not limited to these two names. This case concerns
22 *all* Smok products sold under the “Alien” name or “confusingly similar” names.
23 *See* First Amended Complaint (Dkt. 165) at ¶¶ 10, 44, 72.

24 Plaintiff therefore asks that Smok withdraw the foregoing objections and
25 produce all documents that are responsive to RFP No. 11 within two weeks of the
26 hearing on this motion.

27 **SMOK’S POSITION:**

28 In the interest of brevity, Smok incorporates by reference the following

1 paragraphs from Smok's Omnibus Position on Document Requests: 3-4 (regarding
2 trademark use outside the United States) and 5 (regarding the definition of "Alien
3 Kit Marks").

4

5 **REQUEST FOR PRODUCTION NO. 12:**

6 All Documents concerning any consumer confusion between any of
7 Sarieddine's Marks and SMOK's Alien Kit Marks, including any instances where a
8 third-party has ever inquired if there is a relationship between SMOK and
9 Sarieddine or inquiring whether SMOK is the source of any goods bearing
10 Sarieddine's Alien Vape Marks.

11 **RESPONSE TO REQUEST FOR PRODUCTION NO. 12:**

12 Smok objects to this Request on the grounds that it is overbroad, unduly
13 burdensome, and not proportional to the needs of the case because it seeks
14 documents constituting inquiries and other communications which were directed to
15 Sarieddine. Smok will not search for or produce documents that constitute inquiries
16 or other communications as to a relationship between Smok and Sarieddine or as to
17 whether Smok is the source of any goods bearing Sarieddine's Alien Vape Marks,
18 where such inquiries and other communications were directed to Sarieddine. Smok
19 further objects to this Request on the grounds that it seeks documents protected by
20 the attorney-client privilege, the attorney work product doctrine, or the common
21 interest privilege. Smok will produce non-privileged documents—if any—
22 concerning any alleged consumer confusion between any of Sarieddine's Marks
23 and Smok's Alien Kit Marks.

24 **PLAINTIFF'S POSITION:**

25 This Request seeks documents regarding consumer confusion between
26 Plaintiff's trademarks and Smok's Alien Kit Marks, which are essential to
27 Plaintiff's trademark infringement claims. Smok has not produced any documents
28 in response to this Request. During the parties' meet and confer session on March

1 5, 2018, Smok represented that it had not located any responsive documents.
2 McConnell Decl., ¶ 26. However, Plaintiff has reason to believe these documents
3 exist. Plaintiff has produced dozens of communications with third parties
4 expressing confusion between Sarieddine's Alien Vape Marks and Smok's Alien
5 Kit Marks. *Id.* Plaintiff's First Amended Complaint includes additional examples
6 of consumer confusion. *See* Dkt. 165 at ¶¶ 81- 82. Given the frequency with which
7 Plaintiff has encountered third parties who expressed confusion between
8 Sarieddine's Alien Vape Marks and Smok's Alien Kit Marks, it is not credible that
9 Smok does not have a single similar inquiry from consumers.

10 Plaintiff asks that Smok search for and produce documents responsive to
11 RFP No. 12 within two weeks of the hearing on this motion

12 **SMOK'S POSITION:**

13 Smok has searched for but not located any non-privileged documents
14 responsive to this request.

15
16 **REQUEST FOR PRODUCTION NO. 13:**

17 All Documents constituting or concerning Communications in which SMOK
18 asserted rights in any of SMOK's Alien Kit Marks, including any cease and desist
19 letters.

20 **RESPONSE TO REQUEST FOR PRODUCTION NO. 13:**

21 Smok objects to this Request on the grounds that it is overbroad, unduly
22 burdensome, and not proportional to the needs of the case because it seeks
23 documents unrelated to the assertion of trademark rights inside the United States.
24 Smok will not search for or produce documents constituting or concerning
25 communications in which Smok asserted rights in any of Smok's Alien Kit Marks
26 outside the United States. Smok further objects to this Request on the grounds that
27 it seeks document protected by the attorney-client privilege or the attorney work
28 product doctrine. Smok will produce non-privileged documents—if any—

1 constituting or concerning communications in which Smok asserted rights in any of
2 Smok's Alien Kit Marks in the United States.

3 **PLAINTIFF'S POSITION:**

4 This Request seeks evidence regarding SMOK's efforts to enforce its Alien
5 Kit Marks, which is relevant to Smok's counterclaim for a declaratory judgment
6 that it has not infringed Plaintiff's trademarks. *See* Dkt. 184. Evidence bearing on
7 the enforceability of Smok's Alien Kit Marks (or lack thereof) is also relevant to
8 Plaintiff's Lanham Act and breach of contract claims.

9 Given their relevance, Smok's refusal to search for or produce any
10 documents in which Smok asserted rights in its Alien Kit Marks outside the United
11 States is improper. As previously explained, Plaintiff's claims are not limited to
12 products sold by Smok within the United States. The settlement agreement
13 between Plaintiff and Smok applied "worldwide." *See* Plaintiff's First Amended
14 Complaint, Ex. 1 (Dkt. 165-1). Moreover, Plaintiff's Lanham Act claims are not
15 limited to trademark infringement that occurred within the United States, and this
16 Court has not issued any orders limiting Plaintiff's Lanham Act claims to Smok's
17 U.S. sales. Plaintiff therefore requests that Smok withdraw this objection and
18 produce documents and communications in which Smok asserted rights in any of its
19 Alien Kit Marks anywhere in the world, including but not limited to the United
20 States.

21 Plaintiff also requests that Smok produce documents and communications in
22 which Smok asserted rights in any of its "Alien Kit Marks," which include Smok's
23 Alien Kit, Alien Baby, AL85, Alien 2, AL220, and AL230 products. In its General
24 Objections, Smok objected to the phrase "Alien Kit Marks" and restricted the
25 definition of this phrase to products named "Alien" or "AL85" only. Smok's
26 objections are improper because Plaintiff's claims are not limited to products
27 named "Alien" or "AL85," and evidence demonstrates that Smok sold products
28 under the other Alien Kit Marks. McConnell Decl., ¶¶ 28-30.

1 Plaintiff therefore asks that Smok withdraw the foregoing objections and
2 produce all documents that are responsive to RFP No. 13 within two weeks of the
3 hearing on this motion.

4 **SMOK'S POSITION:**

5 In the interest of brevity, Smok incorporates by reference the following
6 paragraphs from Smok's Omnibus Position on Document Requests: 3-4 (regarding
7 trademark use outside the United States) and 5 (regarding the definition of "Alien
8 Kit Marks").

9
10 **REQUEST FOR PRODUCTION NO. 14:**

11 All Documents transferring, conveying, licensing, or assigning any rights in
12 any of SMOK's Alien Kit Marks.

13 **RESPONSE TO REQUEST FOR PRODUCTION NO. 14:**

14 Smok objects to this Request on the grounds that it is overbroad, unduly
15 burdensome, and not proportional to the needs of the case because it seeks
16 documents unrelated to trademark rights in the United States. Smok will not search
17 for or produce documents transferring, conveying, licensing, or assigning rights in
18 any of Smok's Alien Kit Marks outside the United States. Smok will produce non-
19 privileged documents—if any—transferring, conveying, licensing, or assigning any
20 rights in any of Smok's Alien Kit Marks in the United States.

21 **PLAINTIFF'S POSITION:**

22 This Request seeks documents regarding licenses, assignments, and other
23 conveyances of rights in Smok's Alien Kit Marks, which relate to the validity and
24 enforceability of these marks. Evidence regarding the enforceability of Smok's
25 Alien Kit Marks is relevant to Smok's counterclaim for a declaratory judgment that
26 it has not infringed Plaintiff's trademarks (Dkt. 184), as well as Plaintiff's Lanham
27 Act and breach of contract claims.

28 Smok's refusal to search for documents regarding Smok's conveyance of

1 rights in its Alien Kit Marks outside the United States is improper. As previously
2 explained, Plaintiff's claims are not limited to products sold by Smok within the
3 United States. Smok's objection to producing documents regarding all "Alien Kit
4 Marks" is similarly baseless because Plaintiff's claims include all of these marks,
5 and evidence demonstrates that Smok sold products under the Alien Kit Marks.
6 McConnell Decl., ¶¶ 28-30.

7 Plaintiff therefore asks that Smok withdraw the foregoing objections and
8 produce all documents that are responsive to RFP No. 14 within two weeks of the
9 hearing on this motion.

10 **SMOK'S POSITION:**

11 In the interest of brevity, Smok incorporates by reference the following
12 paragraphs from Smok's Omnibus Position on Document Requests: 3-4 (regarding
13 trademark use outside the United States) and 5 (regarding the definition of "Alien
14 Kit Marks").

15
16 **REQUEST FOR PRODUCTION NO. 15:**

17 All Documents relating to any analysis or evaluation of SMOK's rights to the
18 term "ALIEN" or any of SMOK's Alien Kit Marks for e-cigarette products.

19 **RESPONSE TO REQUEST FOR PRODUCTION NO. 15:**

20 Smok objects to this Request on the grounds that it is overbroad, unduly
21 burdensome, and not proportional to the needs of the case because it seeks
22 documents unrelated to trademark rights in the United States. Smok will not search
23 for or produce documents relating to any analysis or evaluation of Smok's rights
24 outside the United States to the term "ALIEN" or any of Smok's Alien Kit Marks
25 for e-cigarette products. Smok further objects to this Request on the grounds that it
26 seeks documents protected by the attorney-client privilege, the attorney work
27 product doctrine, or the common interest privilege. Smok will produce non-
28 privileged documents—if any—relating to any analysis or evaluation of Smok's

1 rights in the United States to the term “ALIEN” or any of Smok’s Alien Kit Marks
2 for e-cigarette products.

3 **PLAINTIFF’S POSITION:**

4 This Request seeks documents regarding Smok’s evaluation of its rights to
5 use the Alien Kit Marks, which are relevant to Plaintiff’s claim that Smok willfully
6 infringed Plaintiff’s Alien Vape trademarks. *See* First Amended Complaint (Dkt.
7 165) at ¶¶ 10, 72, 104. The documents sought by this Request are also relevant to
8 Plaintiff’s breach of contract claim, which alleges that Smok used the Alien Kit
9 Marks in violation of the settlement agreement.

10 Given the relevance of these documents, Smok’s refusal to search for
11 documents regarding Smok’s rights to use the Alien Kit Marks outside the United
12 States is improper. As previously explained, Plaintiff’s claims are not limited to
13 products sold by Smok within the United States. Smok’s objection to producing
14 documents regarding all “Alien Kit Marks” is similarly baseless because Plaintiff’s
15 claims include all of these marks, and evidence demonstrates that Smok sold
16 products under the Alien Kit Marks. McConnell Decl., ¶¶ 28-30.

17 Plaintiff therefore asks that Smok withdraw its objections and produce all
18 documents that are responsive to RFP No. 15 within two weeks of the hearing on
19 this motion.

20 **SMOK’S POSITION:**

21 In the interest of brevity, Smok incorporates by reference the following
22 paragraphs from Smok’s Omnibus Position on Document Requests: 3-4 (regarding
23 trademark use outside the United States) and 5 (regarding the definition of “Alien
24 Kit Marks”).

25
26 **REQUEST FOR PRODUCTION NO. 16:**

27 All Documents concerning or relating to any contention that SMOK does not
28 infringe Sarieddine’s trademark rights.

1 **RESPONSE TO REQUEST FOR PRODUCTION NO. 16:**

2 Smok objects to this request on the grounds that it is overbroad, unduly
3 burdensome, and not proportional to the needs of the case because (1) it seeks to
4 force Smok's counsel to make legal determinations and (2) the phrase "any
5 contention" includes contentions not made by Smok. Smok will not search for or
6 produce any documents related to a contention that Smok does not intend to make.
7 Smok further objects to this Request on the grounds that it seeks document
8 protected by the attorney-client privilege, the attorney work product doctrine, or the
9 common interest privilege. Smok will produce non-privileged documents—if any—
10 concerning or relating to any contention Smok intends to make that Smok does not
11 infringe Sarieddine's trademark rights.

12 **PLAINTIFF'S POSITION:**

13 Smok has not produced all documents within its possession, custody, or
14 control that are responsive to this Request. Smok produced a limited volume of
15 responsive documents, primarily consisting of advertisements for Plaintiff's
16 products, documents from the USPTO website regarding Plaintiff's trademarks, and
17 documents downloaded from PACER. It is not credible that the documents
18 regarding SMOK's contention that it has not infringed Sarieddine's trademark
19 rights are limited to advertisements and publicly available documents. Smok has
20 not produced any internal emails and few company documents. Nor has Smok
21 produced documents regarding its affirmative defenses (*see, e.g.*, RFP Nos. 52-54
22 and 81, discussed *infra*). Plaintiff therefore requests that Smok produce all
23 documents that are responsive to this Request within two weeks of the hearing on
24 this motion.

25 **SMOK'S POSITION:**

26 Sarieddine's characterization of Smok's production in response to this
27 request ignores the many documents Smok produced that show widespread third-
28 party use of the word "alien" in connection with alternative smoking goods and

1 services, both generically (for a type of wire or coil used in vaporizers) and as part
2 of a trademark or service mark.

3 Finally, in the interest of brevity, Smok incorporates paragraph 2 (regarding
4 internal documents) of Smok's Omnibus Position Regarding Document Requests.

5

6 **REQUEST FOR PRODUCTION NO. 17:**

7 All Documents relating to any similarity between any of Sarieddine's Alien
8 Vape Marks and any of SMOK's Alien Kit Marks.

9 **RESPONSE TO REQUEST FOR PRODUCTION NO. 17:**

10 Smok objects to this request on the grounds that it is overbroad, unduly
11 burdensome, and not proportional to the needs of the case because (1) it seeks to
12 force Smok's counsel to make legal determinations and (2) the broad definition of
13 "relating to" makes this request encompass every document that refers in any way
14 to one of Sarieddine's Alien Vape Marks or Smok's Alien Kit Marks. Smok will
15 not search for or produce documents that do not discuss the similarity or lack
16 thereof between any of Sarieddine's Alien Vape Marks and any of Smok's Alien
17 Kit Marks. Smok further objects to this Request on the grounds that it seeks
18 documents protected by the attorney-client privilege, the work product doctrine, or
19 the common interest privilege. Smok will produce non-privileged documents—if
20 any—that discuss any similarity or lack thereof between any of Sarieddine's Alien
21 Vape Marks and any of Smok's Alien Kit Marks.

22 **PLAINTIFF'S POSITION:**

23 This Request seeks documents regarding the similarities between Plaintiff's
24 trademarks and Smok's Alien Kit Marks, which are essential to Plaintiff's
25 trademark infringement and Lanham Act claims. Smok has not produced any
26 documents that are responsive to this Request. None of Smok's asserted objections
27 permit Smok to withhold relevant, non-privileged documents or limit Smok's
28 obligation to conduct a reasonable search for responsive documents. Smok should

1 withdraw these improper objections and produce all responsive documents within
2 two weeks of the hearing on this Motion.

3 **SMOK'S POSITION:**

4 Smok's limitation of this document request is reasonable. Sarieddine's First
5 Set of Document Requests defined "relating to" as "broadly construed as meaning
6 pertaining to, referring to, embodying, reflecting, mentioning, requesting,
7 discussing, describing, analyzing, regarding, showing, identifying, evidencing,
8 constituting, comprising, or connected with a stated subject matter." Under that
9 broad definition, any document showing any of the marks in question would be
10 responsive because such a document would be "connected with [the] stated subject
11 matter."

12 Smok's search for documents that discuss any similarity or lack thereof
13 between any of Sarieddine's Alien Vape Marks and any of Smok's Alien Kit Marks
14 is ongoing.

15

16 **REQUEST FOR PRODUCTION NO. 18:**

17 All manufacturing and distribution agreements relating to any goods bearing
18 any of SMOK's Alien Kit Marks.

19 **RESPONSE TO REQUEST FOR PRODUCTION NO. 18:**

20 Smok objects to this Request on the grounds that it seeks documents that are
21 not relevant to the claims or defenses in this case and on the grounds that it is
22 overbroad, unduly burdensome, and not proportional to the needs of the case
23 because (1) it seeks financial documents that have no bearing on this action and (2)
24 it seeks documents related to goods bearing Smok's Alien Kit Marks outside the
25 United States.

26 **PLAINTIFF'S POSITION:**

27 Smok's blanket refusal to produce any documents in response to this Request
28 is improper. Smok's distribution agreements are especially relevant to this case,

1 given that ten of the defendants are Smok's distributors. Such documents are likely
2 to contain information regarding the distribution of Smok's "Alien Baby"
3 vaporizer, which is central to Plaintiff's trademark infringement and breach of
4 contract claims against Smok, as well as its Lanham Act and business tort claims
5 against the Distributor Defendants. Moreover, Smok has offered various third
6 parties certain distribution rights and related perks in exchange for third parties'
7 cooperation in trying to invalidate Plaintiff's trademarks. Such distribution
8 agreements with third parties are therefore relevant to Plaintiff's claim for breach of
9 the implied covenant of good faith and fair dealing against Smok, as well as
10 Plaintiff's intentional interference with contractual relations claim against the
11 Distributor Defendants.

12 Moreover, Smok should not withhold any responsive documents simply
13 because they concern sales of Smok's Alien-branded vaporizers outside of the
14 United States. As previously explained, information regarding Smok's trademark
15 infringement outside of the United States is relevant to Plaintiff's Lanham Act and
16 breach of contract claims. Plaintiff therefore requests that Smok search for and
17 produce documents responsive to this Request within two weeks of the hearing on
18 this motion.

19 **SMOK'S POSITION:**

20 As a compromise position, Smok has agreed to produce any distribution
21 agreements between Smok and Distributor Defendants. Smok has hundreds of
22 distributors in the United States (and many more worldwide). Production of every
23 distribution agreement would be burdensome and not proportional to the needs of
24 this case. Sarieddine offers no support (much less persuasive evidence) for his
25 assertion that Smok offered third parties distribution rights and perks in exchange
26 for cooperation in trying to invalidate Sarieddine's trademarks.

27 Finally, in the interest of brevity, Smok hereby incorporates paragraphs 3-4
28 (regarding trademark use outside the United States) of Smok's Omnibus Position

1 Regarding Document Requests.

2

3 **REQUEST FOR PRODUCTION NO. 19:**

4 All Documents concerning or relating to the strength of any of Sarieddine's
5 Alien Vape Marks or SMOK's Alien Kit Marks.

6 **RESPONSE TO REQUEST FOR PRODUCTION NO. 19:**

7 Smok objects to this Request on the grounds that it is overbroad, unduly
8 burdensome, and not proportional to the needs of the case because (1) it seeks to
9 force Smok's counsel to make legal determinations, (2) it seeks documents equally
10 available to Sarieddine, and (3) the broad definitions of "concerning" and "relating
11 to" make this request encompass every document that refers in any way to one of
12 Sarieddine's Alien Vape Marks or Smok's Alien Kit Marks. Smok will not search
13 for or produce documents that do not discuss the strength of any of Sarieddine's
14 Alien Vape Marks or Smok's Alien Kit Marks. Smok further objects to this Request
15 on the grounds that it seeks documents protected by the attorney-client privilege,
16 the attorney work product doctrine, or the common interest privilege. Smok will
17 produce non-privileged documents—if any—that discuss the strength of any of
18 Sarieddine's Alien Vape Marks or Smok's Alien Kit Marks.

19 **PLAINTIFF'S POSITION:**

20 Smok has not produced all documents within its possession, custody, or
21 control that are responsive to this Request. Smok produced a limited volume of
22 responsive documents, primarily consisting of advertisements for Plaintiff's
23 products, documents from the USPTO website regarding Plaintiff's trademarks, and
24 documents downloaded from PACER. It is not credible that Smok's documents
25 regarding the strength of Plaintiff's trademarks and Smok's Alien Kit Marks are
26 limited to these advertisements and publicly available documents. Smok has not
27 produced any internal emails and has produced few company documents. Nor has
28 Smok produced documents regarding its affirmative defenses (*see, e.g.*, RFP Nos.

1 52-54 and 81, discussed *infra*). Plaintiff therefore reasonably expects that Smok
2 has additional responsive documents in its possession, custody, or control, which it
3 has chosen not to produce.

4 To the extent that Smok has withheld documents based on its asserted
5 objections, Smok should produce those documents immediately. Smok's objection
6 that this Request "encompass[es] every document that refers in any way to one of
7 Sarieddine's Alien Vape Marks or Smok's Alien Kit Marks" is unfounded.
8 Plaintiff specifically defined what Plaintiff meant by the "strength" of trademarks in
9 a letter to Defendants, dated November 28, 2017. McConnell Decl., ¶ 7, Ex. 5.
10 Smok therefore cannot claim that it does not understand the scope of this Request.

11 Plaintiff requests that Smok produce all documents that are responsive to this
12 Request within two weeks of the hearing on this motion.

13 **SMOK'S POSITION:**

14 Sarieddine's November 28, 2018 letter states that "this request asks for
15 documents that discuss the distinctiveness and marketplace recognition of
16 Sarieddine's Mark, as well as documents that discuss the distinctiveness and
17 marketplace recognition of Smok's Alien Kit Marks." McConnell Decl., ¶ 7, Ex. 5
18 (note that the letter erroneously refers to this RFP as "No. 14"). In effect,
19 Sarieddine seeks documents that discuss the strength of any of Sarieddine's Alien
20 Vape Marks or Smok's Alien Kit Marks. This narrowed scope matches the
21 documents that Smok stated it would produce, if located.

22 Smok's search for non-privileged documents responsive to the narrowed
23 request is ongoing.

24 Nonetheless, Smok has produced many documents related to the commercial
25 strength of Sarieddine's ALIEN VAPE marks, showing widespread third-party use
26 of the word "alien" in connection with alternative smoking goods and services, both
27 generically (for a type of wire or coil used in vaporizers) and as part of a trademark
28 or service mark.

1 Finally, in the interest of brevity, Smok incorporates paragraph 2 (regarding
2 internal documents) of Smok's Omnibus Position Regarding Document Requests).

3

4 **REQUEST FOR PRODUCTION NO. 20:**

5 All Documents concerning or relating to the scope of SMOK's rights in any
6 ALIEN mark for any e-cigarette products.

7 **RESPONSE TO REQUEST FOR PRODUCTION NO. 20:**

8 Smok objects to this Request on the grounds that it is overbroad, unduly
9 burdensome, vague and not proportional to the needs of the case because (1) it
10 seeks documents unrelated to trademark rights in the United States and (2) it seeks
11 to force Smok's counsel to make legal determinations. Smok will not search for or
12 produce documents concerning or relating to the scope of Smok's rights outside the
13 United States in any ALIEN mark for e-cigarette products. Smok further objects to
14 this Request on the grounds that it seeks documents protected by the attorney-client
15 privilege, the attorney work product doctrine, or the common interest privilege.
16 Smok further objects on the grounds that the term ALIEN marks is vague. Smok
17 will produce non-privileged documents—if any—concerning or relating to the
18 scope of Smok's rights in Smok Alien Kit for vaporizers.

19 **PLAINTIFF'S POSITION:**

20 This Request seeks documents regarding the scope of Smok's rights to use
21 any “Alien” mark for e-cigarette products, which are relevant to Plaintiff's claim
22 that Smok willfully infringed Plaintiff's Alien Vape trademarks. *See* First
23 Amended Complaint (Dkt. 165) at ¶¶ 10, 72, 104. The documents sought by this
24 Request are also relevant to Plaintiff's breach of contract claim, which alleges that
25 Smok willfully used the Alien Kit Marks in violation of the settlement agreement.

26 Smok's refusal to search for documents regarding Smok's rights to use
27 “Alien” marks on e-cigarette products outside the United States is improper. As
28

1 previously explained, Plaintiff's claims are not limited to products sold by Smok
2 within the United States. The settlement agreement between Plaintiff and Smok,
3 applied worldwide, and this Court has not issued any orders limiting Plaintiff's
4 claims to Smok's U.S. sales. Plaintiff therefore requests that Smok withdraw its
5 objections and produce documents regarding the scope of Smok's rights in any
6 ALIEN mark for e-cigarette products anywhere in the world within two weeks of
7 the hearing on this motion.

8 **SMOK'S POSITION:**

9 In the interest of brevity, Smok hereby incorporates paragraphs 3-4
10 (regarding trademark use outside the United States) of Smok's Omnibus Position
11 Regarding Document Requests.

12

13 **REQUEST FOR PRODUCTION NO. 21:**

14 All Documents and Communications between or among SMOK and any
15 third party concerning any disputes (including, without limitation, actual or
16 threatened litigation raised by SMOK or any third-party on SMOK's behalf)
17 concerning any of SMOK's Alien Kit marks.

18 **RESPONSE TO REQUEST FOR PRODUCTION NO. 21:**

19 Smok objects to this Request on the grounds that it is overbroad, unduly
20 burdensome, and not proportional to the needs of the case because it seeks
21 documents unrelated to trademark rights in the United States. Smok will not search
22 for or produce any documents or communications between or among Smok and any
23 third party concerning any disputes outside the United States concerning any of
24 Smok's Alien Kit Marks. Smok further objects to this Request on the grounds that
25 it seeks documents and communications protected by the attorney-client privilege,
26 the attorney work product doctrine, or the common interest doctrine. Smok will
27 produce non-privileged documents and communications—if any—concerning any
28 disputes in the United States concerning any of Smok's Alien Kit Marks.

1 **PLAINTIFF'S POSITION:**

2 This Request seeks Smok's internal documents and communications
3 regarding disputes over its Alien Kit Marks, as well as communications with third
4 parties on this topic. These documents relate to the validity of Smok's Alien Kit
5 Marks and Smok's enforce its rights in these marks, which are relevant to Smok's
6 counterclaims. Smok's communications with third parties on this subject are also
7 relevant to Plaintiff's breach of contract claim, which alleges that Smok worked
8 with third parties to challenge Plaintiff's Alien Vape marks by, *inter alia*, filing a
9 trademark application for Smok Alien Kit.

10 Smok has produced almost no documents in response to this Request. Smok
11 has not produce a single internal communication regarding its Alien Kit Marks and
12 produced very few communications with third parties on this subject. It is not
13 credible that Smok, a major public company, does not have any internal documents
14 or communications regarding a dispute over its Alien Kit Marks, especially when
15 much of the dispute was negotiated and resolved apparently before Smok engaged
16 any counsel. Additionally, Plaintiff has evidence that Smok discussed this lawsuit
17 with third parties. McConnell Decl., ¶¶ 23-24, Exs. 13-14. Therefore, Plaintiff has
18 reason to believe that Smok has additional responsive documents within its
19 possession, custody, or control that it has withheld from production.

20 To the extent that Smok has withheld documents based on the objections it
21 asserted in response to this Request, Smok should withdraw those objections and
22 produce all responsive documents. As previously explained, Smok's objection to
23 producing documents regarding its use of the Alien Kit Marks outside of the United
24 States is improper because Plaintiff's claims are not limited to products sold within
25 the United States. Smok's refusal to produce documents regarding all the Alien Kit
26 Marks is likewise improper because Plaintiff's claims broadly include all products
27 are confusingly similar to the "Alien" name.

28 Furthermore, given the Court's recent order denying Big Bang's request to

1 consolidate its case with the case against Smok, Smok should not withhold
2 responsive communications with Big Bang on privilege grounds. *See* Case No.
3 Case 2:17-cv-00989-DSF-SK, Dkt. 71. As the Court noted, the differences
4 between Plaintiff's cases against Smok and Big Bang include "different defendants,
5 different products in different geographic markets, and different time periods." *Id.*
6 Because of these significant differences, Smok and Big Bang are not pursuing a
7 joint legal strategy, and most, if not all, communications with Big Bang would not
8 fall within the purview of the common interest privilege. *See, e.g., Nidec Corp. v.*
9 *Victor Co.*, 249 F.R.D. 575, 579 (N.D. Cal. 2007) (noting that the common interest
10 privilege applies only to communications made in the course of "formulating
11 a *common legal strategy*" or otherwise furthering the parties' joint interest in a
12 lawsuit).

13 Plaintiff therefore asks that Smok withdraw these objections and produce all
14 documents that are responsive to RFP No. 21 within two weeks of the hearing on
15 this motion.

16 **SMOK'S POSITION:**

17 Sarieddine's position regarding the common-interest privilege between Smok
18 and Big Bang is incorrect. While the two cases were not consolidated, there is
19 undisputed overlap between the cases with respect to a number of issues, including
20 the scope of protection for Sarieddine's ALIEN VAPE marks. Sarieddine's
21 implication that most communications Smok and Big Bang (including their
22 respective attorneys) would cover areas where the cases do not overlap is dubious.
23 Smok is entitled to withhold communications between its counsel and Big Bang's
24 by virtue of the common-interest privilege.

25 Finally, in the interest of brevity, Smok incorporates the following
26 paragraphs from Smok's Omnibus Position Regarding Document Requests: 2
27 (regarding internal documents); 3-4 (regarding trademark use outside the United
28 States); 5 (regarding the definition of "Alien Kit Marks"); and 9 (regarding third-

1 party communications).

2

3 **REQUEST FOR PRODUCTION NO. 22:**

4 Documents sufficient to identify all goods or services that have ever been
5 offered, sold, or certified under any of SMOK's Alien Kit Marks.

6 **RESPONSE TO REQUEST FOR PRODUCTION NO. 22:**

7 Smok objects to this Request on the grounds that it is overbroad, unduly
8 burdensome, and not proportional to the needs of the case because it seeks
9 documents unrelated to trademark use in the United States. Smok will not search
10 for or produce documents sufficient to identify goods or services that have been
11 offered, sold, or certified outside the United States under any of Smok's Alien Kit
12 Marks. Smok will produce non-privileged documents—if any—sufficient to
13 identify all goods or services that have ever been offered, sold, or certified in the
14 United States under any of Smok's Alien Kit Marks.

15 **PLAINTIFF'S POSITION:**

16 This Request seeks documents regarding Smok's sale of products under the
17 Alien Kit Marks, which are relevant to Plaintiff's Lanham Act claims and damages.
18 These documents are also relevant to Plaintiff's breach of contract claims, which
19 prohibit Smok from selling, or offering for sale, any products under the Alien Kit
20 Marks without Plaintiff's consent.

21 Given the relevance of these documents, Smok's blanket refusal to search for
22 or produce any documents regarding Smok's use of its Alien Kit Marks on e-
23 cigarette products outside the United States is improper. As previously explained,
24 Plaintiff's claims are not limited to products sold within the United States. This
25 case concerns *all* Smok products sold under the "Alien" name and other
26 "confusingly similar" names anywhere in the world. *See* First Amended Complaint
27 (Dkt. 165) at ¶¶ 10, 44, 72. Plaintiff therefore asks that Smok withdraw the
28 foregoing objections and produce all documents that are responsive to RFP No. 22

1 within two weeks of the hearing on this motion.

2 **SMOK'S POSITION:**

3 In the interest of brevity, Smok incorporates by reference the following
4 paragraphs from Smok's Omnibus Position on Document Requests: 3-4 (regarding
5 trademark use outside the United States) and 5 (regarding the definition of "Alien
6 Kit Marks").

7

8 **REQUEST FOR PRODUCTION NO. 23:**

9 Documents sufficient to identify all channels of trade used by SMOK for any
10 goods or services offered under any of SMOK's Alien Kit Marks.

11 **RESPONSE TO REQUEST FOR PRODUCTION NO. 23:**

12 Smok objects to this Request on the grounds that it is overbroad, unduly
13 burdensome, and not proportional to the needs of the case because it seeks
14 documents unrelated to trademark use in the United States. Smok will not search
15 for or produce documents sufficient to identify channels of trade outside the United
16 States used by Smok for any goods or services offered under any of Smok's Alien
17 Kit Marks. Smok will produce non-privileged documents—if any—sufficient to
18 identify all channels of trade in the United States used by Smok for any goods or
19 services offered under any of Smok's Alien Kit Marks.

20 **PLAINTIFF'S POSITION:**

21 This Request seeks documents regarding the channels of trade (stores,
22 websites, etc.) that Smok used to sell products under the infringing "Alien Kit
23 Marks." These documents are relevant to Plaintiff's Lanham Act claims and
24 damages, as well as Plaintiff's breach of contract claims against Smok, which
25 prohibit Smok from selling, or offering for sale, any products under the Alien Kit
26 Marks without Plaintiff's consent.

27 Smok's refusal to search for or produce any documents regarding any
28 "channels of trade" that it used to sell infringing products outside of the United

1 States is improper. Excluding these documents from production has the effect of
2 grossly distorting the number of infringing products that Smok sold. As previously
3 explained, Plaintiff's claims are not limited to products named "Alien" sold within
4 the United States. This case concerns *all* Smok products sold under the "Alien"
5 name and other "confusingly similar" names anywhere in the world. *See* First
6 Amended Complaint (Dkt. 165) at ¶¶ 10, 44, 72.

7 Plaintiff therefore asks that Smok withdraw the foregoing objections and
8 produce all documents that are responsive to RFP No. 23 within two weeks of the
9 hearing on this motion

10 **SMOK'S POSITION:**

11 In the interest of brevity, Smok incorporates by reference the following
12 paragraphs from Smok's Omnibus Position on Document Requests: 3-4 (regarding
13 trademark use outside the United States) and 5 (regarding the definition of "Alien
14 Kit Marks").

15
16 **REQUEST FOR PRODUCTION NO. 25:**

17 One sample of each e-cigarette product to which each of SMOK's Alien Kit
18 Marks have been affixed, whether on the product itself or on the product's
19 packaging.

20 **RESPONSE TO REQUEST FOR PRODUCTION NO. 25:**

21 Smok objects to this Request on the grounds that it is overbroad, unduly
22 burdensome, and not proportional to the needs of the case because it seeks items
23 unrelated to trademark use in the United States. Smok will not search for or produce
24 samples of e-cigarette products sold exclusively outside the United States. Smok
25 will produce one sample photo—if any—of each e-cigarette product to which each
26 of Smok's Alien Kit Marks have been affixed in the United States.

27 **PLAINTIFF'S POSITION:**

28 RFP No. 25 requests a physical sample of every e-cigarette product that has

1 displayed any of Smok's Alien Kit Marks. This includes products that have been
2 discontinued or are no longer being sold. Smok has not produced any physical
3 samples of its products, even though Plaintiff provided physical samples of its
4 products months ago.

5 During the parties' meet and confer session on March 5, 2018, Smok agreed
6 to provide physical samples of products specifically named "Alien" only.
7 McConnell Decl., ¶ 21. This limitation is improper. As previously explained, the
8 infringing products at issue include all products sold under the "Alien Kit Marks,"
9 not just products named "Alien." Plaintiff therefore asks that Smok produce a
10 physical sample of every version of each product that has been sold under any of
11 the "Alien Kit Marks," anywhere in the world within two weeks of the hearing on
12 this motion.

13 **SMOK'S POSITION:**

14 In the interest of brevity, Smok incorporates by reference the following
15 paragraphs from Smok's Omnibus Position on Document Requests: 3-4 (regarding
16 trademark use outside the United States) and 5 (regarding the definition of "Alien
17 Kit Marks").

18
19 **REQUEST FOR PRODUCTION NO. 26:**

20 All Documents and Communications between or among SMOK and any
21 third party concerning this Action or any disputes in this Action.

22 **RESPONSE TO REQUEST FOR PRODUCTION NO. 26:**

23 Smok objects to this Request on the grounds that it seeks documents and
24 communications protected by the attorney-client privilege, the work product
25 doctrine, or the common interest privilege. Smok will produce non-privileged
26 documents and communications—if any—between or among Smok and any third
27 party concerning this Action or any disputes in this Action.

1 **PLAINTIFF'S POSITION:**

2 This Request seeks Smok's internal documents and communications
3 regarding any issues in this lawsuit, as well as communications with third parties on
4 this topic. These documents and communications are relevant to Plaintiff's claims
5 for breach of contract and breach of the implied covenant of good faith and fair
6 dealing, which allege that Smok worked with third parties to challenge Plaintiff's
7 Alien Vape marks.

8 Smok has produced almost no documents in response to this Request. Smok
9 has not produce a single internal communication regarding this lawsuit and
10 produced very few communications with third parties on this subject. It is not
11 credible that Smok does not have any internal documents or communications
12 regarding this lawsuit. The few documents that Smok has produced demonstrate
13 that Smok has communicated with third parties, including Big Bang, regarding the
14 claims in this lawsuit. McConnell Decl., ¶ 23, Ex. 13. Plaintiff is also aware that
15 Smok has communicated with Vapor World, a former Smok distributor, about this
16 lawsuit. *Id.*, ¶ 24, Ex. 14.

17 During the parties' meet and confer session on March 5, 2018, Smok
18 revealed for the first time that it has "no written record" of these missing third-party
19 communications. *Id.*, ¶ 22. However, documents produced in this lawsuit
20 demonstrate Smok employees tend to use email, WeChat, and Skype to
21 communicate with individuals outside the company. *Id.* ¶ 23, Ex. 13. This is
22 consistent with Plaintiff's own experience, as the vast majority of Plaintiff's
23 communications with Smok occurred through these means. *Id.*, ¶ 23. Plaintiff
24 therefore expects that there are additional responsive communications that have not
25 been produced.

26 Furthermore, given the Court's recent order denying Big Bang's request to
27 consolidate its case with the case against Smok, Smok should not withhold
28 responsive communications with Big Bang on privilege grounds. *See Case No.*

1 Case 2:17-cv-00989-DSF-SK, Dkt. 71. As the Court noted, the differences
2 between Plaintiff's cases against Smok and Big Bang include "different defendants,
3 different products in different geographic markets, and different time periods." *Id.*
4 Because of these significant differences, Smok and Big Bang are not pursuing a
5 joint legal strategy, and most, if not all, communications with Big Bang would not
6 fall within the purview of the common interest privilege. *See, e.g., Nidec Corp. v.*
7 *Victor Co.*, 249 F.R.D. 575, 579 (N.D. Cal. 2007) (noting that the common interest
8 privilege applies only to communications made in the course of "formulating
9 a *common legal strategy*" or otherwise furthering the parties' joint interest in a
10 lawsuit).

11 To the extent that Smok has withheld responsive communications on
12 privilege grounds, including on joint defense or common interest privilege grounds,
13 Smok must provide a privilege log. In accordance with the instructions provided in
14 Plaintiff's discovery requests, this privilege log should include the following
15 information: (a) the date of the communication; (b) the subject matter of the
16 communication; (c) the names, addresses, job titles, and employers of all persons
17 with knowledge or a copy of the information, and (d) the nature of the privilege
18 asserted.

19 Plaintiff requests that Smok produce documents and communications that are
20 responsive to RFP No. 26 within two weeks of the hearing on this motion.

21 **SMOK'S POSITION:**

22 Sarieddine's position regarding the common-interest privilege between Smok
23 and Big Bang is incorrect. While the two cases were not consolidated, there is
24 undisputed overlap between the cases with respect to a number of issues, including
25 the scope of protection for Sarieddine's ALIEN VAPE marks. Sarieddine's
26 implication that most communications Smok and Big Bang (including their
27 respective attorneys) would cover areas where the cases do not overlap is dubious.
28 Smok is entitled to withhold communications between its counsel and Big Bang's

1 by virtue of the common-interest privilege.

2 Finally, in the interest of brevity, Smok incorporates the following
3 paragraphs from Smok's Omnibus Position Regarding Document Requests: 2
4 (regarding internal documents); 9 (regarding third-party communications); and 12
5 (regarding a privilege log).

6

7 **REQUEST FOR PRODUCTION NO. 27:**

8 Documents related to choosing any names for products bearing SMOK's
9 Alien Kit Marks.

10 **RESPONSE TO REQUEST FOR PRODUCTION NO. 27:**

11 Smok objects to this Request on the grounds that it is overbroad, unduly
12 burdensome, and not proportional to the needs of the case because it seeks
13 documents unrelated to trademark use in the United States. Smok will not search
14 for or produce documents related to choosing names for products bearing Smok's
15 Alien Kit Marks outside the United States. Smok further objects to this Request on
16 the grounds that it seeks documents protected by the attorney-client privilege, the
17 attorney work product doctrine, or the common interest privilege. Smok will
18 produce non-privileged documents—if any—related to choosing any names for
19 products bearing Smok's Alien Kit Marks in the United States.

20 **PLAINTIFF'S POSITION:**

21 Smok has not produced a single document in response to this Request.
22 Plaintiff reasonably expects that Smok, a multinational public company that is one
23 of the most successful e-cigarette companies in the world, has documents
24 explaining how and why it chose to use the name of its company's bestselling
25 product. Smok should produce those documents, which are relevant to Plaintiff's
26 claim that Smok willfully infringed Plaintiff's Alien Vape trademarks. Plaintiff has
27 alleged that Smok adopted the "Alien Kit" name for its vaporizer with full
28 knowledge of Plaintiff's Alien Vape products and superior trademark rights. *See*

1 First Amended Complaint (Dkt. 165) at ¶¶ 10, 72, 104. Furthermore, Plaintiff has
2 produced its own documents showing that Smok knew about its trademark and
3 showed an interest in its mark in the months before Smok announced its first
4 “Alien” product.

5 The documents sought by this Request are also relevant to Plaintiff’s breach
6 of contract claim, which alleges that Smok used the Alien Kit Marks in violation of
7 the settlement agreement.

8 Like its responses to numerous other RFPs, Smok has unjustifiably limited its
9 response to RFP No. 27 to products sold only within the United States and also to
10 products specifically named “AL85” or “Alien.” As previously explained, these
11 limitations are unacceptable because Plaintiff’s claims are not limited to products
12 sold within the United States and because Plaintiff’s claims encompass all the
13 “Alien Kit Marks,” not just products named “AL85” or “Alien.” Plaintiff therefore
14 asks that Smok withdraw the foregoing objections and produce all documents that
15 are responsive to RFP No. 27 within two weeks of the hearing on this motion.

16 **SMOK’S POSITION:**

17 Smok’s search for non-privileged documents responsive to this request is
18 ongoing.

19 Finally, in the interest of brevity, Smok incorporates by reference the
20 following paragraphs from Smok’s Omnibus Position on Document Requests: 3-4
21 (regarding trademark use outside the United States) and 5 (regarding the definition
22 of “Alien Kit Marks”).

23
24 **REQUEST FOR PRODUCTION NO. 28:**

25 All Communications with any third parties selling electronic cigarette
26 products that include the term “Alien” in the product name relating to any attempt
27 to purchase, assign, or license any common law or registered trademark rights.

1 **RESPONSE TO REQUEST FOR PRODUCTION NO. 28:**

2 Smok objects to this Request on the grounds that it is overbroad, unduly
3 burdensome, and not proportional to the needs of the case because it seeks
4 communications unrelated to trademark rights in the United States. Smok will not
5 search for or produce communications with any third parties selling electronic
6 cigarette products outside the United States that include the term “Alien” in the
7 product name relating to any attempt to purchase, assign, or license any common
8 law or registered trademark rights. Smok will produce non-privileged
9 communications—if any—with any third parties selling electronic cigarette
10 products in the United States that include the term “Alien” in the product name
11 relating to any attempt to purchase, assign, or license any common law or registered
12 trademark rights.

13 **PLAINTIFF’S POSITION:**

14 Smok has not produced a single document in response to this Request.
15 Documents regarding Smok’s efforts to purchase, assign, or license any common
16 law or registered trademark rights in “Alien” e-cigarette products are relevant to
17 Plaintiff’s claim that Smok willfully infringed Plaintiff’s Alien Vape trademarks.
18 These documents are also relevant to Plaintiff’s claims for breach of contract and
19 breach of the implied covenant of good faith and fair dealing, which allege that
20 Smok worked with third parties to try to invalidate and otherwise challenge
21 Plaintiff’s Alien Vape marks.

22 Like its responses to numerous other RFPs, Smok has unjustifiably limited its
23 response to RFP No. 28 to products sold only within the United States. As
24 previously explained, this limitation is unacceptable because Plaintiff’s claims are
25 not limited to products sold within the United States. Plaintiff therefore asks that
26 Smok withdraw the foregoing objections and produce all documents that are
27 responsive to RFP No. 28 within two weeks of the hearing on this motion.

1 **SMOK'S POSITION:**

2 In the interest of brevity, Smok hereby incorporates paragraphs 3-4
3 (regarding trademark use outside the United States) of Smok's Omnibus Position
4 Regarding Document Requests.

5

6 **REQUEST FOR PRODUCTION NO. 32:**

7 One representative sample of each e-mail promotion that SMOK has sent to
8 any of its marketing lists that advertises goods offered under any of SMOK's Alien
9 Kit Marks.

10 **RESPONSE TO REQUEST FOR PRODUCTION NO. 32:**

11 Smok objects to this Request on the grounds that it is overbroad, unduly
12 burdensome, and not proportional to the needs of the case because it seeks
13 documents unrelated to trademark use in the United States. Smok will not search
14 for or produce email promotions that were not sent to recipients in the United
15 States. Smok will produce one representative sample—if any—of each email
16 promotion that Smok has sent to any of its marketing lists in the United States that
17 advertised goods offered under any of Smok's Alien Kit Marks

18 **PLAINTIFF'S POSITION:**

19 This Request seeks samples of Smok's email promotions for its infringing
20 products, which are indisputably relevant to Plaintiff's Lanham Act and breach of
21 contract claims. Smok has produced some documents but improperly limited the
22 scope of responsive materials to marketing lists in the United States and to products
23 specifically named "AL85" or "Alien." As previously explained, these limitations
24 are unacceptable because Plaintiff's claims are not limited to products sold within
25 the United States and because Plaintiff's claims encompass all the "Alien Kit
26 Marks," not just products named "AL85" or "Alien." Plaintiff therefore asks that
27 Smok withdraw the foregoing objections and produce all documents that are
28 responsive to RFP No. 32 within two weeks of the hearing on this motion

1 **SMOK'S POSITION:**

2 In the interest of brevity, Smok incorporates by reference the following
3 paragraphs from Smok's Omnibus Position on Document Requests: 3-4 (regarding
4 trademark use outside the United States) and 5 (regarding the definition of "Alien
5 Kit Marks").

6

7 **REQUEST FOR PRODUCTION NO. 34:**

8 All Documents concerning the type of person or entity to which SMOK's
9 goods are sold or marketed or intended to be sold or marketed, including, without
10 limitation, the person or entity's demographics (e.g., geographic location, age,
11 profession, education, and income).

12 **RESPONSE TO REQUEST FOR PRODUCTION NO. 34:**

13 Smok objects to this Request on the grounds that it is overbroad, unduly
14 burdensome, and not proportional to the needs of the case because it seeks
15 documents unrelated to consumers in the United States. Smok further objects to this
16 Request on the grounds that it seeks documents protected by the attorney-client
17 privilege, the attorney work product doctrine, or the common interest privilege.
18 Smok further objects to this Request on the grounds that "type of person" and "type
19 of entity" are vague and ambiguous.

20 Smok will produce non-privileged documents—if any—concerning the type
21 of person or entity to which Smok's goods are sold or marketed or intended to be
22 sold or marketed in the United States.

23 **PLAINTIFF'S POSITION:**

24 Smok has not produced a single document in response to this Request.
25 Documents responsive to RFP No. 34 contain information that is relevant to the
26 customer confusion inquiry, which will be used to determine whether Defendants
27 are liable for trademark infringement. It is not credible that a company as large and
28 sophisticated as Smok does not have a single document or communication

1 regarding its customer base, or efforts to market its products to a certain
2 demographic. Smok should produce these relevant documents.

3 Like its responses to numerous other RFPs, Smok has unjustifiably limited its
4 response to RFP No. 34 to products sold only within the United States. As
5 previously explained, this limitation is unacceptable because Plaintiff's claims are
6 not limited to products sold within the United States. Plaintiff therefore asks that
7 Smok withdraw the foregoing objections and produce all documents that are
8 responsive to RFP No. 34 within two weeks of the hearing on this motion.

9 **SMOK'S POSITION:**

10 Smok's search for non-privileged documents responsive to this request is
11 ongoing.

12 Finally, in the interest of brevity, Smok hereby incorporates by reference the
13 following paragraphs from Smok's Omnibus Position Regarding Document
14 Requests: 2 (regarding internal documents) and 3-4 (regarding trademark use
15 outside the United States).

16

17 **REQUEST FOR PRODUCTION NO. 35:**

18 Documents sufficient to show SMOK's advertising and promotional
19 expenditure for all goods bearing any of Smok's Alien Kit Marks on a monthly
20 basis.

21 **RESPONSE TO REQUEST FOR PRODUCTION NO. 35:**

22 Smok objects to this Request on the grounds that it is overbroad, unduly
23 burdensome, and not proportional to the needs of the case because it seeks
24 documents related to trademark use outside the United States. Smok will not search
25 for or produce documents showing Smok's advertising and promotional
26 expenditure outside the United States. Smok will not produce any financial
27 documents relating to its AL85 product on the grounds that Smok has never sold
28 that or any product under the name "Alien Baby," and therefore any such

1 documents are irrelevant to this action. Smok will produce non-privileged
2 documents—if any—sufficient to show Smok’s advertising and promotional
3 expenditure for all goods bearing Smok’s “Smok Alien” mark on a monthly basis.

4 **PLAINTIFF’S POSITION:**

5 Smok has not produced any documents regarding its advertising and
6 promotional expenditures for the infringing products at issue, except for
7 SMOK002406, an Excel spreadsheet summarizing Smok’s revenue, profit, and
8 costs for its Alien Kit vaporizer. The production of this spreadsheet, which appears
9 to have been created solely for this lawsuit, does not satisfy Smok’s discovery
10 obligations for several reasons. First, this spreadsheet is limited to sales in the
11 United States, which is improper because Plaintiff’s claims against Smok are not
12 limited to U.S. sales. In any event, Plaintiff is entitled to examine Smok’s financial
13 documents regarding the sales of its infringing products worldwide to determine
14 whether Smok’s claims regarding its U.S. sales are true. *See, e.g., Wahoo Int’l, Inc.*
15 *v. Phix Doctor, Inc.*, No. 13cv1395-GPC (BLM), 2014 U.S. Dist. LEXIS 98044, at
16 *20-21 (S.D. Cal. July 18, 2014) (plaintiff was entitled to underlying financial
17 documents to investigate defendant’s sales numbers where defendant only produced
18 an Excel spreadsheet reflecting total sales).

19 Second, summaries like SMOK002406 are not admissible. Thus, if Smok
20 seeks to use any of the financial data on this spreadsheet as evidence in this case,
21 Smok is required to produce the documents underlying this summary. *See, e.g., H-*
22 *D Mich., Inc. v. Bikers Dream, Inc.*, No. CV 97-864 SVW (CWx), 1998 U.S. Dist.
23 LEXIS 17259, at *18 (C.D. Cal. July 28, 1998) (“A summary is not admissible
24 unless the records summarized have been made available to the opposing party.”);
25 *Davis & Cox v. Summa Corp.*, 751 F.2d 1507, 1516-17 (9th Cir. 1985) (a summary
26 is not admissible if it does not fairly represent the underlying documents and the
27 underlying documents have not been made available).

28 Third, the spreadsheet is improperly limited to Smok’s “Alien” vaporizer,

1 even though infringing products in this lawsuit are not so limited. Smok has no
2 basis for refusing to produce documents regarding its advertising and promotional
3 expenditure for its other “Alien Kit Marks” products, given their relevance to this
4 lawsuit and the fact that Smok’s documents confirm that it sold products under the
5 other Alien Kit Marks. McConnell Decl., ¶¶ 28-29, Exs. 15-16.

6 To respond to RFP No. 35, Smok should produce its underlying accounting
7 and financial documents that reflect Smok’s advertising and promotional
8 expenditure for all goods bearing any of Smok’s Alien Kit Marks. During the
9 parties’ meet and confer session on March 5, 2018, Smok stated that it would
10 produce “some” underlying cost documents for the numbers in the Excel
11 spreadsheet, but could not say whether these cost documents would include any
12 advertising or promotional expenditures. McConnell Decl., ¶ 33. Given that Smok
13 is a public company, Plaintiff expects that Smok has accounting documents and
14 audit reports that show its monthly advertising and promotional expenditures on the
15 products at issue. Plaintiff requests that Smok produce these documents within two
16 weeks of the hearing on this motion.

17 **SMOK’S POSITION:**

18 Sarieddine’s position ignores the fact that Smok has produced an additional
19 internal document (bates-labeled SMOK001700) showing Smok’s advertising and
20 promotional expenditures.

21 Finally, in the interest of brevity, Smok hereby incorporates by reference the
22 following paragraphs from Smok’s Omnibus Position Regarding Document
23 Requests: 3-4 (regarding trademark use outside the United States); 5 (regarding the
24 definition of “Alien Kit Marks”); 6-7 (regarding financial information for AL85
25 goods); and 8 (regarding Smok’s financial document production).

26
27 **REQUEST FOR PRODUCTION NO. 36:**

28 Documents sufficient to identify every retailer, distributor or vendor that sells

1 any goods bearing SMOK's Alien Kit Marks.

2 **RESPONSE TO REQUEST FOR PRODUCTION NO. 36:**

3 Smok objects to this Request on the grounds that it is overbroad, unduly
4 burdensome, and not proportional to the needs of the case because (1) goods
5 bearing Smok's Alien Kit Marks are sold by thousands of retailers, distributors, and
6 vendors in the United States, and such identification would not materially affect any
7 claim or defense in this action; and (2) it seeks to identify retailers, distributors, and
8 vendors outside the United States.

9 **PLAINTIFF'S POSITION:**

10 Smok has objected to producing documents responsive to this Request,
11 claiming that it is "unduly burdensome" because goods bearing Smok's Alien Kit
12 Marks are sold by thousands of retailers, distributors, and vendors in the United
13 States." As a compromise, Plaintiff has offered to accept documents identifying
14 Smok's top twenty distributors of products bearing Smok's Alien Kit Marks,
15 measured by gross sales. Plaintiff expects that Smok has accounting or marketing
16 documents that identify its highest grossing U.S. distributors of "Alien"-branded
17 products and asks that Smok produce these documents within two weeks of the
18 hearing on this motion.

19 **SMOK'S POSITION:**

20 Smok will produce a list of its top 20 distributors of SMOK ALIEN goods in
21 the United States, measured by gross sales.

22
23 **REQUEST FOR PRODUCTION NO. 37:**

24 Each marketing plan SMOK has created since January 2016 that include
25 goods that bear any of SMOK's Alien Kit Marks.

26 **RESPONSE TO REQUEST FOR PRODUCTION NO. 37:**

27 Smok objects to this Request on the grounds that it is overbroad, unduly
28 burdensome, and not proportional to the needs of the case because it seeks

1 documents unrelated to trademark use in the United States. Smok will not search
2 for or produce marketing plans directed to markets outside the United States. Smok
3 will produce marketing plans—if any—that it has created relating to the United
4 States since January 2016 that include goods that bear any of Smok’s Alien Kit
5 Marks.

6 **PLAINTIFF’S POSITION:**

7 Smok has not produced a single document in response to this Request.
8 Documents responsive to RFP No. 37 contain information that is relevant to the
9 customer confusion inquiry, which will be used to determine whether Defendants
10 are liable for trademark infringement. It is not credible that a company as large and
11 sophisticated as Smok does not any marketing plans for the infringing products at
12 issue. Smok should produce these relevant documents.

13 Like its responses to numerous other RFPs, Smok has unjustifiably limited its
14 response to RFP No. 37 to products sold only within the United States and to
15 products specifically named “Alien” or “AL85.” As previously explained, these
16 limitations are unacceptable because Plaintiff’s claims are not limited to products
17 sold within the United States or products named “Alien” or “AL85.” Plaintiff
18 therefore asks that Smok withdraw the foregoing objections and produce all
19 documents that are responsive to RFP No. 37 within two weeks of the hearing on
20 this motion.

21 **SMOK’S POSITION:**

22 Sarieddine’s position ignores the fact that Smok has already produced several
23 internal marketing documents. Smok’ searched for additional non-privileged
24 documents responsive to this request is ongoing.

25 In the interest of brevity, Smok incorporates by reference the following
26 paragraphs from Smok’s Omnibus Position on Document Requests: 2 (regarding
27 internal documents); 3-4 (regarding trademark use outside the United States); and 5
28 (regarding the definition of “Alien Kit Marks”).

1

2 **REQUEST FOR PRODUCTION NO. 38:**

3 All Documents related to the role that an e-liquid or vaporizer's name has in
4 a consumer's purchasing decision or in product sales.

5 **RESPONSE TO REQUEST FOR PRODUCTION NO. 38:**

6 Smok objects to this Request on the grounds that it is overbroad, unduly
7 burdensome, and not proportional to the needs of the case because it seeks
8 documents related to consumers and product sales outside the United States. Smok
9 will not search for or produce documents related to the role that an e-liquid or
10 vaporizer's name in a non-United-States consumer's purchasing decision or in
11 product sales outside the United States. Smok further objects to this Request on the
12 grounds that it seeks documents protected by the attorney-client privilege, the
13 attorney work product doctrine, or the common interest doctrine. Smok will
14 produce non-privileged documents—if any—related to the role that an e-liquid or
15 vaporizer's name has in a United States consumer's purchasing decision or in
16 product sales in the United States.

17 **PLAINTIFF'S POSITION:**

18 Smok has not produced a single document in response to this Request.
19 Documents responsive to RFP No. 38 contain information that is relevant to the
20 customer confusion inquiry, which will be used to determine whether Defendants
21 are liable for trademark infringement. These documents are also relevant to
22 Plaintiff's claims that Smok willfully infringed its Alien Vape marks. Plaintiff
23 reasonably expects that Smok, a multinational company making millions of dollars
24 annually in e-cigarette sales, has documents regarding the role that an e-liquid or
25 vaporizer's name has in a consumer's purchasing decision or in product sales.
26 Given their relevance, Smok should produce these documents.

27 Like its responses to numerous other RFPs, Smok has unjustifiably limited its
28 response to RFP No. 38 to products sold only within the United States. As

1 previously explained, this limitation is unacceptable because Plaintiff's claims are
2 not limited to products sold within the United States. Plaintiff therefore asks that
3 Smok withdraw the foregoing objections and produce all documents that are
4 responsive to RFP No. 38 within two weeks of the hearing on this motion.

5 **SMOK'S POSITION:**

6 In the interest of brevity, Smok hereby incorporates the following paragraphs
7 from Smok's Omnibus Position Regarding Document Requests: 2 (regarding
8 internal documents) and 3-4 (regarding trademark use outside the United States).

9
10 **REQUEST FOR PRODUCTION NO. 39:**

11 All internal Communications related to the Contract, Sarieddine, this Action,
12 or the claims therein.

13 **RESPONSE TO REQUEST FOR PRODUCTION NO. 39:**

14 Smok objects to the Request as unduly burdensome and harassing to the
15 extent it seeks internal Communications related to this Action or the claims therein.
16 Smok will not search for or produce internal Communications related to this Action
17 or the claims therein. Smok objects to this Request on the grounds that it seeks
18 documents protected by the attorney-client privilege or the attorney work product
19 doctrine. Smok will produce non-privileged internal communications—if any—
20 related to the purported “Contract” and Sarieddine.

21 **PLAINTIFF'S POSITION:**

22 Smok's blanket refusal to search for or produce *any* internal communications
23 relating to this action is improper. Not all internal communications are protected by
24 the attorney-client privilege or the attorney work product doctrine. Smok has been
25 communicating with Plaintiff since August 2016, which is long before Smok
26 retained counsel in this lawsuit. Furthermore, Smok's counsel went on the record
27 during the preliminary injunction hearings to say that Smok negotiated the entire
28 Settlement Agreement without any counsel from any lawyers and that they had just

1 recently been hired. Plaintiff therefore reasonably expects that there are internal
2 communications, exchanged between Smok employees, regarding Plaintiff, the
3 settlement agreement, and the claims in this lawsuit that are not privileged. Smok
4 should search for and produce these responsive non-privileged documents.

5 To the extent that Smok has withheld responsive communications on
6 privilege grounds, Smok must provide a privilege log. In accordance with the
7 instructions provided in Plaintiff's discovery requests, this privilege log should
8 include the following information: (a) the date of the communication; (b) the
9 subject matter of the communication; (c) the names, addresses, job titles, and
10 employers of all persons with knowledge or a copy of the information, and (d) the
11 nature of the privilege asserted.

12 Plaintiff requests that Smok produce all documents responsive to RFP No.
13 39, along with a privilege log if Smok has withheld any documents, within two
14 weeks of the hearing on this motion.

15 **SMOK'S POSITION:**

16 Sarieddine argues that Smok cannot object to producing internal
17 communications related to this action because Smok negotiated the purported
18 agreement with Sarieddine without legal counsel. But even if those negotiations
19 resulted in internal written communications, such documents are covered by
20 Sarieddine's request for internal communications related to "the Contract" or
21 "Sarieddine." Sarieddine has not (and cannot) set forth any reasonable argument
22 that he is entitled to Smok's internal communications regarding this lawsuit or his
23 claims, especially separate and apart from the documents Smok has agreed to
24 search for and produce (if located).

25 Finally, in the interest of brevity, Smok incorporates the following
26 paragraphs from Smok's Omnibus Section Regarding Document Requests: 2
27 (regarding internal documents) and 12 (regarding a privilege log).

28

1 **REQUEST FOR PRODUCTION NO. 40:**

2 All internal Communications related to Sarieddine or Sarieddine's Alien
3 Vape Marks.

4 **RESPONSE TO REQUEST FOR PRODUCTION NO. 40:**

5 Smok objects to this Request on the grounds that it seeks documents
6 protected by the attorney-client privilege or the attorney work product doctrine.
7 Smok will produce non-privileged internal communications—if any—related to
8 Sarieddine or Sarieddine's Alien Vape Marks.

9 **PLAINTIFF'S POSITION:**

10 Smok has not produced a single document in response to this Request. Given
11 that Plaintiff and Smok were in a contractual relationship and Smok employees
12 have been communicating with Plaintiff since August 2016, Plaintiff reasonably
13 expects that there are have been communications among Smok employees that
14 mention either Plaintiff or his Alien Vape Marks. Plaintiff therefore requests that
15 Smok search for and produce all internal communications that relate to Plaintiff or
16 his trademarks.

17 To the extent that Smok has withheld responsive communications on
18 privilege grounds, Smok must provide a privilege log. In accordance with the
19 instructions provided in Plaintiff's discovery requests, this privilege log should
20 include the following information: (a) the date of the communication; (b) the
21 subject matter of the communication; (c) the names, addresses, job titles, and
22 employers of all persons with knowledge or a copy of the information, and (d) the
23 nature of the privilege asserted.

24 Plaintiff requests that Smok produce all documents responsive to RFP No.
25 40, along with a privilege log if Smok has withheld any documents, within two
26 weeks of the hearing on this motion.

27 **SMOK'S POSITION:**

28 Smok's search for non-privileged documents responsive to this request is

1 ongoing.

2 Finally, in the interest of brevity, Smok incorporates paragraph 12 (regarding
3 a privilege log) of Smok's Omnibus Position Regarding Document Requests.

4

5 **REQUEST FOR PRODUCTION NO. 41:**

6 All Documents related to SMOK's decision to discontinue purchasing
7 Sarieddine's Alien Vape e-liquid pursuant to Section 3.1.1 of the Contract.

8 **RESPONSE TO REQUEST FOR PRODUCTION NO. 41:**

9 Smok objects to this Request on the grounds that it seeks documents
10 protected by the attorney-client privilege, the attorney work product doctrine, or the
11 common interest privilege. Smok will produce non-privileged documents—if any—
12 related to its decision to discontinue purchasing Sarieddine's Alien Vape e-liquid.

13 **PLAINTIFF'S POSITION:**

14 Smok has not produced a single internal company document or
15 communication in response to this Request. Plaintiff reasonably expects that Smok
16 has documents regarding its decision to discontinue purchasing Plaintiff's Alien
17 Vape e-liquid, which violated Section 3 of the Settlement Agreement. As an
18 affirmative defense to Plaintiff's breach of contract claim, Smok alleged that it
19 stopped purchasing Plaintiff's e-liquid because it was prohibited from selling that e-
20 liquid under Chinese law. Given that Smok has been raising this affirmative
21 defense for the past year, Smok must have at least some documents in its
22 possession, custody, or control regarding this defense. These responsive documents
23 should be produced.

24 To the extent that Smok has withheld responsive communications on
25 privilege grounds, including on joint defense or common interest privilege grounds,
26 Smok must provide a privilege log. In accordance with the instructions provided in
27 Plaintiff's discovery requests, this privilege log should include the following
28 information: (a) the date of the communication; (b) the subject matter of the

1 communication; (c) the names, addresses, job titles, and employers of all persons
2 with knowledge or a copy of the information, and (d) the nature of the privilege
3 asserted.

4 Plaintiff requests that Smok produce all documents responsive to RFP No.
5 41, along with a privilege log if Smok has withheld any documents, within two
6 weeks of the hearing on this motion.

7 **SMOK'S POSITION:**

8 Smok has located non-privileged documents responsive to this request, and
9 will endeavor to produce them by March 30, 2018.

10 Finally, in the interest of brevity, Smok incorporates paragraph 12 (regarding
11 a privilege log) of Smok's Omnibus Position Regarding Document Requests.

12

13 **REQUEST FOR PRODUCTION NO. 42:**

14 All Documents related to SMOK's decision to discontinue advertising
15 Sarieddine's Alien Vape e-liquid pursuant to Sections 3.1.2 through 3.1.7 of the
16 Contract.

17 **RESPONSE TO REQUEST FOR PRODUCTION NO. 42:**

18 Smok objects to this Request on the grounds that it seeks documents
19 protected by the attorney-client privilege, the attorney work product doctrine, or the
20 common interest privilege. Smok will produce non-privileged documents—if any—
21 related to its decision to discontinue advertising Sarieddine's Alien Vape e-liquid.

22 **PLAINTIFF'S POSITION:**

23 Smok has not produced a single internal company document or
24 communication in response to this Request. Plaintiff reasonably expects that Smok
25 has documents regarding its decision to discontinue advertising Plaintiff's Alien
26 Vape e-liquid, which violated Section 3 of the Settlement Agreement. As an
27 affirmative defense to Plaintiff's breach of contract claim, Smok alleged that it
28 stopped purchasing Plaintiff's e-liquid because it was prohibited from selling that e-

1 liquid under Chinese law. Given that Smok has been raising this affirmative
2 defense for the past year, Smok must have at least some documents in its
3 possession, custody, or control regarding this defense. These responsive documents
4 should be produced.

5 To the extent that Smok has withheld responsive communications on
6 privilege grounds, Smok must provide a privilege log. In accordance with the
7 instructions provided in Plaintiff's discovery requests, this privilege log should
8 include the following information: (a) the date of the communication; (b) the
9 subject matter of the communication; (c) the names, addresses, job titles, and
10 employers of all persons with knowledge or a copy of the information, and (d) the
11 nature of the privilege asserted.

12 Plaintiff requests that Smok produce all documents responsive to RFP No.
13 42, along with a privilege log if Smok has withheld any documents, within two
14 weeks of the hearing on this motion.

15 **SMOK'S POSITION:**

16 Smok has located non-privileged documents responsive to this request, and
17 will endeavor to produce them by March 30, 2018.

18 Finally, in the interest of brevity, Smok incorporates paragraph 12 (regarding
19 a privilege log) of Smok's Omnibus Position Regarding Document Requests.

21 **REQUEST FOR PRODUCTION NO. 44:**

22 All Documents and Communications related to any communications with
23 any third parties discussing challenging the validity or enforceability of the Alien
24 Vape Marks dated before May 31, 2017.

25 **RESPONSE TO REQUEST FOR PRODUCTION NO. 44:**

26 Smok objects to this Request on the grounds that it seeks documents and
27 communications protected by the attorney-client privilege, the attorney work
28 product doctrine, or the common interest privilege. Smok will produce non-

1 privileged documents and communications—if any—related to any
2 communications with any third parties discussing challenging the validity or
3 enforceability of the Alien Vape marks dated before May 31, 2017.

4 **PLAINTIFF'S POSITION:**

5 This Request seeks Smok's communications with third parties regarding the
6 validity of Plaintiff's Alien Vape Marks before May 31, 2017, which is when Smok
7 purported to “terminate” the Settlement Agreement with Plaintiff. These
8 documents are relevant to Plaintiff's claims for breach of contract and breach of the
9 implied covenant of good faith and fair dealing against Smok, which allege that
10 Smok worked with third parties to challenge Plaintiff's Alien Vape Marks in
11 violation of the Settlement Agreement.

12 Smok has not produced any documents in response to this Request. Plaintiff
13 reasonably expects that Smok has communications with third parties that are
14 responsive, especially given the admission of Smok's CEO in a message to Plaintiff
15 that Smok is working with Big Bang to invalidate Plaintiff's marks. McConnell
16 Decl., ¶ 23, Ex. 13.

17 During the parties' meet and confer session on March 5, 2018, Smok
18 revealed for the first time that it has “no written record” of these missing third-party
19 communications. *Id.*, ¶ 22. However, documents produced in this lawsuit
20 demonstrate Smok employees tend to use email, WeChat, and Skype to
21 communicate with individuals outside the company. *Id.*, ¶ 23, Ex. 13. This is
22 consistent with Plaintiff's own experience, as the vast majority of Plaintiff's
23 communications with Smok occurred through these means. *Id.*, ¶ 23. Plaintiff
24 therefore expects that Smok has responsive communications with third parties in its
25 possession, custody, or control.

26 Furthermore, given the Court's recent order denying Big Bang's request to
27 consolidate its case with the case against Smok, Smok should not withhold
28

1 responsive communications with Big Bang on privilege grounds. *See* Case No.
2 Case 2:17-cv-00989-DSF-SK, Dkt. 71. As the Court noted, the differences
3 between Plaintiff's cases against Smok and Big Bang include "different defendants,
4 different products in different geographic markets, and different time periods." *Id.*
5 Because of these significant differences, Smok and Big Bang are not pursuing a
6 joint legal strategy, and most, if not all, communications with Big Bang would not
7 fall within the purview of the common interest privilege. *See, e.g., Nidec Corp. v.*
8 *Victor Co.*, 249 F.R.D. 575, 579 (N.D. Cal. 2007) (noting that the common interest
9 privilege applies only to communications made in the course of "formulating
10 a *common legal strategy*" or otherwise furthering the parties' joint interest in a
11 lawsuit).

12 To the extent that Smok has withheld any responsive communications on
13 privilege grounds, Smok must provide a privilege log. In accordance with the
14 instructions provided in Plaintiff's discovery requests, this privilege log should
15 include the following information: (a) the date of the communication; (b) the
16 subject matter of the communication; (c) the names, addresses, job titles, and
17 employers of all persons with knowledge or a copy of the information, and (d) the
18 nature of the privilege asserted.

19 Plaintiff requests that Smok produce all documents responsive to RFP No.
20 44, along with a privilege log if Smok has withheld any documents, within two
21 weeks of the hearing on this motion.

22 **SMOK'S POSITION:**

23 Sarieddine's position regarding the common-interest privilege between Smok
24 and Big Bang is incorrect. While the two cases were not consolidated, there is
25 undisputed overlap between the cases with respect to a number of issues, including
26 the scope of protection for Sarieddine's ALIEN VAPE marks. Sarieddine's
27 implication that most communications Smok and Big Bang (including their
28 respective attorneys) would cover areas where the cases do not overlap is dubious.

1 Smok is entitled to withhold communications between its counsel and Big Bang's
2 by virtue of the common-interest privilege.

3 Finally, in the interest of brevity, Smok incorporates the following
4 paragraphs from Smok's Omnibus Position Regarding Document Requests: 9
5 (regarding third-party communications) and 12 (regarding a privilege log).

6

7 **REQUEST FOR PRODUCTION NO. 45:**

8 All Documents and Communications related to SMOK supporting, aiding, or
9 assisting any third party in contesting the validity or enforceability of the Alien
10 Vape Marks before May 31, 2017.

11 **RESPONSE TO REQUEST FOR PRODUCTION NO. 45:**

12 Smok objects to this Request on the grounds that it seeks documents and
13 communications protected by the attorney-client privilege, the attorney work
14 product doctrine, or the common interest privilege. Smok will produce non-
15 privileged documents and communications—if any—related to Smok supporting,
16 aiding, or assisting any third party in contesting the validity or enforceability of the
17 Alien Vape Marks before May 31, 2017.

18 **PLAINTIFF'S POSITION:**

19 This Request seeks Smok's communications with third parties regarding
20 efforts to challenge the validity of Plaintiff's Alien Vape Marks. Specifically, RFP
21 No. 45 is focused on communications that occurred *before* May 31, 2017, which is
22 when Smok announced that it was terminating the Settlement Agreement. These
23 communications are relevant to Plaintiff's claims for breach of contract and breach
24 of the implied covenant of good faith and fair dealing against Smok, which allege
25 that Smok worked with third parties to challenge Plaintiff's Alien Vape Marks in
26 violation of the Settlement Agreement.

27 Smok has not produced any documents in response to this Request. Plaintiff
28 reasonably expects that Smok has communications with third parties that are

1 responsive, especially given the admission of Smok's CEO in a message to Plaintiff
2 that Smok is working with Big Bang to invalidate Plaintiff's marks. McConnell
3 Decl., ¶ 23, Ex. 13.

4 During the parties' meet and confer session on March 5, 2018, Smok
5 revealed for the first time that it has "no written record" of these missing third-party
6 communications. *Id.*, ¶ 22. However, documents produced in this lawsuit,
7 discussions with third parties, and Plaintiff's own interactions with Smok,
8 demonstrate Smok employees virtually exclusively to use email, WeChat, and
9 Skype to communicate with individuals outside the company. *Id.*, ¶ 23, Ex. 13.
10 This is consistent with Plaintiff's own experience, as the vast majority of Plaintiff's
11 communications with Smok occurred through these means. *Id.*, ¶ 23. This is also
12 consistent with the fact that Smok is a Chinese company and phone calls or in-
13 person meetings do not make sense given the time difference and language barrier.
14 Plaintiff therefore expects that Smok has responsive communications with third
15 parties in its possession, custody, or control.

16 Furthermore, given the Court's recent order denying Big Bang's request to
17 consolidate its case with the case against Smok, Smok should not withhold
18 responsive communications with Big Bang on privilege grounds. *See* Case No.
19 Case 2:17-cv-00989-DSF-SK, Dkt. 71. As the Court noted, the differences
20 between Plaintiff's cases against Smok and Big Bang include "different defendants,
21 different products in different geographic markets, and different time periods." *Id.*
22 Because of these significant differences, Smok and Big Bang are not pursuing a
23 joint legal strategy, and most, if not all, communications with Big Bang would not
24 fall within the purview of the common interest privilege. *See, e.g., Nidec Corp. v.*
25 *Victor Co.*, 249 F.R.D. 575, 579 (N.D. Cal. 2007) (noting that the common interest
26 privilege applies only to communications made in the course of "formulating
27 a *common legal strategy*" or otherwise furthering the parties' joint interest in a
28 lawsuit).

1 To the extent that Smok has withheld any responsive communications on
2 privilege grounds, Smok must provide a privilege log. In accordance with the
3 instructions provided in Plaintiff's discovery requests, this privilege log should
4 include the following information: (a) the date of the communication; (b) the
5 subject matter of the communication; (c) the names, addresses, job titles, and
6 employers of all persons with knowledge or a copy of the information, and (d) the
7 nature of the privilege asserted.

8 Plaintiff requests that Smok produce all documents responsive to RFP No.
9 45, along with a privilege log if Smok has withheld any documents, within two
10 weeks of the hearing on this motion.

11 || SMOK'S POSITION:

12 Sarieddine’s position regarding the common-interest privilege between Smok
13 and Big Bang is incorrect. While the two cases were not consolidated, there is
14 undisputed overlap between the cases with respect to a number of issues, including
15 the scope of protection for Sarieddine’s ALIEN VAPE marks. Sarieddine’s
16 implication that most communications Smok and Big Bang (including their
17 respective attorneys) would cover areas where the cases do not overlap is dubious.
18 Smok is entitled to withhold communications between its counsel and Big Bang’s
19 by virtue of the common-interest privilege.

Finally, in the interest of brevity, Smok incorporates the following paragraphs from Smok's Omnibus Position Regarding Document Requests: 9 (regarding third-party communications) and 12 (regarding a privilege log).

24 REQUEST FOR PRODUCTION NO. 46:

25 All Documents and Communications related to SMOK supporting, aiding, or
26 assisting any third party in contesting the validity or enforceability of the Alien
27 Vape Marks after May 31, 2017.

1 **RESPONSE TO REQUEST FOR PRODUCTION NO. 46:**

2 Smok objects to this Request on the grounds that it seeks documents and
3 communications protected by the attorney-client privilege, the attorney work
4 product doctrine, or the common interest privilege. Smok will produce non-
5 privileged documents and communications—if any—related to Smok supporting,
6 aiding, or assisting any third party in contesting the validity or enforceability of the
7 Alien Vape Marks after May 31, 2017.

8 **PLAINTIFF'S POSITION:**

9 This Request seeks Smok's communications with third parties regarding
10 efforts to challenge the validity of Plaintiff's Alien Vape Marks. Specifically, RFP
11 No. 46 is focused on communications that occurred *after* May 31, 2017, which is
12 when Smok announced that it was terminating the Settlement Agreement. These
13 communications are relevant to Plaintiff's claims for breach of contract and breach
14 of the implied covenant of good faith and fair dealing against Smok, which allege
15 that Smok worked with third parties to challenge and invalidate Plaintiff's Alien
16 Vape Marks in violation of the Settlement Agreement.

17 Smok has not produced any documents in response to this Request. Plaintiff
18 reasonably expects that Smok has communications with third parties that are
19 responsive, especially given the admission of Smok's CEO in a message to Plaintiff
20 that Smok is working with Big Bang to invalidate Plaintiff's marks. McConnell
21 Decl., ¶ 23, Ex. 13.

22 During the parties' meet and confer session on March 5, 2018, Smok
23 revealed for the first time that it has “no written record” of these missing third-party
24 communications. *Id.*, ¶ 22. However, other documents produced in this lawsuit
25 demonstrate Smok employees tend to use email, WeChat, and Skype to
26 communicate with individuals outside the company. *Id.*, ¶ 23, Ex. 13. This is
27 consistent with Plaintiff's own experience, as the vast majority of Plaintiff's
28 communications with Smok occurred through these means. *Id.*, ¶ 23. This is also

1 consistent with the fact that Smok is a Chinese company and phone calls or in-
2 person meetings do not make sense given the time difference and language barrier.
3 Plaintiff therefore expects that Smok has responsive communications with third
4 parties in its possession, custody, or control.

5 Furthermore, given the Court's recent order denying Big Bang's request to
6 consolidate its case with the case against Smok, Smok should not withhold
7 responsive communications with Big Bang on privilege grounds. *See* Case No.
8 Case 2:17-cv-00989-DSF-SK, Dkt. 71. As the Court noted, the differences
9 between Plaintiff's cases against Smok and Big Bang include "different defendants,
10 different products in different geographic markets, and different time periods." *Id.*
11 Because of these significant differences, Smok and Big Bang are not pursuing a
12 joint legal strategy, and most, if not all, communications with Big Bang would not
13 fall within the purview of the common interest privilege. *See, e.g., Nidec Corp. v.*
14 *Victor Co.*, 249 F.R.D. 575, 579 (N.D. Cal. 2007) (noting that the common interest
15 privilege applies only to communications made in the course of "formulating
16 a *common legal strategy*" or otherwise furthering the parties' joint interest in a
17 lawsuit).

18 To the extent that Smok has withheld any responsive communications on
19 privilege grounds, Smok must provide a privilege log. In accordance with the
20 instructions provided in Plaintiff's discovery requests, this privilege log should
21 include the following information: (a) the date of the communication; (b) the
22 subject matter of the communication; (c) the names, addresses, job titles, and
23 employers of all persons with knowledge or a copy of the information, and (d) the
24 nature of the privilege asserted.

25 Plaintiff requests that Smok produce all documents responsive to RFP No.
26 46, along with a privilege log if Smok has withheld any documents, within two
27 weeks of the hearing on this motion.

28

1 **SMOK'S POSITION:**

2 Sarieddine's position regarding the common-interest privilege between Smok
3 and Big Bang is incorrect. While the two cases were not consolidated, there is
4 undisputed overlap between the cases with respect to a number of issues, including
5 the scope of protection for Sarieddine's ALIEN VAPE marks. Sarieddine's
6 implication that most communications Smok and Big Bang (including their
7 respective attorneys) would cover areas where the cases do not overlap is dubious.
8 Smok is entitled to withhold communications between its counsel and Big Bang's
9 by virtue of the common-interest privilege.

10 Finally, in the interest of brevity, Smok incorporates the following
11 paragraphs from Smok's Omnibus Position Regarding Document Requests: 9
12 (regarding third-party communications) and 12 (regarding a privilege log).

13
14 **REQUEST FOR PRODUCTION NO. 47:**

15 All Documents and Communications between SMOK and any third party
16 concerning the Contract.

17 **RESPONSE TO REQUEST FOR PRODUCTION NO. 47:**

18 Smok objects to this Request on the grounds that it seeks documents and
19 communications protected by the attorney-client privilege, the attorney work
20 product doctrine, or the common interest privilege. Smok will produce non-
21 privileged documents and communications—if any—between Smok and any third
22 party concerning the purported “Contract.”

23 **PLAINTIFF'S POSITION:**

24 This Request seeks Smok's communications with third parties regarding the
25 Settlement Agreement between Plaintiff and Smok. These communications are
26 relevant to Plaintiff's claims for breach of contract and breach of the implied
27 covenant of good faith and fair dealing against Smok, which allege that Smok
28 communicated with third parties about challenging and invalidating Plaintiff's

1 Alien Vape Marks in violation of the Settlement Agreement.

2 Smok has not produced any documents in response to this Request. Plaintiff
3 reasonably expects that Smok has communications with third parties that are
4 responsive, especially given the admission of Smok's CEO in a message to Plaintiff
5 that Smok is working with Big Bang to invalidate Plaintiff's marks. McConnell
6 Decl., ¶ 23, Ex. 13.

7 During the parties' meet and confer session on March 5, 2018, Smok
8 revealed for the first time that it has "no written record" of these missing third-party
9 communications. *Id.*, ¶ 22. However, other documents produced in this lawsuit
10 demonstrate Smok employees tend to use email, WeChat, and Skype to
11 communicate with individuals outside the company. *Id.*, ¶ 23, Ex. 13. This is
12 consistent with Plaintiff's own experience, as the vast majority of Plaintiff's
13 communications with Smok occurred through these means. *Id.*, ¶ 23. Plaintiff
14 therefore expects that Smok has responsive communications with third parties in its
15 possession, custody, or control.

16 Furthermore, given the Court's recent order denying Big Bang's request to
17 consolidate its case with the case against Smok, Smok should not withhold
18 responsive communications with Big Bang on privilege grounds. *See* Case No.
19 Case 2:17-cv-00989-DSF-SK, Dkt. 71. As the Court noted, the differences
20 between Plaintiff's cases against Smok and Big Bang include "different defendants,
21 different products in different geographic markets, and different time periods." *Id.*
22 Because of these significant differences, Smok and Big Bang are not pursuing a
23 joint legal strategy, and most, if not all, communications with Big Bang would not
24 fall within the purview of the common interest privilege. *See, e.g., Nidec Corp. v.*
25 *Victor Co.*, 249 F.R.D. 575, 579 (N.D. Cal. 2007) (noting that the common interest
26 privilege applies only to communications made in the course of "formulating
27 a *common legal strategy*" or otherwise furthering the parties' joint interest in a
28 lawsuit).

1 To the extent that Smok has withheld any responsive communications on
2 privilege grounds, Smok must provide a privilege log. In accordance with the
3 instructions provided in Plaintiff's discovery requests, this privilege log should
4 include the following information: (a) the date of the communication; (b) the
5 subject matter of the communication; (c) the names, addresses, job titles, and
6 employers of all persons with knowledge or a copy of the information, and (d) the
7 nature of the privilege asserted.

8 Plaintiff requests that Smok produce all documents responsive to RFP No.
9 47, along with a privilege log if Smok has withheld any documents, within two
10 weeks of the hearing on this motion.

11 **SMOK'S POSITION:**

12 Sarieddine's position regarding the common-interest privilege between Smok
13 and Big Bang is incorrect. While the two cases were not consolidated, there is
14 undisputed overlap between the cases with respect to a number of issues, including
15 the scope of protection for Sarieddine's ALIEN VAPE marks. Sarieddine's
16 implication that most communications Smok and Big Bang (including their
17 respective attorneys) would cover areas where the cases do not overlap is dubious.
18 Smok is entitled to withhold communications between its counsel and Big Bang's
19 by virtue of the common-interest privilege.

20 Finally, in the interest of brevity, Smok incorporates the following
21 paragraphs from Smok's Omnibus Position Regarding Document Requests: 9
22 (regarding third-party communications) and 12 (regarding a privilege log).

23

24 **REQUEST FOR PRODUCTION NO. 48:**

25 All Documents and Communications concerning the Contract, including,
26 without limitation, edits to the Contract, internal and external correspondence,
27 emails, WeChat, and Skype logs regarding the Contract.

1 **RESPONSE TO REQUEST FOR PRODUCTION NO. 48:**

2 Smok objects to this Request on the grounds that it seeks documents and
3 communications protected by the attorney-client privilege, the attorney work
4 product doctrine, or the common interest privilege. Smok will produce non-
5 privileged documents and communications—if any—concerning the purported
6 “Contract.”

7 **PLAINTIFF’S POSITION:**

8 This Request seeks Smok’s documents and communications regarding the
9 Settlement Agreement, which are relevant to Plaintiff’s claims for breach of
10 contract and breach of the implied covenant of good faith and fair dealing. Smok
11 has not produced any internal documents or communications that are responsive to
12 this Request. The only communications that Smok has produced regarding the
13 Settlement Agreement are communications with Plaintiff or Plaintiff’s attorneys,
14 which were already in Plaintiff’s possession. Given that Smok is a sophisticated
15 multinational company, Plaintiff reasonably expects that Smok has at least some
16 internal documents and communications analyzing the Settlement Agreement and
17 discussing the benefits and drawbacks of Smok’s performance under that
18 agreement. Therefore, the lack of responsive documents in Smok’s production is
19 either caused by Smok’s failure to diligently search for these documents, or Smok’s
20 over-application of the attorney-client privilege.

21 To the extent that Smok has withheld responsive communications on
22 privilege grounds, including joint defense or common interest privilege, Smok must
23 provide a privilege log. In accordance with the instructions provided in Plaintiff’s
24 discovery requests, this privilege log should include the following information: (a)
25 the date of the communication; (b) the subject matter of the communication; (c) the
26 names, addresses, job titles, and employers of all persons with knowledge or a copy
27 of the information, and (d) the nature of the privilege asserted.

28 Plaintiff requests that Smok produce all documents responsive to RFP No.

1 48, along with a privilege log if Smok has withheld any documents, within two
2 weeks of the hearing on this motion.

3 **SMOK'S POSITION:**

4 Smok's search for non-privileged documents responsive to this request is
5 ongoing.

6 In the interest of brevity, Smok incorporates the following paragraphs from
7 Smok's Omnibus Position Regarding Document Requests: 2 (regarding internal
8 documents) and 12 (regarding a privilege log).

9
10 **REQUEST FOR PRODUCTION NO. 50:**

11 All Documents and Communications concerning or generated in connection
12 with any analysis, audit, review, or examination that SMOK, any party on behalf of
13 SMOK, or any other third-party conducted concerning the Contract.

14 **RESPONSE TO REQUEST FOR PRODUCTION NO. 50:**

15 Smok objects to this Request on the grounds that it seeks documents and
16 communications protected by the attorney-client privilege, the attorney work
17 product doctrine, or the common interest privilege. Smok will produce non-
18 privileged documents and communications—if any—concerning or generated in
19 connection with any analysis, audit, review, or examination that Smok, any party of
20 behalf of Smok, or any other third party conducted concerning the purported
21 “Contract.”

22 **PLAINTIFF'S POSITION:**

23 This Request seeks Smok's internal documents and communications
24 analyzing the Settlement Agreement between Plaintiff and Smok, as well as Smok's
25 communications with third parties on this subject. These documents and
26 communications are relevant to Plaintiff's claims for breach of contract and breach
27 of the implied covenant of good faith and fair dealing against Smok, which allege
28 that Smok breached the Settlement Agreement in bad faith and communicated with

1 third parties about strategies for invalidating Plaintiff's Alien Vape Marks.

2 Smok has not produced any documents in response to this Request. Plaintiff
3 reasonably expects that Smok has communications with third parties that are
4 responsive, especially given the admission of Smok's CEO in a message to Plaintiff
5 that Smok is working with Big Bang to invalidate Plaintiff's marks. McConnell
6 Decl., ¶ 23, Ex. 13.

7 During the parties' meet and confer session on March 5, 2018, Smok
8 revealed for the first time that it has "no written record" of these missing third-party
9 communications. *Id.*, ¶ 22. However, other documents produced in this lawsuit
10 demonstrate Smok employees tend to use email, WeChat, and Skype to
11 communicate with individuals outside the company. *Id.*, ¶ 23, Ex. 13. This is
12 consistent with Plaintiff's own experience, as the vast majority of Plaintiff's
13 communications with Smok occurred through these means. *Id.*, ¶ 23. Plaintiff
14 therefore expects that Smok has responsive communications with third parties in its
15 possession, custody, or control.

16 Furthermore, given the Court's recent order denying Big Bang's request to
17 consolidate its case with the case against Smok, Smok should not withhold
18 responsive communications with Big Bang on privilege grounds. *See* Case No.
19 Case 2:17-cv-00989-DSF-SK, Dkt. 71. As the Court noted, the differences
20 between Plaintiff's cases against Smok and Big Bang include "different defendants,
21 different products in different geographic markets, and different time periods." *Id.*
22 Because of these significant differences, Smok and Big Bang are not pursuing a
23 joint legal strategy, and most, if not all, communications with Big Bang would not
24 fall within the purview of the common interest privilege. *See, e.g., Nidec Corp. v.*
25 *Victor Co.*, 249 F.R.D. 575, 579 (N.D. Cal. 2007) (noting that the common interest
26 privilege applies only to communications made in the course of "formulating
27 a *common legal strategy*" or otherwise furthering the parties' joint interest in a
28 lawsuit).

1 To the extent that Smok has withheld any responsive communications on
2 privilege grounds, Smok must provide a privilege log. In accordance with the
3 instructions provided in Plaintiff's discovery requests, this privilege log should
4 include the following information: (a) the date of the communication; (b) the
5 subject matter of the communication; (c) the names, addresses, job titles, and
6 employers of all persons with knowledge or a copy of the information, and (d) the
7 nature of the privilege asserted.

8 Plaintiff requests that Smok produce all documents responsive to RFP No.
9 50, along with a privilege log if Smok has withheld any documents, within two
10 weeks of the hearing on this motion.

11 **SMOK'S POSITION:**

12 Smok has searched for but has not located any non-privileged documents
13 responsive to this request.

14 Sarieddine's position regarding the common-interest privilege between Smok
15 and Big Bang is incorrect. While the two cases were not consolidated, there is
16 undisputed overlap between the cases with respect to a number of issues, including
17 the scope of protection for Sarieddine's ALIEN VAPE marks. Sarieddine's
18 implication that most communications Smok and Big Bang (including their
19 respective attorneys) would cover areas where the cases do not overlap is dubious.
20 Smok is entitled to withhold communications between its counsel and Big Bang's
21 by virtue of the common-interest privilege.

22 Finally, in the interest of brevity, Smok incorporates the following
23 paragraphs from Smok's Omnibus Section Regarding Document Requests: 2
24 (regarding internal documents); 9 (regarding third-party communications); and 12
25 (regarding a privilege log).

26
27 **REQUEST FOR PRODUCTION NO. 51:**

28 All Documents and Communications related to your allegations that the

1 Contract is unenforceable, invalid, or illusory.

2 **RESPONSE TO REQUEST FOR PRODUCTION NO. 51:**

3 Smok objects to this Request on the grounds that it seeks documents and
4 communications protected by the attorney-client privilege, the attorney work
5 product doctrine, or the common interest privilege. Smok will produce non-
6 privileged documents and communications—if any—related to its allegations that
7 the purported “Contract” is unenforceable, invalid, or illusory.

8 **PLAINTIFF’S POSITION:**

9 This Request seeks Smok’s documents and communications regarding its
10 affirmative defenses that the Settlement Agreement is unenforceable, invalid, and
11 illusory. Given that Smok has been asserting these affirmative defenses for the past
12 year, Plaintiff reasonably expects that Smok has at least some documents relating to
13 these defenses. Therefore, the lack of responsive documents in Smok’s production
14 is either caused by Smok’s failure to diligently search for these documents, or
15 Smok’s over-application of the attorney-client, joint defense, or common interest
16 privileges.

17 To the extent that Smok has withheld responsive communications on
18 privilege grounds, including joint defense or common interest privilege, Smok must
19 provide a privilege log. In accordance with the instructions provided in Plaintiff’s
20 discovery requests, this privilege log should include the following information: (a)
21 the date of the communication; (b) the subject matter of the communication; (c) the
22 names, addresses, job titles, and employers of all persons with knowledge or a copy
23 of the information, and (d) the nature of the privilege asserted.

24 Plaintiff requests that Smok produce all documents responsive to RFP No.
25 51, along with a privilege log if Smok has withheld any documents, within two
26 weeks of the hearing on this motion.

27 **SMOK’S POSITION:**

28 Smok’s search for non-privileged documents responsive to this request is

1 ongoing.

2 In the interest of brevity, Smok incorporates the following paragraphs from
3 Smok's Omnibus Position Regarding Document Requests: 2 (regarding internal
4 documents) and 12 (regarding a privilege log).

5

6 **REQUEST FOR PRODUCTION NO. 52:**

7 All Documents and Communications with any governmental agencies or
8 third parties regarding SMOK's inability to sell e-liquid in China.

9 **RESPONSE TO REQUEST FOR PRODUCTION NO. 52:**

10 Smok objects to this Request on the grounds that it is overbroad, unduly
11 burdensome, and not proportional to the needs of the case because it seeks
12 documents unrelated to whether Smok was permitted to sell Sarieddine's Alien
13 Vape e-liquid in China. Smok will not search for or produce documents or
14 communications with governmental agencies or third parties unrelated to Smok's
15 inability to sell Sarieddine's Alien Vape e-liquid. Smok further objects to this
16 Request on the grounds that it seeks documents and communications protected by
17 the attorney-client privilege, the attorney work product doctrine, or the common
18 interest privilege. Smok will produce non-privileged documents and
19 communications—if any—with any governmental agencies or third parties
20 regarding Smok's inability to sell Sarieddine's Alien Vape e-liquid.

21 **PLAINTIFF'S POSITION:**

22 Smok has not produced a single document in response to this Request.
23 Plaintiff reasonably expects that Smok has documents regarding Smok's alleged
24 inability to sell e-liquid in China, which Smok raised as an affirmative defense to
25 Plaintiff's breach of contract claim. Given that Smok has been raising this
26 affirmative defense for the past year, Smok must have at least some documents in
27 its possession, custody, or control regarding this subject. Moreover, because RFP
28 No. 52 seeks Smok's communications with third parties, Plaintiff expects that most

1 (if not all) responsive documents and communications are not privileged.

2 During the parties' meet and confer session on March 5, 2018, Smok
3 expressed its willingness to produce documents in response to RFP No. 52, but did
4 not say when these documents would be produced. McConnell Decl., ¶ 21.
5 Plaintiff requests that Smok produce all documents responsive to RFP No. 52
6 within two weeks of the hearing on this motion.

7 **SMOK'S POSITION:**

8 Smok has located non-privileged documents responsive to this request, and
9 will endeavor to produce them by March 30, 2018.

10

11 **REQUEST FOR PRODUCTION NO. 53:**

12 All Documents and Communications related to your allegations that "Smok
13 learned that the ALIEN VAPE e-liquid did not comply with several Chinese
14 regulations. Smok attempted to clear those hurdles...."

15 **RESPONSE TO REQUEST FOR PRODUCTION NO. 53:**

16 Smok further objects to this Request on the grounds that it seeks documents
17 and communications protected by the attorney-client privilege, the attorney work
18 product doctrine, or the common interest doctrine. Smok will produce non-
19 privileged documents and communications—if any—related to its allegations that
20 "Smok learned that the ALIEN VAPE e-liquid did not comply with several Chinese
21 regulations. Smok attempted to clear those hurdles . . ."

22 **PLAINTIFF'S POSITION:**

23 Smok has not produced a single document in response to this Request.
24 Plaintiff reasonably expects that Smok has documents regarding its allegation that
25 Plaintiff's ALIEN VAPE e-liquid did not comply with Chinese regulations, which
26 Smok raised as an affirmative defense to Plaintiff's breach of contract claim. Given
27 that Smok has been raising this affirmative defense for the past year, Smok must
28 have at least some documents in its possession, custody, or control regarding this

1 subject. These responsive documents should be produced.

2 To the extent that Smok has withheld responsive communications on
3 privilege grounds, including on joint defense or common interest privilege grounds,
4 Smok must provide a privilege log. In accordance with the instructions provided in
5 Plaintiff's discovery requests, this privilege log should include the following
6 information: (a) the date of the communication; (b) the subject matter of the
7 communication; (c) the names, addresses, job titles, and employers of all persons
8 with knowledge or a copy of the information, and (d) the nature of the privilege
9 asserted.

10 Plaintiff requests that Smok produce all documents responsive to RFP No.
11 53, along with a privilege log if Smok has withheld any documents, within two
12 weeks of the hearing on this motion.

13 **SMOK'S POSITION:**

14 Smok has located non-privileged documents responsive to this request, and
15 will endeavor to produce them by March 30, 2018.

16 Finally, in the interest of brevity, Smok incorporates paragraph 12 (regarding
17 a privilege log) of Smok's Omnibus Position Regarding Document Requests.

19 **REQUEST FOR PRODUCTION NO. 54:**

20 All Documents and Communications related to Sarieddine's alleged failure
21 to "work with Smok to comply with Chinese regulations."

22 **RESPONSE TO REQUEST FOR PRODUCTION NO. 54:**

23 Smok objects to this Request on the grounds that it seeks documents and
24 communications protected by the attorney-client privilege, the attorney work
25 product doctrine, or the common interest doctrine. Smok will produce non-
26 privileged documents and communications—if any—related to Sarieddine's failure
27 to work with Smok to comply with Chinese regulations.

1 **PLAINTIFF'S POSITION:**

2 Smok has not produced a single document in response to this Request.
3 Plaintiff reasonably expects that Smok has documents regarding its allegation that
4 Plaintiff failed to “work with Smok to comply with Chinese regulations,” which
5 Smok raised as an affirmative defense to Plaintiff’s breach of contract claim. Given
6 that Smok has been raising this affirmative defense for the past year, Smok must
7 have at least some documents in its possession, custody, or control regarding this
8 subject. These responsive documents should be produced.

9 To the extent that Smok has withheld responsive communications on
10 privilege grounds, including on joint defense or common interest privilege grounds,
11 Smok must provide a privilege log. In accordance with the instructions provided in
12 Plaintiff’s discovery requests, this privilege log should include the following
13 information: (a) the date of the communication; (b) the subject matter of the
14 communication; (c) the names, addresses, job titles, and employers of all persons
15 with knowledge or a copy of the information, and (d) the nature of the privilege
16 asserted.

17 Plaintiff requests that Smok produce all documents responsive to RFP No.
18 54, along with a privilege log if Smok has withheld any documents, within two
19 weeks of the hearing on this motion.

20 **SMOK'S POSITION:**

21 Smok’ search for non-privileged documents responsive to this request is
22 ongoing.

23 Finally, in the interest of brevity, Smok incorporates paragraph 12 (regarding
24 a privilege log) of Smok’s Omnibus Position Regarding Document Requests.

26 **REQUEST FOR PRODUCTION NO. 55:**

27 All Documents and Communications that include any one of the following
28 terms: “Alien Baby”, “Sarieddine”, “Alien 2”, or “Alien Vape.

1 **RESPONSE TO REQUEST FOR PRODUCTION NO. 55:**

2 Smok objects to this Request as overbroad, unduly burdensome, and not
3 proportional to the needs of the case because Smok never produced any “Alien 2”
4 product. Smok will not search for or produce any Documents or Communications
5 including the term “Alien 2.” Smok objects to this Request on the grounds that it
6 seeks documents and communications protected by the attorney-client privilege, the
7 attorney work product doctrine, or the common interest doctrine. Smok will
8 produce non-privileged documents and communications—if any—that include any
9 of the terms “Alien Baby”, “Sarieddine”, or “Alien Vape.”

10 **PLAINTIFF’S POSITION:**

11 Smok has produced only a fraction of the documents that are responsive to
12 this Request. Smok had agreed to produce all internal communications that include
13 the term “Sarieddine” in response to this Request but has not produced any such
14 communications.

15 In addition, Smok’s production is devoid of any documents mentioning its
16 “Alien 2” product. Smok has refused to even search for documents mentioning the
17 phrase “Alien 2” on the grounds that Smok “never produced any ‘Alien 2’
18 product.” This objection is meritless. Documents produced by Plaintiff produced
19 reveal that Smok had plans to release a product known as “Alien 2” in spring of
20 2017. McConnell Decl., ¶ 30, Ex. 17. In addition, Smok’s distribution affiliates in
21 the United States had press releases on their websites regarding the Alien 2 product,
22 which were clearly given to them by Smok. *See* Dkt. 71-1, Plaintiff’s Motion for a
23 Preliminary Injunction, at pp. 6-7.

24 To the extent that Smok claims that “Alien 2” was only a temporary name, or
25 a “nickname” given to one of its vaporizers, that does not excuse Smok from having
26 to search for and produce “Alien 2” documents. There is no reason to limit the
27 scope of Plaintiff’s discovery to the current “official” names for Smok’s vaporizers.
28 Plaintiff is entitled to ask Smok about all e-cigarette products that have ever been

1 sold under any iteration of the “Alien” name, as such evidence is directly relevant
2 to Plaintiff’s Lanham Act and breach of contract claims.

3 To the extent that Smok has failed to locate documents mentioning “Alien 2”
4 because such documents are written in Mandarin, Smok should be translating these
5 documents into English to search for this phrase, as well as the other phrases
6 requested by RFP No. 55. The fact that a document contains the Mandarin
7 equivalent of the phrase “Alien 2,” for example, does not excuse Smok from having
8 to produce this document. If documents written in Mandarin are responsive to
9 Plaintiff’s discovery requests, they must be produced.

10 Plaintiff therefore asks that Smok produce all outstanding responsive
11 documents, including all documents mentioning “Sarieddine” and all documents
12 mentioning “Alien 2” within two weeks of the hearing on this motion.

13 **SMOK’S POSITION:**

14 Smok did make preliminary plans for an AL230 vaporizer, which some
15 potential distributors and customers referred to as the “Alien 2.” But no such
16 product was ever produced, much less brought to market. So Plaintiff’s purported
17 entitlement to ask Smok about all e-cigarette products that have ever been sold
18 under any iteration of the ‘Alien’ name” does not apply to the phrase “Alien 2,”
19 because no such product was ever sold.

20 Finally, in the interest of brevity, Smok incorporates paragraph 2 (regarding
21 internal documents) from Smok’s Omnibus Position Regarding Document
22 Requests.

23
24 **REQUEST FOR PRODUCTION NO. 56:**

25 All Documents and Communications related to SMOK’s decision to
26 discontinue referring to its “AL85” product as the “Alien Baby.”

27 **RESPONSE TO REQUEST FOR PRODUCTION NO. 56:**

28 Smok objects to this Request on the grounds that it seeks documents and

1 communications protected by the attorney-client privilege, the attorney work
2 product doctrine, or the common interest doctrine. Smok will produce non-
3 privileged documents and communications—if any—related to Smok’s alleged
4 decision.

5 **PLAINTIFF’S POSITION:**

6 To respond to this Request, Smok must produce emails and other internal
7 communications regarding Smok’s decision to change the name of its “Alien Baby”
8 product. Smok has not produced these documents. Smok cannot satisfy its
9 obligation to respond to this Request by producing advertisements and other
10 publicly available documents that simply mention “Alien Baby” or “AL85,” but do
11 not address Smok’s decision to change the name of this product.

12 During the parties’ meet and confer session on March 5, 2018, Smok
13 expressed its willingness to produce documents in response to RFP No. 56, but did
14 not say when these documents would be produced. McConnell Decl., ¶ 21.
15 Plaintiff is troubled by the discrepancy between Smok’s response to this RFP and
16 Smok’s responses to Plaintiff’s other discovery responses. Throughout Smok’s
17 responses to Plaintiff’s RFPs, and well as in its responses to Plaintiff’s
18 interrogatories, Smok has refused to produce information regarding its “Alien
19 Baby” product, claiming that it “never sold any product under the name ‘Alien
20 Baby.’” *See, e.g.*, Smok’s responses to Interrogatories Nos. 3-4 and 6, discussed
21 *infra*. In response to RFP No. 56, however, Smok acknowledges that it did sell a
22 product called the “Alien Baby,” as Smok agreed to produce documents regarding
23 its decision to discontinue that name. Plaintiff reiterates that Smok must fully
24 respond to all discovery requests regarding Smok’s “Alien Baby” product. The fact
25 that Smok has discontinued the “Alien Baby” name does not obviate or otherwise
26 modify Smok’s obligation to search for and produce responsive documents.

27 Plaintiff requests that Smok produce all documents responsive to RFP No. 56
28 within two weeks of the hearing on this motion.

1 **SMOK'S POSITION:**

2 Smok has located non-privileged documents responsive to this request, and
3 will endeavor to produce them by March 30, 2018.

4 There is no discrepancy between Smok's response to this request and Smok's
5 other responses to discovery requests. Smok does not dispute that the phrase "alien
6 baby" appears in a few instances of advertising and promotion for AL85 goods. But
7 "alien baby" was never the name of any Smok product. Smok's documents discuss
8 the decision to cease using the phrase "alien baby."

9

10 **REQUEST FOR PRODUCTION NO. 57:**

11 All Documents and Communications related to SMOK's decision to
12 discontinue referring to its "AL230" product as the "Alien 2."

13 **RESPONSE TO REQUEST FOR PRODUCTION NO. 57:**

14 Smok objects to this Request on the grounds that it overbroad, unduly
15 burdensome, and not proportional to the needs of the case because (1) Smok never
16 brought an "AL230" or "Alien 2" product to market and (2) Smok never referred to
17 any product as the "Alien 2." Smok further objects to this Request on the grounds
18 that it seeks documents and communications protected by the attorney-client
19 privilege, the attorney work product doctrine, or the common interest doctrine.

20 **PLAINTIFF'S POSITION:**

21 Smok's blanket refusal to respond to this Request because it "never brought
22 an 'AL230' or 'Alien 2' product to market" or "referred to any product as the
23 'Alien 2'" is improper. As previously noted, Plaintiff has documents demonstrating
24 that Smok had plans to release a product known as "Alien 2" in spring of 2017. *See,*
25 *e.g.*, SAR - 00019-SAR – 00020. Moreover, Smok's claim that it did not end up
26 giving the "Alien 2" or "AL230" name to any product "brought to market" does not
27 obviate Smok's obligation to respond to this Request. Plaintiff is entitled to review
28 Smok's internal communications regarding the possibility of naming one of its

1 vaporizers “AL230” and/or “Alien 2,” as well as any communications regarding
2 Smok’s alleged decision not to bring the “AL230” or “Alien 2” product to market.
3 Communications regarding Smok’s decision to use—or not use—the “Alien” name
4 on its vaporizers are directly relevant to Plaintiff’s Lanham Act and breach of
5 contract claims. Plaintiff therefore asks that Smok withdraw this objection and
6 search for and produce all communications that refer to Smok’s decision regarding
7 the naming of its “AL230” and “Alien 2” products.

8 **SMOK’S POSITION:**

9 This request refers to a particular product—namely, Smok’s “‘AL230’
10 product.” But, as discussed above, no such product ever existed. Moreover,
11 Sarieddine has not explained (nor can he) how a name that Smok never used on any
12 product has any bearing on either his Lanham Act or breach of contract claims.

13 Notably, Plaintiff’s position improperly seeks a broader production (“all
14 communications that refer to Smok’s decision regarding the naming of its ‘AL230’
15 and ‘Alien 2’ products”) than was sought in the original request (“all Documents
16 and Communications related to SMOK’s decision to discontinue referring to its
17 ‘AL230’ product as the ‘Alien 2’”).

18

19 **REQUEST FOR PRODUCTION NO. 58:**

20 All Documents and Communications with RRV Enterprises LLC d/b/a/
21 Vapor World, or any owner or employee of it, including Lance Custen (collectively,
22 “RRV”), regarding Sarieddine or RRV’s settlement with Sarieddine.

23 **RESPONSE TO REQUEST FOR PRODUCTION NO. 58:**

24 Smok will produce non-privileged documents and communications—if
25 any—with RRV, or any owner or employee of RRV, regarding Sarieddine or
26 RRV’s settlement with Sarieddine.

27 **PLAINTIFF’S POSITION:**

28 The documents sought by this Request relate to Plaintiff’s claim for breach of

1 contract and breach of the implied covenant of good faith and fair dealing, which
2 allege that Smok communicated with third parties, including RRV, about
3 challenging Plaintiff's Alien Vape trademarks. Documents produced by Plaintiff
4 indicate that Smok communicated with Lance Custen of RRV about this lawsuit
5 and tried to pressure RRV to remain in this case and challenge Plaintiff's Alien
6 Vape trademarks. McConnell Decl., ¶ 24, Ex. 14.

7 During the parties' meet and confer session on March 5, 2018, Smok
8 revealed for the first time that it has "no written record" any communications with
9 RRV, or any owner or employee of RRV, including Lance Custen. *Id.*, ¶ 22.
10 However, Plaintiff has reason to believe that at least some communications between
11 Mr. Custen and Smok were recorded, as other documents produced in this lawsuit
12 demonstrate Smok employees tend to use email, WeChat, and Skype to
13 communicate with individuals outside the company. *Id.*, ¶ 23, Ex. 13. This is
14 consistent with Plaintiff's own experience, as the vast majority of Plaintiff's
15 communications with Smok occurred through these means. *Id.*, ¶ 23. Plaintiff
16 therefore believes Smok has responsive communications with RRV and Lance
17 Custen in its possession, custody, or control and asks that Smok produce these
18 communications within two weeks of the hearing on this motion.

19 **SMOK'S POSITION:**

20 Smok's search for non-privileged documents responsive to this request is
21 ongoing.

22 In the interest of brevity, Smok incorporates paragraph 9 (regarding third-
23 party communications) of Smok's Omnibus Position Regarding Document
24 Requests).

25
26 **REQUEST FOR PRODUCTION NO. 59:**

27 All Documents and Communications with RRV after its settlement of this
28 Action with Sarieddine regarding exclusive distribution of any of SMOK's

1 products.

2 **RESPONSE TO REQUEST FOR PRODUCTION NO. 59:**

3 Smok objects to this Request on the grounds that it is overbroad, unduly
4 burdensome, and not proportional to the needs of the case because the documents
5 sought are entirely unrelated to Smok's alleged liability under the claims asserted in
6 Sarieddine's complaint or to any cognizable category of damages Sarieddine could
7 seek pursuant to those claims.

8 **PLAINTIFF'S POSITION:**

9 RFP No. 59 seeks Smok's communications with RRV, d/b/a Vapor World,
10 following their settlement in this lawsuit. Specifically, this Requests seek
11 communications regarding Smok's efforts to discourage Vapor World from settling
12 this lawsuit by terminating Vapor World's distribution contract. Plaintiff has
13 produced its communications with Lance Custen, which indicate that Smok
14 engaged in this misconduct. McConnell Decl., ¶ 24, Ex. 14. Therefore, Plaintiff
15 reasonably expects that Smok has documents responsive to RFP No. 59 in its
16 possession, custody or control.

17 Smok does not have grounds to refuse to produce these responsive
18 communications. Smok's assertion that these communications are "entirely
19 unrelated to Smok's alleged liability under the claims asserted in Sarieddine's
20 complaint or to any cognizable category of damages Sarieddine could seek pursuant
21 to those claims" is not true. Smok's attempts to encourage third parties, including
22 Vapor World, to challenge Plaintiffs' Alien Vape trademarks are relevant to
23 Plaintiff's claims for breach of contract and breach of the implied covenant of good
24 faith and fair dealing. As Plaintiff has alleged in its First Amended Complaint,
25 Smok has a continuing obligation under the settlement agreement not to challenge
26 Plaintiff's Alien Vape trademarks. Smok's efforts to invalidate Plaintiff's marks
27 and encourage third parties to do so—including by punishing third parties, such as
28 Vapor World, who settle lawsuits with Plaintiff—are directly relevant to these

1 claims. Plaintiff therefore requests that Smok produce its documents and
2 communications that are responsive to RFP No. 59 within two weeks of the hearing
3 on this motion.

4 **SMOK'S POSITION:**

5 Smok agrees to search for non-privileged documents responsive to this
6 request, and its search is ongoing.

7 In the interest of brevity, Smok incorporates paragraph 9 (regarding third-
8 party communications) of Smok's Omnibus Position Regarding Document
9 Requests).

10 **REQUEST FOR PRODUCTION NO. 60:**

11 All Documents and Communications with RRV after its settlement of this
12 Action with Sarieddine regarding SMOK raising prices for RRV.

13 **RESPONSE TO REQUEST FOR PRODUCTION NO. 60:**

14 Smok objects to this Request on the grounds that it is overbroad, unduly
15 burdensome, and not proportional to the needs of the case because the documents
16 sought are entirely unrelated to Smok's alleged liability under the claims asserted in
17 Sarieddine's complaint or to any cognizable category of damages Sarieddine could
18 seek pursuant to those claims.

19 **PLAINTIFF'S POSITION:**

20 RFP No. 60 seeks Smok's communications with RRV, d/b/a Vapor World,
21 following their settlement in this lawsuit. Specifically, this Requests seek
22 communications regarding Smok's efforts to discourage Vapor World from settling
23 this lawsuit by raising prices for Vapor World. Plaintiff has produced its
24 communications with Lance Custen, which indicate that Smok engaged in this
25 misconduct. McConnell Decl., ¶ 24, Ex. 14. Therefore, Plaintiff reasonably
26 expects that Smok has documents responsive to RFP No. 60 in its possession,
27 custody or control.

1 Smok does not have grounds to refuse to produce these responsive
2 communications. Smok's assertion that these communications are "entirely
3 unrelated to Smok's alleged liability under the claims asserted in Sarieddine's
4 complaint or to any cognizable category of damages Sarieddine could seek pursuant
5 to those claims" is not true. Smok's attempts to encourage third parties, including
6 Vapor World, to challenge Plaintiffs' Alien Vape trademarks are relevant to
7 Plaintiff's claims for breach of contract and breach of the implied covenant of good
8 faith and fair dealing. As Plaintiff has alleged in its First Amended Complaint,
9 Smok has a continuing obligation under the settlement agreement not to challenge
10 or invalidate Plaintiff's Alien Vape trademarks. Smok's efforts to invalidate
11 Plaintiff's marks and encourage third parties to do so—including by punishing third
12 parties, such as Vapor World, who settle lawsuits with Plaintiff—are directly
13 relevant to these claims. Plaintiff therefore requests that Smok produce its
14 documents and communications that are responsive to RFP No. 60 within two
15 weeks of the hearing on this motion.

16 **SMOK'S POSITION:**

17 Smok agrees to search for non-privileged documents responsive to this
18 request, and its search is ongoing.

19 In the interest of brevity, Smok incorporates paragraph 9 (regarding third-
20 party communications) of Smok's Omnibus Position Regarding Document
21 Requests).

22
23 **REQUEST FOR PRODUCTION NO. 61:**

24 All Documents and Communications with any third parties regarding your
25 allegation in paragraph 26 of your Amended Counterclaims that any third party has
26 "chosen to cease or circumscribe their business relationship with Smok as a result
27 of Plaintiff's unjustified, sham lawsuit against the Distributor Defendants."

28 **RESPONSE TO REQUEST FOR PRODUCTION NO. 61:**

1 Smok objects to this Request on the grounds that it is moot in light of Smok's
2 withdrawal of its Amended Counterclaim for tortious interference with business
3 relations. Smok further objects to this Request on the grounds that it is unduly
4 burdensome and not proportional to the needs of the case because it seeks to force
5 Smok's counsel to make legal determinations.

6 **PLAINTIFF'S POSITION:**

7 Smok's refusal to produce any documents in response to this Request is
8 improper. The fact that Smok has decided to no longer pursue its Amended
9 Counterclaim for tortious interference with business relations does not make
10 Plaintiff's discovery request "moot." Certainly, Smok must have had some factual
11 basis for asserting this Amended Counterclaim, and Plaintiff is entitled to see
12 documents regarding those facts. Among other things, documents that explain how
13 Smok's business relationships with its distributors were affected by this lawsuit, as
14 well as Smok's communications with third parties regarding this lawsuit, are likely
15 to contain information that is relevant to Plaintiff's claims for breach of contract
16 and breach of the implied covenant of good faith and fair dealing.

17 Smok's objection that this Request "seeks to force Smok's counsel to make
18 legal determinations" is similarly groundless. This Request seeks documents and
19 communications regarding Smok's business relationships with third parties and
20 how these relationships may have affected by this lawsuit. This Request does not
21 ask for any "legal determinations" or other attorney work product. Plaintiff
22 therefore requests that Smok produce its documents and communications that are
23 responsive to RFP No. 61 within two weeks of the hearing on this motion.

24 **SMOK'S POSITION:**

25 Smok maintains its mootness objection. The claim at issue has been
26 dismissed. If Sarieddine seeks documents "likely to contain information that is
27 relevant to Plaintiff's claims for breach of contract and breach of the implied
28 covenant of good faith and fair dealing" which are not covered by one of

1 Sarieddine's 85 other document requests, he may propound additional requests. But
2 he may not use his desire for such documents as an after-the -fact justification for a
3 request related to a dead claim.

4

5 **REQUEST FOR PRODUCTION NO. 62:**

6 Copies of all receipts from January 1, 2016 for the sale of goods bearing any
7 of SMOK's Alien Kit Marks.

8 **RESPONSE TO REQUEST FOR PRODUCTION NO. 62:**

9 Smok objects to this Request on the grounds that it is overbroad, unduly
10 burdensome, and not proportional to the needs of the case because (1) it seeks
11 financial documents that have no bearing on this action; (2) it seeks documents
12 related to goods bearing Smok's Alien Kit Marks outside the United States; and (3)
13 Smok has never sold any product under the name "Alien Baby." Smok further
14 objects to this Request on the grounds that receipt is vague and ambiguous when
15 applied to Smok's business.

16 **PLAINTIFF'S POSITION:**

17 Smok does not have grounds for refusing to produce any documents in
18 response to this Request. Smok's assertion that this Request seeks "financial
19 documents that have no bearing on this action" is incorrect. Request No. 62 seeks
20 the underlying records for the sales of Smok's infringing products, which are
21 relevant to Plaintiff's damages for trademark infringement. In addition, Smok's
22 erroneous contention that it "never sold any product under the name 'Alien Baby'"
23 does not excuse Smok from producing any documents in response to this Request.
24 Even if that claim were true, which it is not (McConnell Decl., ¶ 28, Ex. 15) Smok
25 is nonetheless obligated to produce receipts for its other goods bearing the Alien
26 Kit Marks.

27 If the volume of documents responsive to this Request is very large and
28 would be unduly burdensome to produce, Plaintiff is willing to limit the breadth of

1 this Request. Specifically, Plaintiff has offered to limit the scope of RFP No. 62 to
2 a summary of Smok's sales its "Alien Kit Marks" products to Distributor
3 Defendants. During the parties' meet and confer session on March 5, 2018, Smok
4 stated that it was willing to consider this proposed revised request but did not
5 commit to providing this summary. *Id.*, ¶ 35, Ex. 19. Plaintiff therefore requests
6 that Smok produce at least a summary of Smok's sales its "Alien Kit Marks"
7 products to Distributor Defendants within two weeks of the hearing on this motion.

8 **SMOK'S POSITION:**

9 Sarieddine apparently recognizes the unduly burdensome nature of this
10 request. As a practical matter, Smok has disclosed in SMOK002406 its sales of
11 Alien goods in the United States. As that document lists the customer for each sale,
12 Sarieddine can use that document to derive the information he seeks with respect to
13 the Distributor Defendants.

14 Finally, in the interest of brevity, Smok incorporates the following
15 paragraphs from Smok's Omnibus Position Regarding Document Requests: 3-4
16 (regarding trademark use outside the United States); 5 (regarding the definition of
17 "Alien Kit Marks"); 6-7 (regarding financial information for AL85 goods); and 8
18 (regarding Smok's financial document production).

19

20 **REQUEST FOR PRODUCTION NO. 64:**

21 All of SMOK's financial statements from 2016 and 2017, including, but not
22 limited to, balance sheets, income statements, and profits and loss statements.

23 **RESPONSE TO REQUEST FOR PRODUCTION NO. 64:**

24 Smok objects to this Request on the grounds that it is overbroad, unduly
25 burdensome, and not proportional to the needs of the case because (1) it seeks
26 financial documents that have no bearing on this action; (2) it seeks documents
27 unrelated to Smok's use of allegedly infringing marks; and (3) it seeks documents
28 unrelated to trademark use in the United States. Smok further objects on the

1 grounds that this Request seeks documents that are not relevant to any claims or
2 defenses in this case. Smok further objects to this Request on the grounds that it is
3 intended to be harassing when applied to a sophisticated foreign business that is
4 defending trademark infringement and unfair competition claims.

5 **PLAINTIFF'S POSITION:**

6 Smok's refusal to produce any of its financial statements is improper.
7 Plaintiff needs to see Smok's financial statements and accounting documents to
8 analyze and evaluate Smok's revenue, profits, and costs from selling products that
9 infringed Plaintiff's trademarks. Such evidence is directly relevant to Plaintiff's
10 damages.

11 As previously explained, the only financial document that Smok has
12 produced is one bare-bones, summary Excel spreadsheet (SMOK002406), which
13 does not completely reflect Smok's revenue, profits, and costs from selling any of
14 the infringing products and was clearly created just for this lawsuit. Smok cannot
15 produce this spreadsheet in lieu of producing its actual underlying accounting
16 documents and financial statements. Among other problems, the spreadsheet does
17 not include data for Smok's AL85 vaporizer, also known as the "Alien Baby," and
18 is also improperly limited to U.S. sales, even though none of Plaintiff's claims are
19 so limited. The spreadsheet also does not tell Plaintiff how Smok arrived at its
20 conclusory numbers for "profit" and "revenue".

21 At the very least, Smok must produce the underlying financial statements that
22 it used to create this spreadsheet. At the parties' meet and confer session on March
23 5, 2018, Smok stated that it was willing to produce "some" underlying cost
24 documents that it used to create this spreadsheet, but it did not commit to producing
25 its underlying revenue or profit documents. McConnell Decl., ¶ 33. However,
26 Plaintiff is entitled to review *all* financial documents that were used to create this
27 spreadsheet. Without these documents, Plaintiff has no way of investigating the
28 accuracy of the summary presented in Smok's Excel spreadsheet. *See, e.g., Wahoo*

1 *Int'l, Inc. v. Phix Doctor, Inc.*, No. 13cv1395-GPC (BLM), 2014 U.S. Dist. LEXIS
2 98044, at *20-21 (S.D. Cal. July 18, 2014) (plaintiff was entitled to underlying
3 financial documents to investigate defendant's sales numbers where defendant only
4 produced an Excel spreadsheet reflecting total sales). Moreover, none of the data in
5 this spreadsheet are admissible without the underlying financial documents. *See*,
6 *e.g., H-D Mich., Inc. v. Bikers Dream, Inc.*, No. CV 97-864 SVW (CWx), 1998
7 U.S. Dist. LEXIS 17259, at *18 (C.D. Cal. July 28, 1998) ("A summary is not
8 admissible unless the records summarized have been made available to the
9 opposing party.").

10 To respond to RFP No. 64, Smok must produce its underlying accounting
11 and financial documents that fully reflect Smok's revenue, profits, and costs for all
12 goods bearing Smok's Alien Kit Marks. Plaintiff requests that Smok produce these
13 documents within two weeks of the hearing on this motion.

14 **SMOK'S POSITION:**

15 In the interest of brevity, Smok hereby incorporates by reference the
16 following paragraphs from Smok's Omnibus Position Regarding Document
17 Requests: 3-4 (regarding trademark use outside the United States); 5 (regarding the
18 definition of "Alien Kit Marks"); 6-7 (regarding financial information for AL85
19 goods); and 8 (regarding Smok's financial document production).

20
21 **REQUEST FOR PRODUCTION NO. 65:**

22 All Documents showing income to or expenses incurred by SMOK resulting
23 from the sale or licensing any of Goods bearing any of SMOK's Alien Kit Marks.

24 **RESPONSE TO REQUEST FOR PRODUCTION NO. 65:**

25 Smok objects to this Request on the grounds that it is overbroad, unduly
26 burdensome, and not proportional to the needs of the case because (1) it seeks
27 financial documents that have no bearing on this action ; (2) it seeks documents
28 related to goods bearing Smok's Alien Kit Marks outside the United States; and (3)

1 Smok has never sold any product under the name “Alien Baby.”

2 **PLAINTIFF’S POSITION:**

3 Documents regarding Smok’s income and expenses resulting from the sale or
4 licensing of products that infringed Plaintiff’s trademarks are undeniably relevant to
5 this lawsuit. These documents contain evidence of Smok’s revenue, costs, and
6 profits from infringing Plaintiff’s trademarks, which Plaintiff will use to calculate
7 damages pursuant to 15 U.S.C. § 1117(a) of the Lanham Act.

8 During the parties’ meet and confer session on March 5, 2018, Smok said
9 that it would consider producing its licensing documents but did not commit to
10 doing so. McConnell Decl., ¶ 35, Ex. 19. Smok also reasserted its objections to
11 producing documents regarding Smok’s Alien Kit Marks outside the United States.
12 *Id.* As previously explained, evidence of sales outside of the United States are
13 relevant to Plaintiff’s Lanham Act and breach of contract claims. Smok’s refusal to
14 provide any information regarding its AL85 / “Alien Baby” is likewise improper,
15 given that the significance of this product to Plaintiff’s Lanham Act and breach of
16 contract claims, and the fact that Smok used the “Alien Baby” name to sell its
17 vaporizer. *Id.*, ¶ 28, Ex. 15.

18 Plaintiff requests that Smok produce all documents responsive to RFP No. 65
19 within two weeks of the hearing on this motion.

20 **SMOK’S POSITION:**

21 With respect to this request as it applies to the sale of goods, as a practical
22 matter, Smok has produced documentation showing income and expenses from
23 sales of Alien goods in the United States (SMOK002406), and Smok intends to
24 produce additional documents related to its costs.

25 Upon further consideration, Smok maintains its objection to producing
26 documents related to licensing Smok’s Alien Kit Marks, as those marks are not at
27 issue in the case and any licensure of those marks would have no bearing on a
28 reasonable royalty for the licensure of Sarieddine’s Alien Vape Marks.

1 Finally, in the interest of brevity, Smok hereby incorporates by reference the
2 following paragraphs from Smok's Omnibus Position Regarding Document
3 Requests: 3-4 (regarding trademark use outside the United States); 5 (regarding the
4 definition of "Alien Kit Marks"); 6-7 (regarding financial information for AL85
5 goods); and 8 (regarding Smok's financial document production).

6

7 **REQUEST FOR PRODUCTION NO. 66:**

8 Documents sufficient to identify the costs, revenue, and profits of each of the
9 goods bearing SMOK's Alien Kit Marks, broken down by country of sale.

10 **RESPONSE TO REQUEST FOR PRODUCTION NO. 66:**

11 Smok objects to this Request on the grounds that it is overbroad, unduly
12 burdensome, and not proportional to the needs of the case because (1) it seeks
13 documents related to goods bearing Smok's Alien Kit Marks outside the United
14 States and (2) Smok never sold any product under the name "Alien Baby." Smok
15 will not search for or produce document related to the costs, revenue, or profits
16 outside the United States of any of the goods bearing Smok's Alien Kit Marks.
17 Smok will not search for or produce any financial documents relating to its AL85
18 product. Smok will produce non-privileged documents—if any—sufficient to
19 identify the costs, revenue, and profits in the United States of each of the goods
20 bearing Smok's "Smok Alien" mark.

21 **PLAINTIFF'S POSITION:**

22 This Request seeks financial documents that are critical to computing
23 damages in this lawsuit. To assess damages under 15 U.S.C. § 1117(a), Plaintiff
24 needs evidence of Smok's revenue, costs, and profits from selling products that
25 infringe its Alien Vape trademarks. However, the only financial document that
26 Smok has produced is an Excel spreadsheet (SMOK002406), which presents an
27 incomplete "summary" of Smok's profits. As previously discussed, this
28 spreadsheet is deficient because it does not include data for Smok's AL85

1 vaporizer, also known as the “Alien Baby,” and is also improperly limited to U.S.
2 sales, even though none of Plaintiff’s claims are so limited.

3 At the parties’ meet and confer session on March 5, 2018, Smok stated that it
4 was willing to produce “some” underlying cost documents that it used to create the
5 Excel spreadsheet at SMOK002406 but did not commit to producing its underlying
6 revenue or profit documents. McConnell Decl., ¶ 33. However, Plaintiff is entitled
7 to review *all* financial documents that were used to create this spreadsheet. Without
8 these documents, Plaintiff has no way of investigating the accuracy of the summary
9 presented in Smok’s excel spreadsheet. *Wahoo Int'l, Inc. v. Phix Doctor, Inc.*, 2014
10 U.S. Dist. LEXIS 98044, at *20-21.

11 Plaintiff cannot obtain an accurate and complete understanding of its
12 damages in this action without Smok’s accounting and financial documents, which
13 reflect worldwide sales and include revenue, profits, and cost figures for all
14 infringing products. Plaintiff requests that Smok produce these documents within
15 two weeks of the hearing on this motion.

16 **SMOK’S POSITION:**

17 In the interest of brevity, Smok hereby incorporates by reference the
18 following paragraphs from Smok’s Omnibus Position Regarding Document
19 Requests: 3-4 (regarding trademark use outside the United States); 5 (regarding the
20 definition of “Alien Kit Marks”); 6-7 (regarding financial information for AL85
21 goods); and 8 (regarding Smok’s financial document production).

22
23 **REQUEST FOR PRODUCTION NO. 67:**

24 All Documents concerning or relating to any royalty payments or licensing of
25 any trademark, trade name, or service mark for any e-cigarette products, including
26 vaporizers or e-liquid products, sold by SMOK.

27 **RESPONSE TO REQUEST FOR PRODUCTION NO. 67:**

28 Smok objects to this Request on the grounds that it is overbroad, unduly

1 burdensome, and not proportional to the needs of the case because (1) it seeks
2 financial documents that have no bearing on this action and (2) it seeks documents
3 related to goods bearing Smok's Alien Kit Marks outside the United States.

4 **PLAINTIFF'S POSITION:**

5 Smok does not have grounds for refusing to produce any documents in
6 response to this Request. Documents regarding royalty payments and licensing of
7 Smok's e-cigarette products are relevant to the issues of damages. These
8 documents could provide a basis for calculating a reasonable royalty as a measure
9 of Plaintiff's actual damages. Documents regarding Smok's trademark licenses are
10 also relevant to the validity of Smok's trademarks and Smok's counterclaims based
11 on those marks. In addition, because Smok has claimed that the "alien" name is
12 generic in the e-cigarette industry, Plaintiff is entitled to know if Smok is licensing
13 its "alien" marks to third parties, thereby taking positions apposite to those asserted
14 in this litigation.

15 During the parties' meet and confer session on March 5, 2018, Smok agreed
16 to consider producing its licensing documents but did not commit to doing so.
17 McConnell Decl., ¶ 35, Ex. 19. Smok also reasserted its objections to producing
18 documents regarding Smok's Alien Kit Marks outside the United States, which are
19 improper for reasons previously discussed. Plaintiff requests that Smok produce all
20 documents responsive to RFP No. 67 within two weeks of the hearing on this
21 motion.

22 **SMOK'S POSITION:**

23 Upon further consideration, Smok maintains its objection to producing
24 documents responsive to this request. Royalty payments for marks or names not at
25 issue in this case have no bearing on a reasonable royalty for the licensure of
26 Sarieddine's Alien Vape Marks.

27 Finally, in the interest of brevity, Smok hereby incorporates by reference the
28 following paragraphs from Smok's Omnibus Position Regarding Document

1 Requests: 3-4 (regarding trademark use outside the United States); 5 (regarding the
2 definition of “Alien Kit Marks”); 6-7 (regarding financial information for AL85
3 goods).

4

5 **REQUEST FOR PRODUCTION NO. 68:**

6 Documents sufficient to identify the marginal cost to manufacture each of the
7 goods bearing any of SMOK’s Alien Kit Marks.

8 **RESPONSE TO REQUEST FOR PRODUCTION NO. 68:**

9 Smok objects to this Request on the grounds that it is overbroad, unduly
10 burdensome, and not proportional to the needs of the case because (1) it seeks
11 financial documents that have no bearing on this action (2) it seeks documents
12 related to goods bearing Smok’s Alien Kit Marks outside the United States; and (3)
13 Smok never sold any product under the name “Alien Baby.” Smok further objects
14 on the grounds that this Request seeks documents that are not relevant to any claims
15 or defenses in this case. Smok further objects to this Request on the grounds that it
16 is intended to be harassing when applied to a sophisticated foreign business that is
17 defending trademark infringement and unfair competition claims.

18 **PLAINTIFF’S POSITION:**

19 Smok’s blanket objections to producing any documents in response to RFP
20 No. 68 are improper. This Request seeks standard information regarding Smok’s
21 marginal profits from selling infringing products on a per-unit basis. Smok’s
22 marginal profits are directly relevant to Plaintiff’s damages calculations under 15
23 U.S.C. § 1117(a). There is nothing “harassing” about Plaintiff’s request for such
24 basic financial information.

25 Smok’s objections that this Request seeks information regarding sales of
26 “Alien Baby,” as well as information regarding sales outside of the United States,
27 are similarly improper. As previously discussed herein, Smok has sold a vaporizer
28 known as “Alien Baby.” Data regarding the marginal costs of manufacturing this

1 product—as well as all other infringing products—on a worldwide basis are
2 relevant to Plaintiff’s Lanham Act and breach of contract claims. Plaintiff therefore
3 requests that Smok produce documents responsive to RFP No. 68 within two weeks
4 of the hearing on this motion.

5 **SMOK’S POSITION:**

6 As a practical matter, Smok has already provided documentation of its
7 marginal costs related to sales of Alien goods in this United States through the
8 spreadsheet bates-labeled SMOK002406.

9 Finally, in the interest of brevity, Smok hereby incorporates by reference the
10 following paragraphs from Smok’s Omnibus Position Regarding Document
11 Requests: 3-4 (regarding trademark use outside the United States); 5 (regarding the
12 definition of “Alien Kit Marks”); 6-7 (regarding financial information for AL85
13 goods).

14

15 **REQUEST FOR PRODUCTION NO. 69:**

16 Documents sufficient to establish all costs and expenditures for the
17 advertising and promoting of any goods bearing any of SMOK’s Alien Kit Marks.

18 **RESPONSE TO REQUEST FOR PRODUCTION NO. 69:**

19 Smok objects to this Request on the grounds that it is overbroad, unduly
20 burdensome, and not proportional to the needs of the case because (1) it seeks
21 documents unrelated to Smok’s trademark use in the United States and (2) Smok
22 never sold any product under the name “Alien Baby.” Smok will not search for or
23 produce document related to costs and expenditures incurred outside the United
24 States for the advertising and promoting of any goods bearing any of Smok’s Alien
25 Kit Marks. Smok will not search for or produce any financial documents relating to
26 its AL85 product. Smok further objects to this Request on the grounds that it is
27 overbroad, unduly burdensome, and not proportional to the needs of the case
28 because it seeks documents to establish costs and expenditures not incurred by

1 Smok. Smok will not search for or produce documents related to costs or
2 expenditures incurred by others. Smok will produce non-privileged documents—if
3 any—sufficient to identify costs and expenditures incurred in the United States by
4 Smok for the advertising and promoting of goods bearing Smok’s “Smok Alien”
5 mark.

6 **PLAINTIFF’S POSITION:**

7 RFP No. 69 seeks essential information regarding Smok’s costs from selling
8 the infringing products at issue. This information is necessary to compute
9 Plaintiff’s damages from Smok’s trademark infringement under 15 U.S.C. §
10 1117(a). Despite the clear relevance of these data, Smok has objected to this
11 Request because it calls for information regarding non-U.S. sales and the “Alien
12 Baby” product. Both objections are without merit.

13 As previously discussed, Smok *did* sell a vaporizer known as the “Alien
14 Baby.” McConnell Decl., ¶ 28, Ex. 15. And even if Smok’s contention regarding
15 “Alien Baby” were true (which it is not), that does not excuse Smok from
16 producing financial documents regarding any of the other Alien Kit Marks.

17 Smok is likewise obligated to produce documents reflecting its worldwide
18 sales of the infringing products. Plaintiff’s Lanham Act and breach of contract
19 claims are not limited to U.S.-only sales. Even if these claims were so limited,
20 Plaintiff is still entitled to review Smok’s underlying financial data to investigate
21 the veracity of Smok’s claims regarding the sales of its infringing products within
22 the U.S.

23 The sole financial document that Smok has produced is the Excel spreadsheet
24 at SMOK002406, which is deficient because it was created specifically for this
25 lawsuit, is not accompanied by the underlying and supporting documents that were
26 used to create it, and presents an incomplete picture of Smok’s revenue, profits, and
27 costs. At the parties’ meet and confer session on March 5, 2018, Smok stated that it
28

1 was willing to produce some of the underlying cost documents that it used to create
2 the Excel spreadsheet at SMOK002406 but could not say whether Smok's
3 advertising and promoting expenditures would be included these documents. Nor
4 did Smok withdraw its improper objections to producing financial data for its
5 worldwide sales and for its AL85 / "Alien Baby" vaporizer. McConnell Decl., ¶¶
6 33-34.

7 Plaintiff requests that Smok withdraw its objections and produce all
8 documents responsive to RFP No. 69 within two weeks of the hearing on this
9 motion.

10 **SMOK'S POSITION:**

11 Sarieddine's position ignores the fact that Smok has produced an additional
12 internal document (bates-labeled SMOK001700) showing Smok's advertising and
13 promotional expenditures.

14 Smok's search additional documents establishing its costs and expenditures
15 incurred in the United States for the advertising and promoting of goods bearing
16 Smok's "Smok Alien" mark is ongoing.

17 Finally, in the interest of brevity, Smok hereby incorporates by reference the
18 following paragraphs from Smok's Omnibus Position Regarding Document
19 Requests: 3-4 (regarding trademark use outside the United States); 5 (regarding the
20 definition of "Alien Kit Marks"); 6-7 (regarding financial information for AL85
21 goods); and 8 (regarding Smok's financial document production).

22
23 **REQUEST FOR PRODUCTION NO. 70:**

24 Documents sufficient to identify the number of vaporizer SMOK has sold
25 under each of SMOK's Alien Kit Marks.

26 **RESPONSE TO REQUEST FOR PRODUCTION NO. 70:**

27 Smok objects to this Request on the grounds that it is overbroad, unduly
28 burdensome, and not proportional to the needs of the case because (1) the

1 documents sought are entirely unrelated to Smok's alleged liability under the claims
2 asserted in Sarieddine's complaint or to any cognizable category of damages
3 Sarieddine could seek pursuant to those claims; (2) it seeks documents unrelated to
4 Smok's trademark use in the United States; and (3) Smok never sold any product
5 under the name "Alien Baby."

6 **PLAINTIFF'S POSITION:**

7 RFP No. 70 seeks basic data regarding Smok's total sales of its infringing
8 products, which are needed to compute Plaintiff's damages from Smok's trademark
9 infringement under 15 U.S.C. § 1117(a). Despite the clear relevance of these data,
10 Smok has objected to this Request because it calls for information regarding non-
11 U.S. sales and the "Alien Baby" product. Both objections are without merit.

12 As previously discussed, Smok *did* sell a vaporizer known as the "Alien
13 Baby." McConnell Decl., ¶ 28, Ex. 15. And even if Smok's contention regarding
14 "Alien Baby" were true (which it is not), that does not excuse Smok from
15 producing financial documents regarding any of the other Alien Kit Marks.

16 Smok is likewise obligated to produce documents reflecting its worldwide
17 sales of the infringing products. Plaintiff's Lanham Act and breach of contract
18 claims are not limited to U.S.-only sales. Even if these claims were so limited,
19 Plaintiff is still entitled to review Smok's underlying financial data to investigate
20 the veracity of Smok's claims regarding the sales of its infringing products within
21 the U.S.

22 The sole financial document that Smok has produced is the Excel spreadsheet
23 at SMOK002406, which is deficient because it was created specifically for this
24 lawsuit, is not accompanied by the underlying and supporting documents that were
25 used to create it, and presents an incomplete picture of Smok's revenue, profits, and
26 costs. This spreadsheet does not satisfy Smok's obligations to respond to RFP No.
27 70. Plaintiff requests that Smok withdraw its meritless objections and produce
28 documents responsive to RFP No. 70 within two weeks of the hearing on this

1 motion.

2 **SMOK'S POSITION:**

3 As a practical matter, the spreadsheet bates-labeled SMOK 002406 establishes
4 the number of Alien goods Smok has sold in the United States.

5 Finally, in the interest of brevity, Smok incorporates by reference the
6 following paragraphs from Smok's Omnibus Position on Document Requests: 3-4
7 (regarding trademark use outside the United States); 5 (regarding the definition of
8 "Alien Kit Marks"); and 8 (regarding Smok's financial document production).

9

10 **REQUEST FOR PRODUCTION NO. 71:**

11 Documents sufficient to identify the average selling price of the vaporizers
12 sold under each of SMOK's Alien Kit Marks.

13 **RESPONSE TO REQUEST FOR PRODUCTION NO. 71:**

14 Smok objects to this Request on the grounds that it is overbroad, unduly
15 burdensome, and not proportional to the needs of the case because (1) it seeks
16 financial documents that have no bearing on this action; (2) it seeks documents
17 unrelated to Smok's trademark use in the United States; and (3) Smok never sold
18 any product under the name "Alien Baby." Smok further objects on the grounds
19 that the average selling price is vague and ambiguous in that it does not identify the
20 seller and seeks to elicit an average of a dynamic cohort.

21 **PLAINTIFF'S POSITION:**

22 RFP No. 71 seeks basic data regarding the average prices of Smok's
23 infringing products, which are needed to compute Plaintiff's damages from Smok's
24 trademark infringement under 15 U.S.C. § 1117(a). Despite the clear relevance of
25 these data, Smok has objected to this Request because it calls for information
26 regarding non-U.S. sales and the "Alien Baby" product. Both objections are
27 without merit.

1 As previously discussed, Smok *did* sell a vaporizer known as the “Alien
2 Baby.” McConnell Decl., ¶ 28, Ex. 15. And even if Smok’s contention regarding
3 “Alien Baby” were true (which it is not), that does not excuse Smok from
4 producing financial documents regarding any of the other Alien Kit Marks.

5 Smok is likewise obligated to produce documents reflecting its worldwide
6 sales of the infringing products. Plaintiff’s Lanham Act and breach of contract
7 claims are not limited to U.S.-only sales. Even if these claims were so limited,
8 Plaintiff is still entitled to review Smok’s underlying financial data to investigate
9 the veracity of Smok’s claims regarding the sales of its infringing products within
10 the U.S.

11 The sole financial document that Smok has produced is the Excel spreadsheet
12 at SMOK002406, which is deficient because it was created specifically for this
13 lawsuit, is not accompanied by the underlying and supporting documents that were
14 used to create it, and presents an incomplete picture of Smok’s revenue, profits, and
15 costs. This spreadsheet does not satisfy Smok’s obligations to respond to RFP No.
16 71. Plaintiff requests that Smok withdraw its meritless objections and produce
17 documents responsive to RFP No. 71 within two weeks of the hearing on this
18 motion.

19 **SMOK’S POSITION:**

20 Sarieddine’s position wholly ignores Smok’s vagueness and ambiguity
21 objection. Sarieddine does not identify which seller or sellers are to be included in
22 calculating an “average selling price,” nor does Sarieddine explain how an “average
23 selling price can be identified when sales are ongoing.

24 Finally, in the interest of brevity, Smok hereby incorporates by reference the
25 following paragraphs from Smok’s Omnibus Position Regarding Document
26 Requests: 3-4 (regarding trademark use outside the United States); 5 (regarding the
27 definition of “Alien Kit Marks”); 6-7 (regarding financial information for AL85
28

1 goods); and 8 (regarding Smok's financial document production).

2

3 **REQUEST FOR PRODUCTION NO. 72:**

4 Documents sufficient to identify the total revenue to SMOK from each of the
5 goods bearing any of SMOK's Alien Kit marks.

6 **RESPONSE TO REQUEST FOR PRODUCTION NO. 72:**

7 Smok objects to this Request on the grounds that it is overbroad, unduly
8 burdensome, and not proportional to the needs of the case because (1) it seeks
9 documents related to goods bearing Smok's Alien Kit Marks outside the United
10 States and (2) Smok never sold any product under the name "Alien Baby." Smok
11 will not search for or produce documents related to Smok's revenue from products
12 sold outside the United States. Smok will not search for or produce financial
13 documents relating to its AL85 product. Smok further objects on the grounds that
14 total revenue to Smok is vague and ambiguous. Smok interprets "total revenue" to
15 mean "gross revenue." Smok will produce non-privileged documents—if any—
16 sufficient to identify the gross revenue to Smok from United States sales of each of
17 the goods bearing Smok's "Smok Alien" mark.

18 **PLAINTIFF'S POSITION:**

19 RFP No. 72 seeks essential data regarding Smok's revenue from selling the
20 infringing products at issue, which are necessary to compute Plaintiff's damages
21 from Smok's trademark infringement under 15 U.S.C. § 1117(a). Despite the clear
22 relevance of these data, Smok has objected to this Request because it calls for
23 information regarding non-U.S. sales and the "Alien Baby" product. Both
24 objections are without merit.

25 As previously discussed, Smok *did* sell a vaporizer known as the "Alien
26 Baby." *See, e.g.*, SMOK001988. And even if Smok's contention regarding "Alien
27 Baby" were true (which it is not), that does not excuse Smok from producing
28 financial documents regarding any of the other Alien Kit Marks.

1 Smok is likewise obligated to produce documents reflecting its worldwide
2 sales of the infringing products. Plaintiff's Lanham Act and breach of contract
3 claims are not limited to U.S.-only sales. Even if these claims were so limited,
4 Plaintiff is still entitled to review Smok's underlying financial data to investigate
5 the veracity of Smok's claims regarding the sales of its infringing products within
6 the U.S.

7 The sole financial document that Smok has produced is the Excel spreadsheet
8 at SMOK002406, which is deficient because it was created specifically for this
9 lawsuit, is not accompanied by the underlying and supporting documents that were
10 used to create it, and presents an incomplete picture of Smok's revenue, profits, and
11 costs. This spreadsheet does not satisfy Smok's obligations to respond to RFP No.
12 72. Plaintiff requests that Smok withdraw its meritless objections and produce
13 documents responsive to RFP No. 72 within two weeks of the hearing on this
14 motion.

15 **SMOK'S POSITION:**

16 In the interest of brevity, Smok hereby incorporates by reference the
17 following paragraphs from Smok's Omnibus Position Regarding Document
18 Requests: 3-4 (regarding trademark use outside the United States); 5 (regarding the
19 definition of "Alien Kit Marks"); 6-7 (regarding financial information for AL85
20 goods); and 8 (regarding Smok's financial document production).

22 **REQUEST FOR PRODUCTION NO. 73:**

23 Documents sufficient to identify the total revenue of SMOK from January
24 2016 to present.

25 **RESPONSE TO REQUEST FOR PRODUCTION NO. 73:**

26 Smok objects to this Request on the grounds that it is overbroad, unduly
27 burdensome, and not proportional to the needs of the case because (1) it seeks
28

1 financial documents that have no bearing on this action; (2) it seeks documents
2 unrelated to Smok's use of allegedly infringing marks; and (3) it seeks documents
3 unrelated to trademark use in the United States. Smok further objects on the
4 grounds that this Request is not relevant to any claim or defense in the case.

5 **PLAINTIFF'S POSITION:**

6 Smok's refusal to produce any of its revenue documents is improper.
7 Plaintiff needs to see Smok's underlying financial statements and accounting
8 documents to calculate Smok's revenue from selling products that infringed
9 Plaintiff's trademarks. Such evidence is needed to compute Plaintiff's damages
10 from Smok's trademark infringement under 15 U.S.C. § 1117(a).

11 As previously explained, the only financial document that Smok has
12 produced is an Excel spreadsheet (SMOK002406). Smok cannot fulfill its
13 discovery obligations by producing this spreadsheet, which does not fully reflect
14 Smok's revenue from selling the infringing products at issue. Among other
15 problems, the spreadsheet does not include data for Smok's AL85 vaporizer, also
16 known as the "Alien Baby," and is also limited to U.S. sales, even though none of
17 Plaintiff's claims are so limited.

18 At the very least, Smok must produce the underlying financial statements that
19 it used to create this spreadsheet. *Wahoo Int'l, Inc. v. Phix Doctor, Inc.*, 2014 U.S.
20 Dist. LEXIS 98044, at *20-21. Without these underlying financial documents,
21 Plaintiff has no way of investigating the accuracy of the summary presented in
22 Smok's Excel spreadsheet. Moreover, none of the data in this spreadsheet are
23 admissible without the underlying financial documents. *H-D Mich., Inc. v. Bikers*
24 *Dream, Inc.*, 1998 U.S. Dist. LEXIS 17259, at *18.

25 The fact that RFP No. 73 seeks financial documents regarding Smok's
26 revenue from selling products outside the U.S. does not excuse Smok from
27 responding to this Request. As previously discussed, Plaintiff's Lanham Act and
28 breach of contract claims are not limited to U.S.-only sales. Even if these claims

1 were so limited, Plaintiff is still entitled to review Smok's underlying financial data
2 to investigate the veracity of Smok's claims regarding the sales of its infringing
3 products within the U.S. Smok must therefore produce its underlying accounting
4 and financial documents that fully reflect Smok's revenue, profits, and costs for all
5 goods bearing Smok's Alien Kit Marks. Plaintiff requests that Smok produce these
6 documents within two weeks of the hearing on this motion.

7 **SMOK'S POSITION:**

8 This request is woefully overbroad. Even if Sarieddine were entitled to
9 Smok's worldwide financial information for both Alien and AL85 (which
10 Sarieddine is not), this request would still seek disclosure of revenue from Smok's
11 many other goods. To give one example out of dozens, Smok is not required to
12 disclose revenues from sales of Smok's T-PRIV kit.

13 Finally, in the interest of brevity, Smok hereby incorporates by reference the
14 following paragraphs from Smok's Omnibus Position Regarding Document
15 Requests: 3-4 (regarding trademark use outside the United States); 5 (regarding the
16 definition of "Alien Kit Marks"); 6-7 (regarding financial information for AL85
17 goods); and 8 (regarding Smok's financial document production).

18

19 **REQUEST FOR PRODUCTION NO. 74:**

20 Documents sufficient to identify SMOK's total profits from selling any
21 goods bearing each of SMOK's Alien Kit Marks.

22 **RESPONSE TO REQUEST FOR PRODUCTION NO. 74:**

23 Smok objects to this Request on the grounds that it is overbroad, unduly
24 burdensome, and not proportional to the needs of the case because (1) it seeks
25 documents related to goods bearing Smok's Alien Kit Marks outside the United
26 States and (2) Smok never sold any product under the name "Alien Baby." Smok
27 will not search for or produce documents related to Smok's profits from products
28 sold outside the United States. Smok will not search for or produce any financial

1 documents relating to its AL85 product. Smok will produce non-privileged
2 documents—if any—sufficient to identify Smok’s total profits from selling any
3 goods in the United States goods bearing each of Smok’s Smok Alien mark.

4 **PLAINTIFF’S POSITION:**

5 RFP No. 74 seeks essential data regarding Smok’s profits from selling the
6 infringing products at issue, which are necessary to compute Plaintiff’s damages
7 from Smok’s trademark infringement under 15 U.S.C. § 1117(a). Despite the clear
8 relevance of these data, Smok has improperly objected to this Request because it
9 calls for information regarding non-U.S. sales and information regarding the “Alien
10 Baby” product. Both objections are without merit.

11 As previously discussed, Smok *did* sell a vaporizer known as the “Alien
12 Baby.” *See, e.g.*, SMOK001988. And even if Smok’s contention regarding “Alien
13 Baby” were true (which it is not), that does not excuse Smok from producing
14 financial documents regarding any of the other Alien Kit Marks.

15 Smok is likewise obligated to produce documents reflecting its worldwide
16 sales of the infringing products. Plaintiff’s Lanham Act and breach of contract
17 claims are not limited to U.S.-only sales. Even if these claims were so limited,
18 Plaintiff is still entitled to review Smok’s underlying financial data to investigate
19 the veracity of Smok’s claims regarding the sales of its infringing products within
20 the U.S.

21 The sole financial document that Smok has produced is the Excel spreadsheet
22 at SMOK002406, which is deficient because it was created specifically for this
23 lawsuit, is not accompanied by the underlying and supporting documents that were
24 used to create it, and presents an incomplete picture of Smok’s revenue, profits, and
25 costs. This spreadsheet does not satisfy Smok’s obligations to respond to RFP No.
26 74. Plaintiff requests that Smok withdraw its meritless objections and produce
27 documents responsive to RFP No. 74 within two weeks of the hearing on this
28 motion.

1 **SMOK'S POSITION:**

2 In the interest of brevity, Smok hereby incorporates by reference the
3 following paragraphs from Smok's Omnibus Position Regarding Document
4 Requests: 3-4 (regarding trademark use outside the United States); 5 (regarding the
5 definition of "Alien Kit Marks"); 6-7 (regarding financial information for AL85
6 goods); and 8 (regarding Smok's financial document production).

7

8 **REQUEST FOR PRODUCTION NO. 75:**

9 All Documents relating to any revenue or business projections or forecasts
10 for any products sold under SMOK's Alien Kit Marks.

11 **RESPONSE TO REQUEST FOR PRODUCTION NO. 75:**

12 Smok objects to this Request on the grounds that it is overbroad, unduly
13 burdensome, and not proportional to the needs of the case because (1) the
14 documents sought are entirely unrelated to Smok's alleged liability under the claims
15 asserted in Sarieddine's complaint or to any cognizable category of damages
16 Sarieddine could seek pursuant to those claims; (2) it seeks documents unrelated to
17 trademark use in the United States; and (3) Smok never sold any product under the
18 name "Alien Baby." Smok further objects to this Request on the grounds that
19 "documents relating to business projections or forecasts" is vague and ambiguous
20 and could constitute virtually every document possessed by a corporation.

21 **PLAINTIFF'S POSITION:**

22 RFP No. 75 seeks Smok's revenue forecasts for the infringing products at
23 issue, which are relevant to computing Plaintiff's damages from Smok's trademark
24 infringement under 15 U.S.C. § 1117(a). These documents also provide insight into
25 Smok's motivations for infringing Plaintiff's trademarks, which are relevant to
26 Plaintiff's claims that Smok willfully infringed Plaintiff's marks and breached the
27 Settlement Agreement in bad faith. Despite the clear relevance of these data, Smok
28 has improperly objected to this Request because it calls for information regarding

1 non-U.S. sales and the “Alien Baby” product. Both objections are without merit.

2 As previously discussed, Smok *did* sell a vaporizer known as the “Alien
3 Baby.” *See, e.g.*, SMOK001988. And even if Smok’s contention regarding “Alien
4 Baby” were true (which it is not), that does not excuse Smok from producing
5 financial documents regarding any of the other Alien Kit Marks.

6 Smok is likewise obligated to produce documents reflecting its worldwide
7 sales of the infringing products. Plaintiff’s Lanham Act and breach of contract
8 claims are not limited to U.S.-only sales. Even if these claims were so limited,
9 Plaintiff is still entitled to review Smok’s underlying financial data to investigate
10 the veracity of Smok’s claims regarding the sales of its infringing products within
11 the U.S.

12 The sole financial document that Smok has produced is the Excel spreadsheet
13 at SMOK002406, which is deficient because it was created specifically for this
14 lawsuit, is not accompanied by the underlying and supporting documents that were
15 used to create it, and presents an incomplete picture of Smok’s revenue, profits, and
16 costs. This spreadsheet does not satisfy Smok’s obligations to produce the revenue
17 forecasts sought by RFP No. 75.

18 Smok’s objection that this Request “could constitute virtually every
19 document possessed by a corporation” is likewise meritless. RFP No. 75 does not
20 call for “every document” in Smok’s possession; it seeks only those documents
21 regarding Smok’s “Alien Kit Marks” products and is further limited to documents
22 discussing revenue forecasts for those products. Plaintiff requests that Smok
23 withdraw its meritless objections and produce documents responsive to RFP No. 75
24 within two weeks of the hearing on this motion.

25 **SMOK’S POSITION:**

26 Sarieddine is incorrect that his damages calculations flow from business
27 projections, as opposed to Smok’s actual profits. And a business projection or
28 forecast can provide no “insight” regarding Smok’s motivations for its adoption of

1 any particular mark. Instead, such documents merely make an educated guess
2 regarding future revenue, expenses, and profits.

3 Once again, Sarieddine fails to recognize that his own broad definition of
4 “relating to” would sweep in an unduly burdensome volume of documents. Nearly
5 every document in Smok’s possession, custody, or control related to the goods at
6 issue (for example, every copy of every advertisement or promotion for Smok’s
7 Alien goods) would be “connected with” Smok’s “revenue or business projections
8 or forecasts.” The scope of this request is not proportional to the needs of the case,
9 yet Sarieddine has made no effort to narrow it.

10 Finally, in the interest of brevity, Smok hereby incorporates by reference the
11 following paragraphs from Smok’s Omnibus Position Regarding Document
12 Requests: 3-4 (regarding trademark use outside the United States); 5 (regarding the
13 definition of “Alien Kit Marks”); 6-7 (regarding financial information for AL85
14 goods); and 8 (regarding Smok’s financial document production).

15

16 **REQUEST FOR PRODUCTION NO. 76:**

17 All Documents and Communications supporting SMOK’s allegation that “A
18 prohibition on sales in the United States of vaporizers named Alien Kit, AL85, and
19 AL230 for one year would causes losses to Smok of more than \$50 million in
20 revenue and more than \$5 million in profits.”

21 **RESPONSE TO REQUEST FOR PRODUCTION NO. 76:**

22 Smok objects to this Request on the grounds that it is moot because Smok
23 made the quoted statement in opposition to Sarieddine’s motions for temporary
24 injunctive relief, which motions have since been denied. Smok further objects to
25 this Request on the grounds that it is overbroad, unduly burdensome, and not
26 proportional to the needs of the case because (1) it seeks financial information that
27 has no bearing on this action and (2) it seeks to force Smok’s counsel to make legal
28 determinations. Smok further objects to this Request on the grounds that it seeks

1 documents and communications protected by the attorney-client privilege, the
2 attorney work product doctrine, and the common interest privilege. Smok further
3 objects on the grounds that the Request mischaracterizes the quoted language as an
4 allegation when it is not an allegation in any claim or defense.

5 **PLAINTIFF'S POSITION:**

6 Smok's refusal to produce any documents in response to this Request is
7 improper. This discovery request is not "moot" simply because it seeks information
8 regarding a statement that Smok made in its opposition to Plaintiff's request for
9 preliminary injunctive relief. That motion has been decided, but Smok's revenue
10 and profits from infringing Plaintiff's trademarks clearly has not been determined.
11 Smok made a statement under a penalty of perjury regarding its revenue and profits
12 from selling products that infringed Plaintiff's trademarks. Smok has no basis for
13 refusing to produce documents regarding that statement and how Smok calculated
14 its claims of "\$50 million in revenue and more than \$5 million in profits," which
15 are directly relevant to the computation of Plaintiff's damages. Plaintiff therefore
16 requests that Smok produce documents responsive to RFP No. 76 within two weeks
17 of the hearing on this motion.

18 **SMOK'S POSITION:**

19 Sarieddine tries to justify this request by pointing to the need to determine
20 Smok's revenue and profits. But those are sought in multiple other requests, and
21 Smok has produced documentation of revenue and profits from its sale of Alien
22 goods in the United States.

23 Plaintiff's position as to additional documents responsive to this request
24 intentionally ignores the difference between calculation of actual revenue and
25 profits and *projections* of revenues and profits. Smok does not dispute that Plaintiff
26 is entitled to know Smok's revenues and profits for Smok's Alien goods in the
27 United States, but that does not give Plaintiff free reign to explore facts underlying
28 a financial projection made in June 2017. Moreover, nine months have passed since

1 that year-long projection. Any projections for that time period have given way to
2 actual revenue and profits.

3

4 **REQUEST FOR PRODUCTION NO. 77:**

5 All Documents and Communication supporting your allegation that “Welfer
6 OuYang agreed to sign the purported agreement because he believed Sarieddine’s
7 registrations for the ALIEN VAPE Marks automatically gave Sarieddine superior
8 trademark rights, as would be the case under Chinese law. Based on statements
9 made by Sarieddine, OuYang understood that the purpose of the Purported
10 Agreement was to give Sarieddine the access he desired to Smok’s sales channels
11 and to introduce Sarieddine’s products into new markets. In exchange for Smok’s
12 purchase and marketing of Sarieddine’s products, OuYang understood that
13 Sarieddine would not challenge Smok’s use of Smok’s ALIEN mark.” (Internal
14 Citations Omitted).

15 **RESPONSE TO REQUEST FOR PRODUCTION NO. 77:**

16 Smok objects to this Request on the grounds that it seeks documents and
17 communications protected by the attorney-client privilege, the attorney work
18 product doctrine, and the common interest privilege. Smok will produce non-
19 privileged documents and communications—if any— supporting the referenced
20 language.

21 **PLAINTIFF’S POSITION:**

22 Smok had agreed to produce non-privileged documents and communications
23 in response to this Request. However, it does not appear that Smok has produced all
24 responsive documents, as Smok has yet to produce a single internal communication
25 or email on this topic. Plaintiff reasonably expects that Smok has internal emails
26 and documents regarding the decision of Smok’s CEO to enter into the settlement
27 agreement. Plaintiff asks that these documents be produced within two weeks of
28 the hearing on this motion.

1 **SMOK'S POSITION:**

2 Smok's search for non-privileged documents responsive to this request is
3 ongoing.

4 Finally, in the interest of brevity, Smok incorporates paragraph 2 (regarding
5 internal documents) of Smok's Omnibus Position Regarding Document Requests.

6
7 **REQUEST FOR PRODUCTION NO. 79:**

8 All Documents supporting or refuting your denial that SMOK marketed a
9 vaporizer product in January 2017 named the "Alien Baby", in paragraph 6 of your
10 Amended Answer.

11 **RESPONSE TO REQUEST FOR PRODUCTION NO. 79:**

12 Smok objects to this Request on the grounds that it is overbroad, unduly
13 burdensome, and not proportional to the needs of the case because "all documents"
14 supporting Smok's denial would include every document that refers to the AL85
15 product by the name AL85. Smok will not search for or produce all such
16 documents. Smok further objects to this Request on the grounds that it seeks
17 documents protected by the attorney-client privilege, the attorney work product
18 doctrine, or the common interest privilege. Smok will produce non-privileged
19 documents—if any—that refute Smok's denial that it marketed a vaporizer product
20 in January 2017 named the "Alien Baby." Smok also will produce representative
21 non-privileged documents—if any—supporting the aforementioned denial.

22 **PLAINTIFF'S POSITION:**

23 Smok improperly objected that this Request is overbroad because "all
24 documents supporting Smok's denial would include every document that refers to
25 the AL85 product by the name AL85." However, RFP No. 79 does not ask Smok to
26 produce every document that uses the term AL85. Rather, it asks Smok for
27 evidence regarding Smok's contention that it never marketed a product named
28 "Alien Baby." As previously discussed, emails and advertisements demonstrate that

1 Smok marketed and advertised its AL85 vaporizer under the name “Alien Baby.”
2 McConnell Decl., ¶ 28, Ex. 15. To understand the discrepancy between these
3 advertisements and Smok’s position in this lawsuit, Plaintiff is entitled to review
4 Smok’s documents supporting its contention that it never marketed a vaporizer
5 under the “Alien Baby” name.

6 During the parties’ meet and confer session on March 5, 2018, Smok agreed
7 to search for documents responsive to RFP No. 79. McConnell Decl., ¶ 21.
8 Plaintiff asks that Smok produce these responsive documents within two weeks of
9 the hearing on this Motion.

10 **SMOK’S POSITION:**

11 Smok’s support for denying that it marketed a product named the “Alien
12 Baby” is that the name of the product in question has always been “AL85”. Thus,
13 “all documents” supporting this denial would include every document referring to
14 the AL85 product by the name AL85. Plaintiff has made no attempt to narrow the
15 overbroad scope of this request.

16

17 **REQUEST FOR PRODUCTION NO. 81:**

18 All Documents relating to or supporting any of SMOK’s Affirmative
19 Defense in its Amended Answer.

20 **RESPONSE TO REQUEST FOR PRODUCTION NO. 81:**

21 Smok objects to this request on the grounds that it is moot in light of
22 Sarieddine’s stated intention to file an Amended Complaint. Smok further objects
23 to this Request on the grounds that it is unduly burdensome and not proportional to
24 the needs of the case because it seeks to force Smok’s counsel to make legal
25 determinations. Smok further objects to this Request on the grounds that it seeks
26 documents protected by the attorney-client privilege, the attorney work product
27 doctrine, or the common interest doctrine.

28 **PLAINTIFF’S POSITION:**

1 Smok objected that this Request is “moot in light of Sarieddine’s stated
2 intention to file an Amended Complaint.” During the parties’ meet and confer
3 session, Plaintiff asked that Smok interpret this Request as applying to the
4 Affirmative Defenses of Smok’s most recently filed Amended Counterclaims (Dkt.
5 184). McConnell Decl., ¶ 35, Ex. 19. Plaintiff requests that Smok produce
6 documents regarding these affirmative defenses within two weeks of the hearing on
7 this motion.

8 **SMOK’S POSITION:**

9 During the meet and confer, Smok agreed to interpret this RFP as applying to
10 Smok’s amended affirmative defenses. Smok has already produced numerous
11 documents relating to or supporting its amended affirmative defenses, and intends
12 to produce additional responsive documents by May 30, 2018.

13

14 **REQUEST FOR PRODUCTION NO. 86:**

15 All Documents that SMOK is asked to identify in responding to any of
16 Plaintiff’s Interrogatories to SMOK, or from which SMOK derives information
17 used in preparing said responses.

18 **RESPONSE TO REQUEST FOR PRODUCTION NO. 86:**

19 Smok objects to this Request on the grounds that it is overbroad, unduly
20 burdensome, and not proportional to the needs of the case because it seeks
21 production of documents which Smok was asked to identify in Interrogatories that
22 were wholly or partially objectionable. Smok will not search for or produce
23 documents that it objected to identifying in responding to Plaintiff’s Interrogatories.
24 Smok further objects to this Request on the grounds that it seeks documents
25 protected by the attorney-client privilege, the attorney work product doctrine, or the
26 common interest privilege. Smok will produce non-privileged documents—if any—
27 that Smok identified in responding to Plaintiff’s Interrogatories. Smok also will
28 produce non-privileged documents—if any—from which Smok derived

1 information in preparing those responses.

2 **PLAINTIFF'S POSITION:**

3 It does not appear that Smok has produced the documents it used to answer
4 Plaintiff's interrogatories. For example, Interrogatories Nos. 3-4 and 6 seek
5 information regarding Smok's revenue, profits, and costs from selling the infringing
6 products at issue, but Smok has not produced any underlying financial documents.
7 The sole financial document that Smok has produced is the spreadsheet at
8 SMOK002406, which is incomplete for the reasons previously discussed. This
9 spreadsheet was clearly made from other more detailed financial and accounting
10 documents. Plaintiff asks that Smok produce the underlying financial documents
11 that Smok used to create the spreadsheet at SMOK002406 and which were also
12 used to provide information in response to Interrogatories Nos. 3-4 and 6. Plaintiff
13 asks that Smok produce all documents that it used in responding to Plaintiff's
14 interrogatories within two weeks of the hearing on this motion.

15 **SMOK'S POSITION:**

16 Plaintiff's sole complaint regarding Smok's production in response to this
17 RFP relates to information derived in preparing Smok's responses to Interrogatory
18 Nos. 3-4 and 6. Smok's responses to those Interrogatories were derived from the
19 spreadsheet bates-labeled SMOK002406, which Smok has already produced.

20

21 **D. Plaintiff's Omnibus Position Regarding Interrogatories**

22 Smok has failed to substantively respond to more than half of Plaintiff's
23 interrogatories, despite having six months to respond. Smok still has not provided
24 *any* information in response to Interrogatories Nos. 5, 8, 12, and 17 and instead has
25 asserted unsubstantiated objections that improperly limit Smok's obligation to
26 provide the requested information. For example, Smok objected to Interrogatory
27 No. 8 on attorney-client privilege grounds, even though that Interrogatory expressly
28 calls for communications between Smok and third parties. Smok has not provided

1 any authority for its position that its communications with third parties are
2 privileged, nor has it provided a privilege log. Smok's responses to Plaintiff's
3 remaining interrogatories are replete with similarly baseless objections.

4 The few interrogatories that Smok has answered suffer from critical
5 deficiencies. Smok disclosed only three numbers in response to Interrogatories
6 Nos. 3,4, and 6, which seek essential information regarding Smok's costs, profits,
7 and revenue from selling the infringing products at issue. Smok has represented
8 that these three numbers represent its costs, profits, and revenue from selling *one* of
9 the infringing products, based on U.S. sales only. Smok has refused, without
10 justification, to produce any cost, revenue, or profit information for the other
11 infringing products in this lawsuit. Smok has likewise refused to produce any data
12 for sales that occurred outside the U.S., even though the parties' Settlement
13 Agreement applied "worldwide," and Plaintiff's breach of contract claims therefore
14 include Smok's infringement outside the United States. Nor has Smok provided a
15 breakdown of its profits, costs, and revenue information, by product, financial
16 quarter, and country, as requested by Plaintiff's interrogatories.

17 Moreover, Smok has yet to produce any verifications for its interrogatory
18 responses in violation of FRCP 33, which requires that interrogatories be verified
19 by the answering party under oath. Plaintiff has been asking Smok to produce these
20 outstanding verifications since Plaintiff sent its first letter, dated November 28,
21 2017, regarding deficiencies in Smok's interrogatory responses. McConnell Decl.,
22 ¶ 7, Ex. 5.

23 After six months, Smok has produced only a fraction of the information
24 requested by Plaintiff's interrogatories and continues to assert unfounded objections
25 to avoid answering Plaintiff's interrogatories in full. Plaintiff therefore requests a
26 Court Order requiring Smok provide substantive, verified interrogatory responses
27 within two weeks of the hearing on this motion. Plaintiff's Interrogatories, and the
28 relevant portions of Smok's responses thereto, are identified below.

1 **E. Smok's Omnibus Position Regarding Interrogatories**

2 In the interest of brevity, Smok incorporates by reference the following
3 paragraphs from Smok's Omnibus Position on Document Requests: 3-4 (regarding
4 trademark use outside the United States); 5 (regarding the definition of "Alien Kit
5 Marks"); and 6-7 (regarding financial information for AL85 goods).

6 As to providing profits, costs, and revenue broken down by quarter, pursuant
7 to Fed. R. Civ. P. 33(d), Plaintiff can derive that information from the spreadsheet
8 bates-labeled SMOK002406. Smok will amend its interrogatory responses to reflect
9 this.

10 **F. Interrogatories That Are in Dispute**

11 **INTERROGATORY NO. 3:**

12 Identify the total amount of costs that SMOK has incurred relating to the
13 products sold, or offered for sale, under the Alien Kit Marks. The identification
14 shall include a breakdown of the costs incurred, type of cost, and an identification
15 of all documents relating to those costs.

16 **RESPONSE TO INTERROGATORY NO. 3:**

17 Smok objects to this Interrogatory on the grounds that it is overbroad, unduly
18 burdensome, and not proportional to the needs of the case because (1) it seeks
19 information unrelated to trademark use in the United States and (2) Smok never
20 sold any product under the name "Alien Baby." Smok further objects to this
21 Interrogatory on the grounds that it is unduly burdensome because identifying "all
22 documents relating to those costs" would be unnecessary to disclose the cost
23 information Sarieddine seeks through this Interrogatory. Smok will not search for
24 or provide answers regarding its costs relating to products sold or offered for sale
25 outside the United States, nor will Smok identify all documents relating to the costs
26 it has incurred relating to products sold or offered for sale under the Alien Kit
27 Marks. Smok will not search for or provide financial information relating to its

1 AL85 product. [Remaining response redacted as Attorney's Eyes Only pursuant to
2 Stipulated Protective Order (D.I. 157) and separately produced to counsel].

3 **PLAINTIFF'S POSITION:**

4 Interrogatory No. 3 asks Smok to identify the total amount of costs it
5 incurred from selling goods under the "Alien Kit Marks." Like Plaintiff's RFPs,
6 Plaintiff's interrogatories define "Alien Kit Marks" as encompassing all Smok's
7 Alien-branded products in this lawsuit, which Smok sold in breach of the parties'
8 settlement agreement and in violation of Plaintiff's federal trademark rights. These
9 products include Alien Kit aka AL220, Alien Mod, Alien Baby aka AL85, and the
10 Alien 2 aka AL230. In addition to asking Smok to provide its total costs from
11 selling these products, Interrogatory No. 3 also asks Smok to provide a breakdown
12 of these costs by product sold. This information is needed to compute Plaintiff's
13 damages from Smok's trademark infringement under 15 U.S.C. § 1117(a).

14 Smok has failed to meaningfully respond to Interrogatory No. 3. Smok
15 provided only one number in response to this interrogatory, which Smok said
16 reflected its "direct costs" for its U.S.-only sales of its "Smok Alien" product. Smok
17 refused to provide any cost information for its other product sold under the "Alien
18 Kit Marks" and also refused to provide cost information for worldwide sales.
19 Plaintiff asks that Smok withdraw its objections and fully respond to Interrogatory
20 No. 3 for the following reasons.

21 First, Smok has no basis for refusing to search for or produce any financial
22 information regarding its other products sold under the Alien Kit Marks. Smok's
23 refusal to produce any information for its AL85 vaporizer, advertised as the "Alien
24 Baby" product, is particularly egregious. This vaporizer is a key product in this
25 lawsuit, mentioned throughout Plaintiff's First Amended Complaint as a product
26 that Smok sold in breach of the parties' settlement agreement and in violation of
27 Plaintiff's trademark rights. Data regarding Smok's costs from selling this
28 infringing product are directly relevant to Plaintiff's damages in this lawsuit.

1 Smok's false assertion in its response to Interrogatory No. 3 that it "never sold any
2 product under the name 'Alien Baby'" is contradicted by Smok's own documents.
3 McConnell Decl., ¶ 28, Ex. 15. Furthermore, Smok's Twitter and Instagram
4 accounts continue to display posts promoting the AL85 vaporizer using the
5 #alienbaby hashtag. *Id.*, ¶ 36, Exs. 20-21.

6 Smok's refusal to provide any data regarding the sales of its Alien-branded
7 vaporizers outside of the United States is likewise improper. As previously
8 explained herein, Smok's objection is inconsistent with the claims in this lawsuit.
9 The parties' settlement agreement applied worldwide, and Plaintiff's Lanham Act
10 claims are not limited to acts of trademark infringement that occurred within the
11 United States. Even if the Court does eventually decide that Plaintiff's Lanham Act
12 claims do not apply extraterritorially, such a decision would not give Smok
13 unfettered discretion to "cherry-pick" financial data to produce in this case. Plaintiff
14 has the right to examine Smok's financial data regarding all sales of its infringing
15 products to investigate the veracity of Smok's claimed sales in the United States.
16 *See Wahoo Int'l, Inc. v. Phix Doctor, Inc.*, 2014 U.S. Dist. LEXIS 98044, at *20-21.

17 Plaintiff therefore requests that Smok revise its response to Interrogatory No.
18 3 to include its costs for all products sold under the Alien Kit Marks and that it also
19 include the costs from the worldwide sales of these goods. In addition, Smok
20 should provide a per-product breakdown of these costs, as requested by the
21 Interrogatory. Furthermore, Smok should produce the underlying financial
22 documents that it used to respond to Interrogatory No. 3. Plaintiff requests that
23 Smok provide its amended response to Interrogatory No. 3, along with the
24 underlying financial documents, within two weeks of the hearing on this motion.

25 **SMOK'S POSITION:**

26 In the interest of brevity, Smok incorporates by reference the following
27 paragraphs from Smok's Omnibus Position on Document Requests: 3-4 (regarding
28 trademark use outside the United States); 5 (regarding the definition of "Alien Kit

1 Marks"); and 6-7 (regarding financial information for AL85 goods).

2

3 **INTERROGATORY NO. 4:**

4 Identify the total profits that SMOK has derived from all products sold or
5 offered for sale under the Alien Kit Marks. The identification shall include a
6 breakdown of SMOK's profits, by product on a quarterly basis, from first sale to
7 the present.

8 **RESPONSE TO INTERROGATORY NO. 4:**

9 Smok objects to this Interrogatory on the grounds that it is overbroad, unduly
10 burdensome, and not proportional to the needs of the case because (1) it seeks
11 information unrelated to trademark use in the United States and (2) Smok never
12 sold any product under the name "Alien Baby." Smok will not search for or provide
13 answers regarding its profits relating to products sold or offered for sale outside the
14 United States. Smok will not search for or provide financial information relating to
15 its AL85 product. [Remaining response redacted as Attorney's Eyes Only pursuant
16 to Stipulated Protective Order (D.I. 157) and separately produced to counsel].

17 **PLAINTIFF'S POSITION:**

18 Interrogatory No. 4 asks Smok to identify the total amount of profits it
19 incurred from selling goods under the "Alien Kit Marks" and also asks Smok to
20 provide a breakdown of these profits by product sold. This information is needed
21 to compute Plaintiff's damages from Smok's trademark infringement under 15
22 U.S.C. § 1117(a).

23 Smok has failed to meaningfully respond to Interrogatory No. 4. Smok
24 provided only one number in response to this interrogatory, which Smok said
25 reflected its "gross profits" for its U.S.-only sales of its "Smok Alien" product.
26 Smok refused to provide any profit information for its other product sold under the
27 "Alien Kit Marks" and also refused to provide profit information for worldwide
28 sales. Plaintiff asks that Smok withdraw its objections and fully respond to

1 Interrogatory No. 4 for the following reasons.

2 First, Smok has no basis for refusing to search for or produce any financial
3 information regarding its other products sold under the “Alien Kit Marks.” As
4 previously discussed, Plaintiff’s claims encompass all products sold under the
5 “Alien Kit Marks,” and Plaintiff therefore needs data regarding Smok’s profits from
6 selling these products to calculate damages in this lawsuit. Smok’s false assertion
7 in its response to Interrogatory No. 4 that it “never sold any product under the name
8 ‘Alien Baby’” is contradicted by Smok’s own documents and promotions on social
9 media. McConnell Decl., ¶¶ 28 and 36; Exs. 15; 20-21.

10 Smok’s refusal to provide any data regarding the sales of its Alien-branded
11 vaporizers outside of the United States is likewise improper. As previously
12 explained herein, Smok’s limitation is inconsistent with the claims in this lawsuit.
13 The parties’ settlement agreement applied “worldwide” and Plaintiff’s Lanham Act
14 claims against Smok are not limited to acts of trademark infringement that occurred
15 within the United States. In any event, Plaintiff has the right to examine Smok’s
16 underlying financial documents regarding all sales of its infringing products to
17 investigate the veracity of Smok’s claims its sales in the United States. *See, e.g.*,
18 *Wahoo Int’l, Inc. v. Phix Doctor, Inc.*, 2014 U.S. Dist. LEXIS 98044, at *20-21.

19 Plaintiff therefore requests that Smok revise its response to Interrogatory No.
20 4 to include its profits for all products sold under the Alien Kit Marks and that it
21 also include profits from the worldwide sales of these goods. In addition, Smok
22 should provide a per-product breakdown of these profits, as requested by the
23 Interrogatory. Furthermore, Smok should produce the underlying financial
24 documents that it used to respond to Interrogatory No. 4. Plaintiff requests that
25 Smok provide its amended response to Interrogatory No. 4, along with the
26 underlying financial documents, within two weeks of the hearing on this motion.

27 **SMOK’S POSITION:**

28 In the interest of brevity, Smok incorporates by reference the following

1 paragraphs from Smok's Omnibus Position on Document Requests: 3-4 (regarding
2 trademark use outside the United States); 5 (regarding the definition of "Alien Kit
3 Marks"); and 6-7 (regarding financial information for AL85 goods).

4

5 **INTERROGATORY NO. 5:**

6 Identify all facts supporting SMOK's contention that "[i]f Smok is prohibited
7 from selling its ALIEN, AL85, and AL230 vaporizers for a year while awaiting
8 trial, Smok would project to lose well over \$50 million in revenue and \$5 million in
9 profits." (Dkt. 102-1 at page 11). The identification shall include, without
10 limitation, all documents relating to this contention, as well as facts sufficient to
11 demonstrate how SMOK arrived at its "\$50 million in revenue and \$5 million in
12 profits" calculations.

13 **RESPONSE TO INTERROGATORY NO. 5:**

14 Smok objects to this Interrogatory on the grounds that it is moot because
15 Smok made the quoted prediction in opposition to Sarieddine's motions for
16 temporary injunctive relief, which motions have since been denied. Smok further
17 objects to this Interrogatory on the grounds that it is overbroad, unduly
18 burdensome, and not proportional to the needs of the case because it seeks dated,
19 predictive financial information that has no bearing on this action. Smok further
20 objects to this Interrogatory on the grounds that it is unduly burdensome to identify
21 "all documents relating" to anticipated sales of so many products.

22 **PLAINTIFF'S POSITION:**

23 Smok has improperly refused to answer this interrogatory, claiming that the
24 interrogatory is "moot" because Smok had represented that it would "lose well over
25 \$50 million in revenue and \$5 million in profits" in its opposition to Plaintiff's
26 motion for injunctive relief. However, the fact that Plaintiff's motion for injunctive
27 relief was denied does not render this issue "moot." The question of how Smok
28 calculates its revenue and profits from selling its infringing products is very much a

1 live issue. Plaintiff is entitled to understand how Smok calculates its revenue and
2 profits and how Smok makes financial predictions regarding the infringing products
3 at issue.

4 Plaintiff therefore requests that Smok amend its response to Interrogatory
5 No. 5 to explain how it estimated that it would “lose well over \$50 million in
6 revenue and \$5 million in profits” if it were enjoined from selling its ALIEN,
7 AL85, and AL230 vaporizers for a year. Smok should also produce the underlying
8 financial documents that it used to respond to this interrogatory. Plaintiff requests
9 that Smok provide its amended response to Interrogatory No. 5, as well as the
10 supporting financial documents, within two weeks of the hearing on this motion.

11 **SMOK'S POSITION:**

12 Plaintiff's position intentionally ignores the difference between calculation of
13 actual revenue and profits and *projections* of revenues and profits. Smok does not
14 dispute that Plaintiff is entitled to know Smok's revenues and profits for Smok's
15 Alien goods in the United States, but that does not give Plaintiff free reign to
16 explore facts underlying a financial projection made in June 2017. Moreover, nine
17 months have passed since that year-long projection. Any projections for that time
18 period have given way to actual revenue and profits.

19
20 **INTERROGATORY NO. 6:**

21 Identify SMOK's total gross revenue from the sale of any and all goods
22 bearing any of the Alien Kit Marks, broken down by product and country, from first
23 sale to the present.

24 **RESPONSE TO INTERROGATORY NO. 6:**

25 Smok objects to this Interrogatory on the grounds that it is overbroad, unduly
26 burdensome, and not proportional to the needs of the case because (1) it seeks
27 information unrelated to trademark use in the United States and (2) Smok never
28 sold any product under the name “Alien Baby.” Smok will not search for or provide

1 answers regarding its gross revenue for products sold or offered for sale outside the
2 United States. Smok will not search for or provide financial information relating to
3 its AL85 product. [Remaining response redacted as Attorney's Eyes Only pursuant
4 to Stipulated Protective Order (D.I. 157) and separately produced to counsel.].

5 **PLAINTIFF'S POSITION:**

6 Interrogatory No. 6 asks Smok to identify its total revenue from selling goods
7 under the "Alien Kit Marks" and also asks Smok to provide a breakdown of the
8 revenue by country and product sold. This information is needed to compute
9 Plaintiff's damages from Smok's trademark infringement under 15 U.S.C. §
10 1117(a).

11 Smok has failed to meaningfully respond to Interrogatory No. 6. Smok
12 provided only one number in response to this interrogatory, which Smok said
13 reflected its "gross revenue" for its U.S.-only sales of its "Smok Alien" product.
14 Smok refused to provide any revenue information for its other product sold under
15 the "Alien Kit Marks" and also refused to provide revenue information for
16 worldwide sales. Plaintiff asks that Smok withdraw its objections and fully respond
17 to Interrogatory No. 6 for the following reasons.

18 First, Smok has no basis for refusing to search for or produce any financial
19 information regarding its other products sold under the "Alien Kit Marks." As
20 previously discussed, Plaintiff's claims encompass all products sold under the
21 "Alien Kit Marks," and Plaintiff therefore needs data regarding Smok's revenue
22 from selling these products to calculate damages in this lawsuit. Smok's false
23 assertion in its response to Interrogatory No. 6 that it "never sold any product under
24 the name 'Alien Baby'" is contradicted by Smok's own documents and promotions
25 on social media. McConnell Decl., ¶¶ 28 and 36; Exs. 15; 20-21.

26 Smok's refusal to provide any data regarding the sales of its Alien-branded
27 vaporizers outside of the United States is likewise improper. As previously
28 explained herein, Smok's objection is inconsistent with the claims in this lawsuit.

1 The parties' settlement agreement applied "worldwide" and Plaintiff's Lanham Act
2 claims against Smok are not limited to acts of trademark infringement that occurred
3 within the United States. In any event, Plaintiff has the right to examine Smok's
4 underlying financial documents regarding all sales of its infringing products to
5 investigate the veracity of Smok's claims its sales in the United States. *See Wahoo*
6 *Int'l, Inc. v. Phix Doctor, Inc.*, 2014 U.S. Dist. LEXIS 98044, at *20-21.

7 Plaintiff therefore requests that Smok revise its response to Interrogatory No.
8 6 to include its revenue for all products sold under the Alien Kit Marks and that it
9 also include revenue from the worldwide sales of these goods. In addition, Smok
10 should provide a per-product and per-country breakdown of these profits, as
11 requested by the Interrogatory. Furthermore, Smok should produce the underlying
12 financial documents that it used to respond to Interrogatory No. 6. Plaintiff requests
13 that Smok provide its amended response to Interrogatory No. 6, along with the
14 underlying financial documents, within two weeks of the hearing on this motion.

15 **SMOK'S POSITION:**

16 In the interest of brevity, Smok incorporates by reference the following
17 paragraphs from Smok's Omnibus Position on Document Requests: 3-4 (regarding
18 trademark use outside the United States); 5 (regarding the definition of "Alien Kit
19 Marks"); and 6-7 (regarding financial information for AL85 goods).

20

21 **INTERROGATORY NO. 7:**

22 Identify every trademark application that SMOK has filed anywhere in the
23 world that includes the term "ALIEN." The identification shall include, without
24 limitation, the trademark application number, the country where the application was
25 filed, and the date of filing.

26 **RESPONSE TO INTERROGATORY NO. 7:**

27 Smok objects to this Interrogatory on the grounds that it is overbroad, unduly
28 burdensome, and not proportional to the needs of the case because it seeks

1 information unrelated to trademark activity in the United States. Smok answers
2 only with respect to trademark applications Smok has filed in the United States that
3 include the term “ALIEN.”

4 • Application No. 87/411,300 for the mark SMOK ALIEN KIT, filed on
5 April 13, 2017. Smok filed a request for express abandonment of this application on
6 April 20, 2017. The USPTO issued a Notice of Abandonment on April 21, 2017.

7 **PLAINTIFF’S POSITION:**

8 Smok had improperly restricted the scope of this Interrogatory to trademark
9 applications filed in the United States. Interrogatory No. 7 seeks information
10 regarding *all* of Smok’s trademark applications for “Alien,” which were filed in
11 violation of the parties’ settlement agreement. Because the settlement agreement
12 applied “worldwide,” trademark applications that Smok filed in China and
13 elsewhere are relevant to Plaintiff’s breach of contract claims. *See* Dkt. 165-1.

14 During the parties’ meet and confer session on March 5, 2018, Smok agreed
15 to revise its response to Interrogatory No. 7 to reflect the trademark applications it
16 filed in China that contained the term “Alien.” McConnell Decl., ¶ 21. That is not
17 good enough. Smok must revise its response to reflect all trademark applications
18 filed anywhere in the world that contained the term “Alien”. Plaintiff asks that
19 Smok provide its updated response to Interrogatory No. 7 within two weeks of the
20 hearing on this motion.

21 **SMOK’S POSITION:**

22 As Smok’s counsel noted during the meet and confer, Smok’s only trademark
23 applications containing the term “Alien” were filed in China or the United States.
24 So Smok’s amendment to identify the Chinese applications will reflect trademark
25 applications “anywhere in the world.”

26
27 **INTERROGATORY NO. 8:**

28 Identify all communications, before May 31, 2017, between SMOK and any

1 third parties that refer or relate to contesting, challenging, or invalidating Plaintiff's
2 Alien Vape Marks. The identification shall include the date(s) of each
3 communication, the parties to the communication, and the substance of the
4 communication, as well as all documents relating to the communication.

5 **RESPONSE TO INTERROGATORY NO. 8:**

6 Smok objects to the Interrogatory to the extent it seeks information protected
7 by the attorney-client privilege, the attorney work product doctrine, or the common
8 interest privilege. Smok answers that it is not aware of any non-privileged
9 communications prior to May 31, 2017, between Smok and any third parties, that
10 refer or relate to contesting, challenging, or invalidating Plaintiff's Alien Vape
11 Marks.

12 **PLAINTIFF'S POSITION:**

13 Smok had initially refused to provide the information requested by
14 Interrogatory No. 8 on the grounds that "it is not aware of any non-privileged
15 communications prior to May 31, 2017, between Smok and any third parties, that
16 refer or relate to contesting, challenging, or invalidating Plaintiff's Alien Vape
17 Marks." However, this assertion is contradicted by Smok's documents. For
18 example, Smok's CEO admitted to speaking with Big Bang and working with them
19 "to fight against" Plaintiff's "liquid trademark." McConnell Decl., ¶ 23, Ex. 13.
20 Given this admission from Smok's CEO, there are presumably other
21 communications between Smok and third parties regarding efforts to invalidate
22 Plaintiff's trademarks.

23 During the parties' meet and confer session on March 5, 2018, Smok
24 conceded that the requested communications *did* occur, but stated there was "no
25 written record" of these communications. Smok agreed to revise its response to
26 Interrogatory No. 8 to include information regarding these non-recorded
27 communications. *Id.*, ¶ 22.

28 However, Plaintiff has reason to believe that recorded communications

1 between Smok and third parties, which are responsive to Interrogatory No. 8, do
2 exist. As previously discussed, other documents produced in this lawsuit
3 demonstrate Smok employees tend to use email, WeChat, and Skype to
4 communicate with individuals outside the company. *Id.*, ¶ 23, Ex. 13. This is
5 consistent with Plaintiff's own experience, as the vast majority of Plaintiff's
6 communications with Smok occurred through these means. *Id.*, ¶ 23. Plaintiff
7 therefore requests that Smok produce *all* communications with third parties that
8 refer or relate to challenging Plaintiff's trademarks and that Smok revise its
9 response to this Interrogatory to identify all recorded and non-recorded
10 communications.

11 Furthermore, given the Court's recent order denying Big Bang's request to
12 consolidate its case with the case against Smok, Smok should not withhold
13 responsive communications with Big Bang on privilege grounds. *See* Case No.
14 Case 2:17-cv-00989-DSF-SK, Dkt. 71. As the Court noted, the differences
15 between Plaintiff's cases against Smok and Big Bang include "different defendants,
16 different products in different geographic markets, and different time periods." *Id.*
17 Because of these significant differences, Smok and Big Bang are not pursuing a
18 joint legal strategy, and most, if not all, communications with Big Bang would not
19 fall within the purview of the common interest privilege. *See, e.g.*, *Nidec Corp. v.*
20 *Victor Co.*, 249 F.R.D. 575, 579 (N.D. Cal. 2007) (noting that the common interest
21 privilege applies only to communications made in the course of "formulating
22 a *common legal strategy*" or otherwise furthering the parties' joint interest in a
23 lawsuit).

24 To the extent that Smok has withheld responsive communications with third
25 parties on any privilege grounds, including on joint defense or common interest
26 privilege grounds, Smok must provide a privilege log. In accordance with the
27 instructions provided in Plaintiff's discovery requests, this privilege log should
28 include the following information: (a) the date of the communication; (b) the

1 subject matter of the communication; (c) the names, addresses, job titles, and
2 employers of all persons with knowledge or a copy of the information, and (d) the
3 nature of the privilege asserted.

4 Smok should revise its response to Interrogatory 8, and produce all
5 communications used to answer this Interrogatory as well as a privilege log for any
6 withheld communications, within two weeks of the hearing on this motion.

7 **SMOK'S POSITION:**

8 During the meet and confer, Smok's position was that communications with
9 third parties regarding Sarieddine or the Alien Vape Marks had occurred; it was not
10 Smok's position that those communications necessarily referred or related to
11 contesting, challenging, or invalidating the Alien Vape Marks. If Smok can identify
12 any non-privileged responsive communications, it will amend its answer to this
13 Interrogatory accordingly.

14 Sarieddine's position regarding the common-interest privilege between Smok
15 and Big Bang is incorrect. While the two cases were not consolidated, there is
16 undisputed overlap between the cases with respect to a number of issues, including
17 the scope of protection for Sarieddine's ALIEN VAPE marks. Sarieddine's
18 implication that most communications Smok and Big Bang (including their
19 respective attorneys) would cover areas where the cases do not overlap is dubious.
20 Smok is entitled to withhold communications between its counsel and Big Bang's
21 by virtue of the common-interest privilege.

22 Finally, in the interest of brevity, Smok incorporates by reference the
23 following paragraphs from Smok's Omnibus Position on Document Requests: 9
24 (regarding third-party communications) and 12 (regarding a privilege log).

25
26 **INTERROGATORY NO. 12:**

27 Identify all facts relating to your affirmative defense that SMOK did not
28 perform under the Contract because Sarieddine's "ALIEN VAPE e-liquid did not

1 comply with Chinese regulations.” (SMOK Amended Answer, Dkt. 139 at page
2 13). The identification should include, without limitation, the Chinese regulations at
3 issue, the date that SMOK allegedly learned that Sarieddine’s “ALIEN VAPE e-
4 liquid did not comply with Chinese regulations,” and the persons or entities who
5 have knowledge of facts relating to this affirmative defense.

6 **RESPONSE TO INTERROGATORY NO. 12:**

7 Smok objects to this interrogatory on the grounds that it seems information
8 protected by the attorney-client privilege and attorney work product doctrine.
9 Chinese regulations govern the type of business that Smok can operate, and sales of
10 Alien Vape branded e-juice are not consistent with Smok’s obligations under those
11 regulations. Smok is still investigating this interrogatory.

12 **PLAINTIFF’S POSITION:**

13 Smok failed to provide any information in response to this Interrogatory and
14 simply states that “Chinese regulations govern the type of business that Smok can
15 operate, and sales of Alien Vape branded e-juice are not consistent with Smok’s
16 obligations under those regulations. Smok is still investigating this interrogatory.”

17 Plaintiff requests that Smok amend its response to provide substantive
18 information regarding this affirmative defense. Given that Smok has been asserting
19 this affirmative defense for the better part of a year, Plaintiff expects that Smok has
20 some factual basis for asserting it. During the parties’ meet and confer session on
21 March 5, 2018, Smok agreed to provide information in response to this
22 Interrogatory. McConnell Decl., ¶ 21. Plaintiff asks that Smok amend its response
23 to Interrogatory No. 12 to provide the requested information within two weeks of
24 the hearing on this motion.

25 **SMOK’S POSITION:**

26 Smok will amend its answer to this Interrogatory to provide additional facts.
27
28

1 **INTERROGATORY NO. 17:**

2 Identify all communications that refer or relate to any consumer confusion
3 between Sarieddine's Alien Vape Marks and SMOK's Alien Kit Marks, including,
4 without limitation, any instances when a third-party has inquired if there is a
5 relationship between SMOK and Sarieddine, or whether SMOK is the source of any
6 goods bearing Sarieddine's Alien Vape Marks. The identification shall include the
7 date(s) of each communication, the parties to the communication, and the substance
8 of the communication, as well as all documents relating to the communication.

9 **RESPONSE TO INTERROGATORY NO. 17:**

10 Smok objects to this Interrogatory to the extent it seeks information protected
11 by the attorney-client privilege, the attorney work product doctrine, or the common
12 interest privilege. Smok further objects to this Interrogatory as overbroad, unduly
13 burdensome, and not proportional to the needs of the case because it seeks
14 information related to communications to which Smok was not a party. Smok
15 answers that it is not aware of any non-privileged communications to which Smok
16 was a party that refer or relate to any consumer confusion between Sarieddine's
17 Alien Vape Marks and Smok's Alien Kit Marks.

18 **PLAINTIFF'S POSITION:**

19 Smok failed to provide any information in response to Interrogatory No. 17
20 on the grounds that it is "not aware of any non-privileged communications to which
21 Smok was a party that refer or relate to any consumer confusion between
22 Sarieddine's Alien Vape Marks and Smok's Alien Kit Marks." However, this
23 statement is not credible. Plaintiff has produced dozens of communications with
24 third parties expressing confusion between Sarieddine's Alien Vape Marks and
25 Smok's Alien Kit Marks. McConnell Decl., ¶ 26. Plaintiff's First Amended
26 Complaint includes additional examples of consumer confusion. *See* Dkt. 165 at ¶¶
27 81- 82. Given the frequency with which Plaintiff has encountered third parties who
28 expressed confusion between Sarieddine's Alien Vape Marks and Smok's Alien Kit

1 Marks, Plaintiff reasonably believes that Smok has also communications on this
2 topic within its possession, custody, or control.

3 Plaintiff asks that Smok revise its response to Interrogatory No. 17 to provide
4 the request information, and that Smok also produce the underlying
5 communications indicating consumer confusion, within two weeks of the hearing
6 on this motion.

7 **SMOK'S POSITION:**

8 Smok remains unaware of any non-privileged communications to which
9 Smok was a party that refer or relate to any consumer confusion between
10 Sarieddine's Alien Vape Marks and Smok's Alien Kit Marks.

11

12

DATED: March 21, 2018

Respectfully submitted,

13 THE MCARTHUR LAW FIRM, PC

14

15

By: /s/ Stephen McArthur
Stephen McArthur

16

Attorneys for Plaintiff, Mike Sarieddine

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19

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DATED: March 21, 2018

Respectfully submitted,

21 LOCKE LORD LLP

22

23

By: David T. Van Der Loen

24

25

Name: David T. Van Der Loen

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28

Attorneys for Defendant and
Counterclaimant Shenzhen IVPS
Technology Co., Ltd. f/k/a Shenzhen
Smok Technology Co., Ltd.

JOINT STIPULATION REGARDING
PLAINTIFF'S MOTION TO COMPEL
Case No. 2:17-cv-02390-DSF-SK